



This is a digital copy of a book that was preserved for generations on library shelves before it was carefully scanned by Google as part of a project to make the world's books discoverable online.

It has survived long enough for the copyright to expire and the book to enter the public domain. A public domain book is one that was never subject to copyright or whose legal copyright term has expired. Whether a book is in the public domain may vary country to country. Public domain books are our gateways to the past, representing a wealth of history, culture and knowledge that's often difficult to discover.

Marks, notations and other marginalia present in the original volume will appear in this file - a reminder of this book's long journey from the publisher to a library and finally to you.

Usage guidelines

Google is proud to partner with libraries to digitize public domain materials and make them widely accessible. Public domain books belong to the public and we are merely their custodians. Nevertheless, this work is expensive, so in order to keep providing this resource, we have taken steps to prevent abuse by commercial parties, including placing technical restrictions on automated querying.

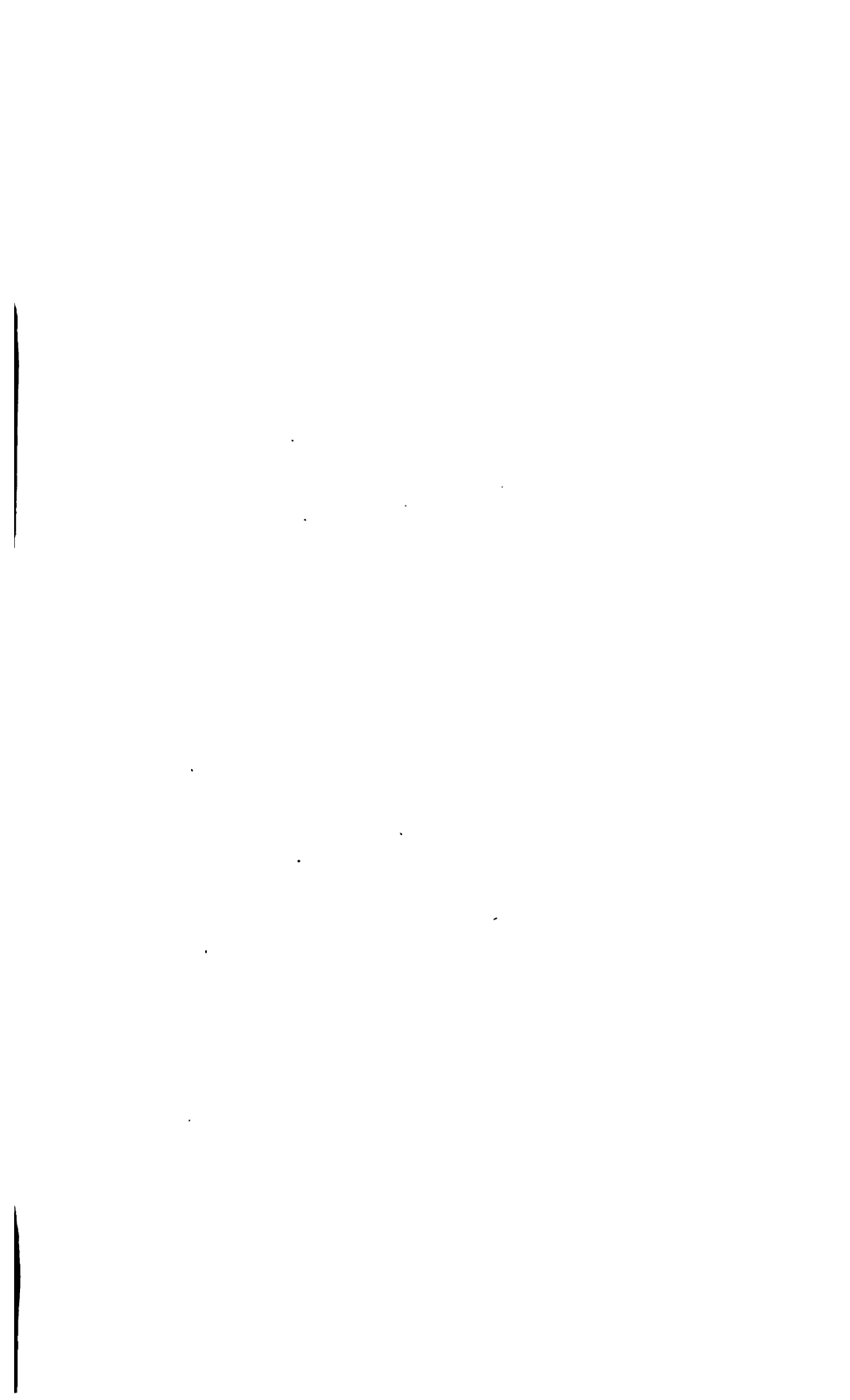
We also ask that you:

- + *Make non-commercial use of the files* We designed Google Book Search for use by individuals, and we request that you use these files for personal, non-commercial purposes.
- + *Refrain from automated querying* Do not send automated queries of any sort to Google's system: If you are conducting research on machine translation, optical character recognition or other areas where access to a large amount of text is helpful, please contact us. We encourage the use of public domain materials for these purposes and may be able to help.
- + *Maintain attribution* The Google "watermark" you see on each file is essential for informing people about this project and helping them find additional materials through Google Book Search. Please do not remove it.
- + *Keep it legal* Whatever your use, remember that you are responsible for ensuring that what you are doing is legal. Do not assume that just because we believe a book is in the public domain for users in the United States, that the work is also in the public domain for users in other countries. Whether a book is still in copyright varies from country to country, and we can't offer guidance on whether any specific use of any specific book is allowed. Please do not assume that a book's appearance in Google Book Search means it can be used in any manner anywhere in the world. Copyright infringement liability can be quite severe.

About Google Book Search

Google's mission is to organize the world's information and to make it universally accessible and useful. Google Book Search helps readers discover the world's books while helping authors and publishers reach new audiences. You can search through the full text of this book on the web at <http://books.google.com/>





REPORTS
OF
CASES ARGUED AND DETERMINED
IN THE
Circuit Court of the United States
FOR THE SECOND CIRCUIT.

BY SAMUEL BLATCHFORD,
JUDGE OF THE DISTRICT COURT OF THE UNITED STATES FOR THE SOUTHERN
DISTRICT OF NEW YORK.

VOLUME IX.

NEW YORK:
BAKER, VOORHIS & CO., PUBLISHERS,
66 NASSAU STREET.
1872.

Entered, according to Act of Congress, in the year one thousand eight hundred and seventy-two,

By SAMUEL BLATCHFORD,

In the Office of the Librarian of Congress, at Washington.

**LIBRARY OF THE
LELAND STANFORD, JR., UNIVERSITY
LAW DEPARTMENT.**

**BAKER & GODWIN, PRINTERS,
Printing-House Square, New York.**

JUDGES
OF THE CIRCUIT COURTS OF THE UNITED STATES
WITHIN THE SECOND CIRCUIT,
DURING THE TIME OF THESE REPORTS.

**SAMUEL NELSON, Associate Justice of the Supreme
Court of the United States.**

**LEWIS B. WOODRUFF, Circuit Judge of the Second
Judicial Circuit.**

DISTRICT JUDGES.

**SAMUEL BLATCHFORD, Southern District of New
York.**

NATHAN K. HALL, Northern District of New York.

**CHARLES L. BENEDICT, Eastern District of New
York.**

DAVID A. SMALLEY, Vermont.

WILLIAM D. SHIPMAN, Connecticut.

* * *The following corrections should be made in Volume
VIII of these Reports.*

Page 63, line 9, strike out "United "

" 66, 10th line from bottom, for "charter" read "character "

" 181, line 9, for "part" read "fact "

" 238, line 17, for "his" read "this "

" 242, 5th line from bottom, for "continued" read "combined "

" 265, line 17, for "salvage" read "towage "

" 310, 15th line from bottom, for "was the intention" read "was
not the intention "

" 465, line 12 of head note, for "was" read "were "

" 571, line 4 of syllabus 9, for "was" read "were "

CASES

REPORTED IN THIS VOLUME.

A

Alabama and Chattanooga R. R. Co. (<i>In re</i>).....	890
Archer (<i>Platt v.</i>).....	559

B

Baldwin <i>v.</i> Bernard.....	509
—— <i>v.</i> Schultz.....	494
Bankers' and Brokers' Telegraph Co. (<i>Day v.</i>).....	345
Barnes <i>v.</i> Straus.....	553
Bernard (<i>Baldwin v.</i>).....	509
Bevin <i>v.</i> East Hampton Bell Co. . .	50
Bixby (<i>Sawyer v.</i>).....	381
Boston, Hartford & Erie R. R. Co. (<i>In re</i>).....	101, 409
Boutwell (<i>Galvin v.</i>).....	470
Britton <i>v.</i> Butler.....	456
Buerk <i>v.</i> Valentine.....	479
Butler (<i>Britton v.</i>).....	456

C

Carrington <i>v.</i> Florida Railroad Co.....	467, 468
Case (<i>Morrison v.</i>).....	548
Clark (<i>In re</i>).....	372, 379
—— <i>v.</i> Iselin.....	196
—— <i>v.</i> Scott.....	301
Coe (<i>Keyser v.</i>).....	82
Comet (<i>The</i>).....	323
Cornwall (<i>In re</i>).....	114

D

Daniels <i>v.</i> Tarbox.....	176
Dart <i>v.</i> McKinney.....	359
Day (<i>Doughty v.</i>).....	262

Day <i>v.</i> Bankers' and Brokers' Tele- graph Co.....	345
Devoe Mfg. Co. (<i>Meissner v.</i>)....	363
Dey (<i>In re</i>).....	285
Doughty <i>v.</i> Day.....	262
Drake (<i>Merriam v.</i>).....	336

E

East Hampton Bell Co. (<i>Bevin v.</i>)..	50
Elliott (<i>Smith v.</i>).....	400
Elwine Kreplin (<i>The</i>).....	438
Erie Railway Co. (<i>Heath v.</i>).....	316
—— <i>v.</i> Heath.....	226, 316

F

Florida Railroad, Co. (<i>Carring- ton v.</i>).....	467, 468
Folsom <i>v.</i> Mercantile Mutual Ins. Co.....	201
Frame (<i>Peek v.</i>).....	194
Frost (<i>Kittle v.</i>).....	214

G

Galvin <i>v.</i> Boutwell.....	470
Garretson (<i>Taylor v.</i>).....	156
Gay <i>v.</i> Union Mutual Life Ins. Co.	142
Gilbert (<i>Sisson v.</i>).....	185
Grant (<i>Hartford and New Haven R. R. Co. v.</i>).....	542
Grinnell (<i>Shaw v.</i>).....	471
Griswold (<i>Wilson v.</i>).....	267

H

Hall (<i>Sarven v.</i>).....	524
Hamilton <i>v.</i> Mutual Life Ins. Co..	234

Hartford and New Haven R. R. Co. v. Grant	542	Mercantile Mutual Ins. Co. (Fol- som v.)	201		
Heath (Erie Railway Co. v.) ..	226, 316	Merriam v. Drake	336		
—— v. Erie Railway Co.	316	Merrill (Petty v.)	447		
Hitchcock v. Tremaine	385, 550	Miller v. O'Brien	270		
Holmes (Wallace v.)	65	—— (Waterbury Brass Co. v.) ..	77		
Howard (Rubber Tip Pencil Co. v.)	490	Mitchell (Tilghman v.)	1, 18		
I		Morrison v. Case	548		
		Morse (Tilghman v.)	421		
		Murtha (Knox v.)	205		
		Mutual Life Ins. Co. (Hamilton v.)	234		
		O			
<i>In re</i> Alabama and Chattanooga R. R. Co.	390	P			
—— Boston, Hartford and Erie R. R. Co.	101, 409				
—— Clark	372, 379				
—— Cornwall	114				
—— Dey	285				
—— Iron Mountain Co.	320				
—— Place	369				
—— Troy Woolen Co.	191				
Iron Mountain Co. (<i>In re</i>)	320				
Iselin (Clark v.)	196				
J					
				Jenkins v. Johnson	516
Johnson (Jenkins v.)	516				
Jurgensen v. Magnin	294				
K					
				Keyser v. Coe	32
Kittle v. Frost	214				
Knox v. Murtha	205				
L					
				Leonard (Williams v.)	476
Lippman (Young v.)	277				
M					
				Magnin (Jurgensen v.)	294
Many (Woolcocks v.)	139	Sawyer v. Bixby	361		
McKinney (Dart v.)	352	Schultz (Baldwin v.)	494		
Meissner v. Devoe Mfg. Co.	363	Scott (Clark v.)	301		
		Shaw v. Grinnell	471		
		Sisson v. Gilbert	185		
		Smith v. Elliott	400		
		Straus (Barnes v.)	553		

T

Tarbox (Daniels v.).....	176
Taylor v. Garretson	186
Tenney v. Townsend	274
Tenth National Bank (Warren v.)..	193
Thayer v. Wales	170
The Comet	323
— Elwine Kreplin	438
— Missouri (United States v.)...	433
— Pennsylvania	451
Tilghman v. Mitchell.....	1, 18
— v. Morse.....	421
Townsend (Tenney v.).....	274
Tremaine (Hitchcock v.).....	386, 550
Troy Woolen Co. (<i>In re</i>).....	191

U

Union Mutual Life Ins. Co. (Gay v.)	142
United States Button Co. (Platt v.)	342
United States v. The Missouri....	433

V

Valentine (Buerk v.).....	479
Verselius (Verselius v.)	189
— v. Verselius.....	189

W

Wales (Thayer v.).....	170
Wallace v. Holmes.....	65
Warren v. Tenth National Bank..	193
Waterbury Brass Co. v. Miller ...	77
Webb v. Quintard	352
Wilkinson v. Pomeroy	513
Williams v. Leonard	476
Wilson v. Griswold	267
Woolcocks v. Many.....	139

Y

Young v. Lippman	277
------------------------	-----

APPENDIX.

I. RULES.....	573
---------------	-----



CASES

CITED IN THIS VOLUME.

A			
Adams v. Edwards.....	59	Doubleday v. Bracheo.....	97
— v. Jones.....	57	Doughty v. West.....	526
American Wood Paper Co. v. Glen's Falls Paper Co.....	418	E	
Ayres v. Revere.....	292	Eames v. Godfrey.....	75, 97
B		Edwards v. Davidson.....	292
Balme v. Hutton.....	273	Eposito v. Bowden.....	243
Barney v. Keith.....	270	<i>Ex parte</i> Dewdney.....	133
Bean v. Smallwood.....	535	— Robinson.....	109
Beebe v. Russell.....	371	— Roffey.....	133
Biddle v. Wilkins.....	277	— Ross.....	133
Bliss v. Haight.....	97	— Woodward.....	133
Brewster v. Shelton.....	106	F	
Brockett v. Brockett.....	420	Ferguson v. Kimball.....	420
Brown v. United States.....	462	Forgay v. Conrad.....	371
Burr v. Duryea.....	163, 164	Foster v. Moore.....	75, 97
Byam v. Farr.....	95, 97	G	
C		Garland v. Carlisle.....	273
Case v. Brown.....	164	Gates v. Benson.....	62
Clement v. Phoenix Ins. Co.....	203	Generes v. Campbell.....	204
Colt v. Massachusetts Arms Co.....	358	Godfrey v. Eames.....	60, 61
Conn v. Penn.....	255	Goodyear v. Hills.....	62
Consequa v. Fanning.....	420	Gordon v. Torrey.....	292
Cox v. Griggs.....	359	Grannis v. Clark.....	270
Craig v. The Hartford.....	371	Green v. Neal's Lessee.....	127
D		Gregory v. Hurrill.....	133
D'Arcy v. Ketchum.....	277	Griswold v. Sedgwick.....	277
Dennistoun v. Draper.....	470	H	
Dental Vulcanite Co. v. Weather- bee.....	59	Hailes v. Van Wormer.....	535
		Hampton v. McConnel.....	277

Hanger v. Abbott.....	128, 248
Harrington v. Snyder.....	269
Hart's Appeal from Probate.....	127
Hind v. Vattier.....	198
Hitchcock v. Tremaine.....	388
Hotchkiss v. Greenwood.....	535
Hussey v. Bradley.....	526

I

India Rubber Comb Co. v. Phelps.....	551
<i>In re</i> Harden.....	136
— Independent Ins. Co.....	570
— Kingsley.....	136
— Ray.....	136
— Sheppard.....	136
— The Boston, Hartford, and Erie R. R. Co.....	409, 410
— The Iron Mountain Co.....	376
— Troy Woolen Co.....	105

J

Jones v. Judd.....	259
Jordan v. Williams.....	446

K

Kentucky v. Dennison.....	446
Kidd, <i>ex parte</i>	133

L

Lent v. Padelford.....	270
Levy v. Stewart.....	127
Lincoln v. Tower.....	277
Lyon v. Mells.....	269

M

Mahler v. Transportation Co.....	48
Manhattan Life Ins. Co. v. War- wick.....	244, 260
Manley v. The People.....	47
Mays v. Manufs. Natl. Bank.....	272
McCluny v. Silliman.....	127
McCormick v. Seymour.....	62

McCormick v. Talcott.....	163
Miller v. Smith.....	514
Mills v. Duryee.....	277
Morris Co. Bank v. Rockaway Mfg. Co.....	286, 293

N

New York Life Ins. Co. v. Clopton.....	245, 249, 260
Norris v. Jackson.....	204

P

Parkhurst v. Kinsman.....	358
Paul v. Virginia.....	254
Peale v. Phipps.....	109
Pitts v. Hall.....	62
Prouty v. Ruggles.....	75, 97

R

Railroad v. Stimpson.....	27
Randall v. Lynch.....	270
<i>Re</i> Clendinning.....	133
Reid v. Hoskins.....	243
Rich v. Lippincott.....	59
Robbins v. Harvey.....	127
Ross v. Duval.....	127
Rubber Co. v. Goodyear.....	27

S

Seymour v. Osborne.....	27, 526
Shelby v. Bacon.....	109
— v. Guy.....	127
Silsby v. Foote.....	371
Smith v. Marrable.....	269
— v. McIver.....	109
Stainthorpe v. Elkinton.....	173
— v. Humiston.....	173
Starbuck v. Murray.....	277
Stewart v. Kahn.....	138
Stimpson v. Railroad.....	27
— v. Woodman.....	535
Sullivan v. Redfield.....	283
Sumner v. Marcy.....	277
Sutton v. Temple.....	269
Sweat v. Boston, Hartford and Erie R. R. Co.....	108

T

The Favorite.....	450
— Isaac Newton.....	450
— Ouachita Cotton.....	460
— People v. Tubbs.....	259
— Queen.....	434
— St. John.....	450
— Venice.....	465
— William Bagaley.....	243
Tilghman v. Mitchell.....	18, 19
— v. Werk.....	19
Tomlinson v. Degraw.....	292
Topping, <i>ex parte</i>	133

U

United States v. Grossmayer.....	255
— v. The Stadacona...	435
— v. Wiley.....	127

V

Van Buren v. Digges.....	256, 514
Vance v. Campbell.....	75, 97
Varnum v. Campbell.....	515

W

Ward v. Smith.....	255
Westerwelt v. Lewis.....	277
Wheeler v. Raymond.....	277
White v. Carpenter.....	420
Wilder v. Gayler.....	515
Williams v. Bank of the United States.....	256
Wilson v. Graham.....	277
Winans v. R. R. Co.....	535
Winder v. Caldwell.....	514
Witetiqui v. D'Arbel.....	470
Withers v. Green.....	514
Wolfe v. Howes.....	259
Wood v. Matthews.....	470
Woods v. Wilder.....	460



CASES
ARGUED AND DETERMINED
IN THE
Circuit Courts of the United States
WITHIN THE SECOND CIRCUIT.

RICHARD A. TILGHMAN

vs.

ROLAND G. MITCHELL. IN EQUITY.

By the use, for decomposing fatty bodies into fat acids and glycerine, of the apparatus described in letters patent of the United States granted to Robert Alfred Wright and Louis Jules Fouché, January 25th, 1859, for "improvements in process for decomposing fats," such fatty bodies are so decomposed by the action of water at a high temperature and pressure, and the process is used which is described and claimed in letters patent of the United States granted to Richard A. Tilghman, October 3d, 1854, for 14 years from January 9th, 1854, for an "improvement in processes for purifying fatty bodies."

The fact, that, in using the Wright and Fouché apparatus, a lower temperature is employed than that designated in the Tilghman patent, and the fact that more time is employed for the operation, and the fact that a continued agitation or circulation of the fat, water, and steam, is kept up, make no difference in the conclusion.

The defendant having employed, before he adopted the Tilghman process, a process in which he used lime and sulphuric acid, and it being shown that, as a result of the use of the Tilghman process, he dispensed with the use of lime and sulphuric acid, and saved a quantity of fat which was lost by the use of the prior process, and obtained an increased profit from the glycerine pro-

Tilghman v. Mitchell.

duced: *Held*, that the plaintiff was entitled to recover, as profits, on an accounting, under a decree, in a suit in equity, such saving of lime, sulphuric acid and fat, and such increased profit in respect of glycerine.

(Before BLATCHFORD, J., Southern District of New York, August 26th, 1871.)

BLATCHFORD, J. This case comes up on exceptions taken by the plaintiff to the report of the master, filed February 7th, 1870. On the 1st of December, 1864, an interlocutory decree was made in the cause, on final hearing, by which it was referred to the master to state and report to the Court an account of the gains and profits which the defendant had received, or which had arisen or accrued to him, from infringing the exclusive rights of the plaintiff by the manufacture, use, and sale of the improvements patented in the letters patent upon which the suit was brought. The bill was filed in 1862. It was founded on letters patent granted to the plaintiff October 3d, 1854, for an "improvement in processes for purifying fatty bodies." The term of the patent was for 14 years from the 9th of January, 1854.

In his specification the patentee says: "My invention consists of a process for producing free fat acids and solution of glycerine from those fatty and oily bodies of animal and vegetable origin which contain glycerine as their base. For this purpose, I subject these fatty or oily bodies to the action of water at a high temperature and pressure, so as to cause the elements of those bodies to combine with water, and thereby obtain at the same time free fat acids and solution of glycerine. I mix the fatty body to be operated upon with from a third to a half of its bulk of water, and the mixture may be placed in any convenient vessel in which it can be heated to the melting point of lead, until the operation is complete. The vessel must be closed, and of great strength, so that the requisite amount of pressure may be applied to prevent the conversion of the water into steam. The process may be performed more rapidly, and also continuously, by causing the mixture of fatty matter and water to pass through a tube or continuous channel, heated to the temperature already mentioned, the requisite pressure for preventing the conversion

Tilghman v. Mitchell.

of water into steam being applied during the process; and this, I believe, is the best mode of carrying my invention into effect. In the drawing hereunto annexed are shown figures of an apparatus for performing this process speedily and continuously, but which apparatus I do not intend to claim as any part of my invention." He then describes the construction of the apparatus shown by the figures in the drawing. The fat or oil, in a fluid state, is placed in a vessel with from one-third to one-half its bulk of warm water, a disc or piston, in the vessel, perforated with numerous small holes, being kept in rapid motion, up and down, in the vessel, to cause the fat or oil and water to form an emulsion or intimate mechanical mixture. A force pump, like those in common use for hydraulic presses, then drives the mixture through a long coil of very strong iron tube, which, being placed in a furnace, is heated by a fire to about the temperature of melting lead. From the exit end of the heating tubes, the mixture, which has then become converted into free fat acids and solution of glycerine, passes on, through another coiled iron tube, immersed in water, by which it is cooled down from its high temperature to below 212° Fahrenheit, after which it makes its escape through an exit valve into a receiving vessel. The specification says: "The iron tubes I have employed and found to be convenient for this purpose, are about one inch external diameter, and about half an inch internal diameter, being such as are in common use for Perkins' hot water apparatus. The ends of the tubes are joined together by welding to make the requisite length, but, where welding is not practicable, I employ the kind of joints used for Perkins' hot water apparatus, which are now well known." The heating tube is coiled several times backwards and forwards, so as to arrange a considerable length of tube in a moderate space. The different coils of the tube are kept about a quarter of an inch apart from each other, and the interval between them is filled up solid with cast iron, which also covers the outer coils or rows of tubes, to the thickness of one-half or three-quarters of an inch. This casing of metal

Tilghman v. Mitchell.

insures a considerable uniformity of temperature in the different parts of the coil, adding, also, to its strength, and protecting it from injury by the fire. The exit valve is so loaded, that, when the heating tubes are at the desired working temperature, and the force pump is not in action, such valve will not be opened by the internal pressure produced by the application of heat to the mixture; and, therefore, when the force pump is not in action, nothing escapes from the exit valve, if the temperature be not too high. But, when the pump forces fresh mixture into one end of the heating tubes, the exit valve is thereby forced open, to allow an equal amount of the mixture, which has been operated upon, to escape out of the cooling tubes at the other end of the apparatus. The specification adds: "No steam or air should be allowed to accumulate in the tubes, which should be kept entirely full of the mixture. For this purpose, whenever it may be required, the speed of the pump should be increased, so that the current through the tubes may be made sufficiently rapid to carry out with it any air remaining in them. Although the decomposition of the neutral fats by water takes place with great quickness at the proper heat, yet I prefer that the pump should be worked at such a rate, in proportion to the length or capacity of the heating tubes, that the mixture, while flowing through them, should be maintained at the desired temperature for ten minutes before it passes into the refrigerator or cooling parts of the apparatus. The melting point of lead has been mentioned as the proper heat to be used in this operation, because it has been found to give good results. But the change of fatty matters into fat acid and glycerine takes place with some materials (such as palm oil) at or below the melting point of bismuth. Yet the heat has been carried considerably above the melting point of lead without any apparent injury; and the decomposing action of the water becomes more powerful as the heat is increased. By starting the apparatus at a low heat and gradually increasing it, the temperature giving products most suitable to the intended application of the fatty body employed, can easily be determined. To

Tilghman v. Mitchell.

indicate the temperature of the tubes," (the heating tubes,) "I have found the successive melting of metals, and other substances of different and known degrees of fusibility, to be convenient in practice. Several holes, half an inch in diameter and two or three inches deep, are bored into the solid parts of the castings surrounding the tubes, each hole being charged with a different substance. The series I have used consist of tin, melting at about 440° F.; bismuth, at about 510° F.; lead, at about 610° F.; and nitrate of potash, at about 660° F. A straight piece of iron wire, passing through the side of the furnace to the bottom of each of the holes, enables the workman to feel which of the substances are melted, and to regulate the fire accordingly. It is important, for the quickness and perfection of the decomposition, that the oil and water, during their entire passage through the heating tubes, should remain in the same state of intimate mixture in which they enter them. I therefore prefer to place the series of heating tubes in a vertical position, so that any partial separation which may take place while the liquids pass up one tube, may be counteracted as they pass down the next. I believe that it will be found useful to fix, at intervals, in the heating tubes, diaphragms pierced with numerous small holes, so that the liquids, being forced through these obstructions with great velocity, may be thoroughly mixed together. I deem it prudent to test the strength of the apparatus by a pressure of ten thousand pounds to the square inch, before taking it into use; but I believe that the working pressure necessary in using the heat I have mentioned, will not be found to exceed two thousand pounds to the square inch. When it is desired to diminish the contact of the liquids with iron, the tubes or channels of the apparatus may be lined with copper. The hot mixture of fat acids and glycerine which escapes from the exit valve of the apparatus, separates by subsidence. The fat acids may then be washed with water, and the solution of glycerine concentrated and purified by the usual means. The fat acids thus produced may, like those obtained by other methods, be used in the manufacture of

candles and soaps, and be applied to various purposes, according to their quality; and, when desired, they may also be first bleached by chemical agents, or purified by distillation, in a current of steam, or in a vacuum, as is now well understood. I prefer that the fatty bodies should be previously deprived, as far as practicable, of such impurities as would cause the discoloration of the fat acids produced; but, when the fat acids are to be finally purified by distillation, this preliminary purification is of less importance. When sulphuric acid, nitrous fumes, or other corrosive agent, shall have been used for purifying, hardening, or otherwise preparing the fatty body to be operated upon, I take care that all traces of it shall be washed out or neutralized, before passing it through the apparatus. Some fatty bodies, (particularly when impure,) generate, during the process, a portion of active or other soluble acid, which might tend to injure the iron tubes. In such cases, I add a corresponding quantity of alkaline or basic matter to the water and oil before they are pumped into the tubes." The claim is in these words: "Having now described the nature of my said invention, and the manner of performing the same, I hereby declare, that I claim as of my invention, the manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure."

This case was brought to a hearing before Mr. Justice Nelson, who, in November, 1864, delivered a written opinion, (*2 Fisher's Patent Cases*, 518,) in which he said: "It will be seen, not only from the specification, but also from the claim, that the improvement patented to the complainant is the invention of a process for producing fat acids and glycerine from fatty or oily bodies, which process consists in the action of water upon these bodies at a high temperature and pressure, and which may be effected in any vessel adapted to such use. There is no claim for the vessel or machinery thus used; but, as it was essential to the validity of the process, as an invention, to show how it may be adapted to practical use, two modes are pointed out—one, any convenient vessel well known to the art, and which some of the witnesses called

Tilghman v. Mitchell.

a digester ; the other, the coil apparatus ; in either of which, as appears from the proofs, the process could be carried into practical effect, according to our construction of the patent. It was urged, on the argument, by the learned counsel for the defendant, that, upon the terms of the specification, the vessel must be entirely filled with the mixture of water and fatty matter, and then be closed, and the contents heated to the point of melting lead, and no steam be permitted to be made in the vessel ; and that, upon this hypothesis, no vessel could be made of sufficient strength to endure the pressure. But we do not agree to this construction. In the first place, the degree of heat was given only as the maximum, and under which the process could be most rapidly carried into effect. For, the patentee, speaking upon this part of the specification, says, that no fixed degree of heat can be given, as the different fatty or oily substances that may be used will require different degrees ; and that, by starting the vessel at a low heat and gradually increasing it, the best temperature may be ascertained for the particular substance used. In the next place, we cannot agree that a fair construction of the specification tends to the conclusion, either that the vessel was to be entirely filled, or that no steam was to be permitted in it. No doubt it is true, as urged for the defendant, if thus filled, and the vessel closed, and the contents heated to the point of melting lead, or under a pressure that would prevent the existence of steam, the process would be utterly impracticable ; and, doubtless, the patentee knew this would be the result, as well as any of the experts. It would require but the commonest knowledge and experience in the business of life to reach such a conclusion. This moderate degree of knowledge, at least, should be kept in view, in construing the general terms of the description. Besides, the patentee does not direct that the vessel should be entirely filled. This is an inference of the learned counsel, from the direction that the vessel must be closed, and be of great strength, so that the requisite amount of pressure be applied to prevent the conversion of the water into steam. Now, all that was in-

tended, as is apparent from the context, by the patentee, was, that the pressure should be so great as to prevent the body of the water in the vessel from passing into steam, as the heated water was the element that separated the fatty acids and glycerine. That there would necessarily be some steam, must have been obvious to the patentee, as well as to any one of common observation. Now, upon this interpretation of the patent, and which we think is the sound one, we repeat what we have already said, that the process could be, and has been, carried into successful operation by the means pointed out by the patentee. Previous to the date of this invention, there were but two modes known, or in practical use, for decomposing fatty substances, and obtaining from them fatty acids and glycerine—one called the lime saponification process; the other known as the distillation process. It is not material to give a particular description of these modes of separating the fatty acids and glycerine. It is sufficient to say, that they were different from the patentee's in the process or mode of producing the result, much more expensive and tedious, and have generally gone out of use, both in this country and in England, since the complainant's improvement has become generally known and practised. We have looked through the proofs in the case with some care, and, without going into them in this opinion, are satisfied that the complainant was the first person who discovered the chemical fact, that fatty or oily substances could be decomposed, and the fatty acids and glycerine separated, by the action of water at a high temperature and under pressure. Then, as to the infringement, it is not material to inquire whether the vessel or machinery used by the defendant is or is not similar to that described in the complainant's patent. These constitute no part of his invention. If the defendant, or the persons under whom he uses his machinery, have discovered new means of carrying into effect the complainant's process, he or they may be entitled to a patent for that improvement. But this would furnish no right to the use of the process. The question here is—does the defendant, whatever may be his

Tilghman v. Mitchell.

vessel or machinery, manufacture or produce fat acids and glycerine, from fatty bodies, by the action of water at a high temperature and pressure, according to the process as explained by the plaintiff in his specification? We are satisfied that he does, and, hence, has infringed the patent. Our conclusion is, that the complainant is entitled to a decree for an injunction and profits."

Voluminous testimony was taken before the master on the reference made to him by the interlocutory decree, and his report is, "that no gains or profits have been proven to have been received by, or to have arisen or accrued to, the defendant, from the manufacture, use, or sale of the improvements patented in the letters patent set forth and described in the order of reference." The plaintiff excepts to the report of the master, and alleges, in his exceptions, that the master erred in not reporting the following facts as proved: "1. That defendant has made a profit by the saving of the quantity of lime and sulphuric acid formerly used by him in his old process, to produce the fat acids and glycerine which he now produces (without using lime or sulphuric acid) by the action of water at a high temperature and pressure. 2. That the quantity of lime and sulphuric acid thus saved by defendant is thirteen and a half pounds of lime and twenty-seven pounds of sulphuric acid on each one hundred pounds of fat decomposed into fat acids and glycerine, by the action of water at a high temperature and pressure. 3. That defendant has made a profit by the saving of the quantity of fat formerly lost and thrown away with the refuse sulphate of lime produced in his old process, but which fat is no longer lost since his use of complainant's process, in which no refuse sulphate of lime is produced or thrown away. 4. That the quantity of fat thus saved by defendant is two pounds on each one hundred pounds of fat decomposed into fat acids and glycerine by the action of water at a high temperature and pressure. 5. That the quantity of fat decomposed by defendant into fat acids and glycerine, by the action of water at a high temperature and pressure, up to the 9th day of

Tilghman v. Mitchell.

January, 1868, amounted to eleven million five hundred and two thousand eight hundred and ninety-two pounds (11,502,892 lbs.) 6. That the saving of thirteen and a half pounds of lime, twenty-seven pounds of sulphuric acid, and two pounds of fat, upon each one hundred pounds of fat decomposed, was made and realized by defendant upon the said eleven and a half million pounds of fat decomposed into fat acids and glycerine. 7. That the values or market prices of the lime, sulphuric acid, and fat, at the several dates when saved by defendant, are those stated by him in his testimony herein. 8. That defendant has made a profit by the increased strength, purity, and value of the glycerine obtained by his use of complainant's process, as compared with that obtained by his former process. 9. That this increase of value of the glycerine amounts to one-fifth of a cent on each pound of fat from which the glycerine was utilized and obtained, by the action of water at a high temperature and pressure. 10. That the quantity of fat from which the glycerine was utilized and obtained by defendant, by the action of water at a high temperature and pressure, amounted to ten million three hundred and thirty-seven thousand one hundred and forty-seven pounds, (10,337,147 lbs.) 11. That the profits made by defendant, by his use of complainant's process, amounted to the principal sum of one hundred and sixty thousand six hundred and ninety-nine $\frac{1}{10}$ dollars (\$160,699 05,) being the value of the following articles saved, at their market price when saved, viz :

Lime saved,	1,552,889 lbs.	Value,	\$11,243 26
Sulphuric acid saved,	3,105,778 "	"	100,663 51
Fat saved,	230,057 "	"	28,118 01
Profit on glycerine obtained from 10,337,147			
lbs of fat, $\frac{1}{5}$ cent per lb. fat,			20,674 27
			<hr/> \$160,699 05

together with interest on said sums from the dates when the saving was realized, as set forth in the calculation appended

to the printed argument submitted by the counsel for complainant."

The plaintiff contends, that the defendant, by manufacturing fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure, according to the plaintiff's process, instead of by the process used by him up to the time he adopted the plaintiff's process, has saved the quantities specified, of lime, sulphuric acid, and fat, in working the specified quantities of fat, and has made the specified additional profit from the specified quantity of glycerine; that such saving and profit are due to the use of the plaintiff's process; and that the defendant must account for the same as profits, under the interlocutory decree. The defendant contends that he has made no gains or profits by the use of the plaintiff's invention; that such invention is incapable of practical use; and that whatever saving the defendant has made by working the process which he uses, is due to something other than any invention of the plaintiff's.

The defendant formerly used, in his manufactory, what was known as the lime saponification process. Twenty-five pounds of water and one hundred pounds of fat were put into a vat. From nine to fourteen pounds of lime were slacked in another vat with sixty-six pounds of water, and the product was then gradually poured into the fat and water, which were boiling, and the whole was kept boiling for about eight hours. It was then allowed to stand and cool, and the water was drawn off, carrying in it the glycerine. The residue, called lime soap, was then decomposed by sulphuric acid, and produced free fat acids. The defendant, since abandoning this old process, has worked under and according to letters patent of the United States, granted to Robert Alfred Wright and Louis Jules Fouché, January 25th, 1859, for "improvements in process for decomposing fats." All the fat he has treated has been treated according to the process, and by the apparatus, described in that patent. The specification of that patent states, that the apparatus which it describes is chiefly intended for the decomposition of fatty

substances into fatty acids and glycerine. A detailed description of the apparatus and of its action is given. There are two boilers. The lower boiler, or first boiler, is completely filled with water. The upper boiler, or second boiler, is filled with water up to one-third of its height, and then filled up to a certain point with the fatty bodies to be decomposed. The first boiler, which is strong enough to resist a pressure of from ten to twenty atmospheres, is gradually heated till the proper pressure, according to the nature of the fatty matter, is attained. The superheated water in the first boiler ascends through a tube, which runs from the top of the first boiler into the upper part of the second boiler, and there terminates in a rose jet discharging downwards. The water, passing through the holes in the rose jet, descends through the fatty matter, and passes out of the bottom of the second boiler, through a tube which enters the top of the first boiler, and passes through its interior to near its bottom, and there discharges into it. The mixture of fatty matter and water, carried down by the passage from the second boiler to the first boiler, is again heated, to recommence its ascending motion, and so on. A continuance of this operation during a period of from five to eight hours, according to the nature of the fatty bodies operated on, and according to the variation of pressure, varying from ten to twenty atmospheres, decomposes the fatty bodies into glycerine and fatty acids, the glycerine remaining dissolved in the water, and the fatty acids floating in the second boiler. The patentees say, in their specification: "We are aware that, firstly, the decomposition of fatty bodies by water, under the influence of heat and of pressure, is a well known scientific fact. Water is substituted for the organic basis; it forms a perfect and fixed combination with the fatty acids, while the glycerine is dissolved in the excess of water. Secondly, that, as this chemical action takes place under the influence of a weak affinity, it is necessary, in addition to the above named physical and chemical conditions, to insure a perfect molecular agitation of the whole mass, and that we wish it to be understood that

what we wish to claim and establish as of our invention, consists of an apparatus wherein the water and the fatty matters are heated separately in two different boilers. The first boiler is heated by the source of heat, while the second boiler is heated by the first boiler. In these boilers, the agitation necessary for the chemical action and combination is produced by the pressure of the heated water in the first boiler. This water circulates continuously from the first boiler to the second boiler, and from the second boiler to the first, in a continuous and self-acting or automatic manner, without interruption. The characteristics of our apparatus are, that it produces agitation by circulation alone, a continuous and automatic circulation, produced by the pressure of water. Lastly, our apparatus effects the chemical action in a continuous manner, without the aid of any manual or other assistance." The claim of the Wright and Fouché patent is as follows: "Having described the nature of our invention, and the manner in which the same is to be performed, we do not claim the application of superheated water for decomposing fatty bodies, nor the form of the apparatus above described, which may vary somewhat according to conditions and circumstances; but what we claim as our invention is, producing a continuous automatic circulation of highly heated water, in a very finely divided state, through the bodies under treatment, by means of an apparatus constructed and employed substantially as herein shown and described."

It is manifest, that, in using the Wright and Fouché apparatus, the defendant decomposes fatty bodies into fat acids and glycerine by the action of water at a high temperature and pressure, and thus uses the plaintiff's process. But the defendant urges that he works at a lower temperature than that designated by the plaintiff, and takes more time for the operation, and employs a continued agitation or circulation of the fat, water, and steam; and that these are features not described in the plaintiff's patent, and features to which all the profits made by the defendant are entirely due. Stress is particularly laid on the fact, that, without the use of means to

Tilghman v. Mitchell.

produce agitation and circulation of the fat, water, and steam, the employment of heat and pressure would result in no pecuniary profit. The other points urged are disposed of by the opinion of Mr. Justice Nelson.

It is a mistake to contend that the plaintiff does not, in his specification, enforce the necessity of keeping up an intimate mechanical mixture of the fat and water during the operation. He directs that the fat and water shall be mixed, and he calls, in many places, the liquid that is being operated upon, a mixture. His description and drawing of the coil apparatus state and show that a disc or piston, perforated with numerous small holes, is kept in rapid motion, up and down, in the vessel into which the fat and water are first put, to cause them "to form an emulsion or intimate mechanical mixture." He also states, in reference to the coil apparatus, that "it is important for the quickness and perfection of the decomposition, that the oil and water, during their entire passage through the heating tubes, should remain in the same state of intimate mixture in which they enter them;" and he suggests two devices for maintaining such thorough mixture. It is impossible to maintain the proposition that the plaintiff's specification ought not to be construed as fully disclosing the desirableness of keeping the fat and water intimately mixed during the operation, with a view to effecting a speedy and complete decomposition, as well when the "convenient vessel" first named is used, as when the coil apparatus is used. The evidence is, that the decomposition will take place without mixture, in a time proportioned to the degree of heat and the extent of the area of surface contact between the fat and the water. Having indicated the propriety of using means to maintain an intimate mixture of the fat and water, the plaintiff is entitled to use, in carrying out his process, any means then known and used in the same art, for maintaining a mixture of fat and water. In the lime saponification process, the stirring or agitation of the fat, water, and lime during the process, in order to keep up an intimate contact between the particles, was employed; and the proofs

Tilghman v. Mitchell.

show the description or use, before the date of the plaintiff's patent, of a vertical churn agitator, to mix fat, water, and lime while being boiled in an upright boiler under pressure, of a rotary paddle-wheel agitator, to mix fat, water, and lime while being boiled in a horizontal boiler under pressure, and of a stirrer rotating on a vertical shaft, to mix fat, water, and lime while being boiled in an open tub. The plaintiff's specification is addressed to persons skilled in the department of manufacturing to which it is applicable; and the evidence is abundant to show, that such persons would have understood, as a matter of course, that, with a view to practical and profitable manufacturing, there must be agitation of the mass, and would have readily used known devices at hand to produce such agitation.

The defendant has entirely failed to show that the plaintiff's process, carried out as described in his patent, is not practicable or practical. It was put in practical operation in London in 1857, a patent having been taken out for it in England, by the plaintiff, January 9th, 1854. It was put in operation in Cincinnati, Ohio, in 1860, and has been in use, under license from the plaintiff, in the United States, ever since, there being ten factories in the United States working under such license. The defendant was notified by the plaintiff in September, 1860, not to infringe the patent, and what he has done has been done wilfully, and not innocently.

It is abundantly shown, that the saving of lime and sulphuric acid and fat, and the increased profit from the glycerine produced, result from the use of the plaintiff's process, and not from the special apparatus of Wright and Fouché. Such apparatus is one means of producing stirring or agitation and mixture. The plaintiff's process, when carried on with other means of maintaining the mixture, produces, as is shown by the evidence, the same saving of lime and sulphuric acid, which is produced by the defendant in using the Wright and Fouché apparatus; and such apparatus is useless unless a high heat and pressure be employed. The

defendant previously used the lime saponification process, and abandoned it for the plaintiff's process. He must be regarded as having made directly, by using the plaintiff's process, the saving of lime, sulphuric acid, and fat, and the profit in respect of glycerine, which existed between the use of the two processes, and which saving and profit he would not have made if he had continued to use the old process. He has not made the saving by using the Wright and Fouché mixing apparatus. Ropes used the heat and pressure with a paddle-wheel mixer, and made the saving of lime and sulphuric acid. Jones used a pump to mix, with heat and pressure, and made the same saving.

The use of superheated water is the effective decomposing agent in the defendant's process. If the use by the defendant of the Wright and Fouché mixing apparatus saves labor or fuel, as compared with any prior process, the plaintiff is not entitled to the saving thus effected. But the defendant has not shown any such saving of labor or fuel. The proof as to the saving of lime, sulphuric acid, and fat, and as to the increased profit on the glycerine produced, at the quantities and values set forth in the plaintiff's exceptions, is full and clear.

On the hearing, the defendant's counsel did not dispute, that, if the saving of the lime, sulphuric acid, and fat was due to the use of the plaintiff's process, the plaintiff was entitled to the value of such saving, as profits. That is, undoubtedly, a correct principle, as applicable to an accounting for profits, in a case of this description, in equity.

The plaintiff's exceptions above set forth must be allowed. But, as the calculations based on the evidence taken before the master, and furnished by the plaintiff, show just how much the plaintiff is entitled to recover, it is unnecessary to send the case back to the master. The account was taken down to the expiration of the patent, on the 9th of January, 1868. The savings are calculated at thirteen and a half pounds of lime, twenty-seven pounds of sulphuric acid, and two pounds of fat, on each one hundred pounds of fat worked.

Tilghman v. Mitchell.

This, at the prices shown by the evidence, makes the saving, in the aggregate, of lime, sulphuric acid, and fat, \$140,024 78. The increased profit on glycerine, at one-fifth of a cent per pound on the quantity of fat worked, was \$20,674 27. The saving of lime, sulphuric acid, and fat, is calculated from and including the 1st of July in each year, to and including the 30th of June in the following year, covering the period from and including December, 1860, to and including January 9th, 1868. The increased profit on the glycerine is calculated from and including the 1st of January in each year, to and including the 31st of December in the same year, but only covers the fat worked from and including July 1st, 1861, to and including January 9th, 1868. I think that the plaintiff is entitled to interest from and after the close of each of such years, on the ascertained value of the savings and profits for the twelve months next preceding. Making up the account on these principles gives the following results:

Savings of Lime, Sulphuric Acid, and Fat.

For the Year ending	Quantity of Fat worked.	Value of Lime, Sulphuric Acid, and Fat saved.	Interest to September 1st, 1871	
			Years.	Per cent.
June 30th, 1861.....	Lbs. 1,165,745	\$8,998 86	10 1-6	71 1-6
" " 1862.....	" 1,502,316	11,068 28	9 1-6	64 1-6
" " 1863.....	" 1,050,426	8,718 84	8 1-6	57 1-6
" " 1864.....	" 1,395,143	14,556 26	7 1-6	50 1-6
" " 1865.....	" 1,998,051	23,998 58	6 1-6	43 1-6
" " 1866.....	" 1,612,263	26,254 43	5 1-6	36 1-6
" " 1867.....	" 2,001,163	28,344 53	4 1-6	29 1-6
To Jan'y 9th, 1868.....	" 781,787	8,096 95	3 23-36	25 17-36
	<u>Lbs. 11,502,892</u>	<u>\$140,024 78</u>		
				<u>\$60,287 26</u>

Tilghman v. Mitchell.

Increased Profit from Glycerine sold.

For the Year ending	Amount received for Glycerine sold.	Quantity of Fat worked.	Profit at 1-5 of a Cent per lb. of Fat worked.	Interest to September 1st, 1871.		
				Years.	Per cent.	
Dec. 31st, 1863....	\$6,048 88	Lbs. 1,502,316	\$8,004 68	8 2-3	60 2-8	\$1,322 81
" " 1863....	7,543 97	" 1,050,496	2,100 85	7 2-3	58 2-8	1,127 46
" " 1864....	16,830 16	" 1,395,143	2,790 28	6 2-3	46 2-8	1,802 18
" " 1865....	15,278 70	" 1,968,061	3,986 10	5 2-3	39 2-8	1,661 15
" " 1866....	17,904 88	" 1,612,263	3,226 52	4 2-3	32 2-8	1,054 00
To Jan'y 9th, 1868..	85,777 94	" 2,782,949	5,565 89	8 23-86	25 17-86	1,417 76
	<u>\$98,774 47</u>	<u>" 10,387,147</u>	<u>\$30,674 87</u>			<u>\$8,805 81</u>

This makes the total amount for which the plaintiff will be entitled to a decree, September 1st, 1871, \$229,291 62. Let a decree be entered of that date for that amount, with costs.

George Harding, for the plaintiff.

Charles M. Keller and *Stephen D. Law*, for the defendant.

RICHARD A. TILGHMAN

vs.

ROLAND G. MITCHELL. IN EQUITY.

On a motion for a preliminary injunction to restrain the infringement of a patent which had been extended, although its extension had been opposed by the defendant, on testimony introduced by him, such injunction was granted, it appearing that the novelty of the invention and the validity of the patent had been sustained, on final hearing, in several suits in equity.

The construction put in the case of *Tilghman v. Mitchell*, (2 *Fisher's Patent Cases*, 518,) on the specification of the patent granted to Richard A. Tilghman, October 8d, 1854, for fourteen years from January 9th, 1854, for an "improvement in processes for purifying fatty bodies," approved.

Tilghman v. Mitchell

If the extension of a patent is regular on its face, no question of irregularity or fraud in granting it can be raised by an infringer, in a suit against him for infringement.

Although an inventor obtained a patent in the United States for his invention, after he obtained a patent in England for it, and the English patent expired previously to the granting of an extension of the patent for the United States, the fact that such English patent expired before the patent for the United States was extended, forms no objection to the validity of such extension.

The novelty of the invention covered by the said patent to Tilghman, and the validity of the said patent, sustained.

The defendant not allowed to give a bond as security, in place of having a preliminary injunction issued against him.

The defendant expressing a willingness to take a license from the plaintiff, under the extended patent, at the usual rate of license established by the plaintiff, an order was made, that, unless the defendant should accept and execute a license, duly executed by the plaintiff, in the usual form, within ten days, under the extended patent, an injunction should issue, as prayed for in the bill.

(Before BLATCHFORD, J., Southern District of New York, August 26th, 1871.)

BLATCHFORD, J. This is a motion for a provisional injunction, founded on letters patent granted to the plaintiff, October 3d, 1854, for fourteen years from January 9th, 1854, for an "improvement in processes for purifying fatty bodies." The patent was, on the 23d of November, 1867, extended by the Commissioner of Patents, for seven years from January 9th, 1868. The bill was filed in March, 1871. The defendant is the same person who was the defendant in the suit in equity brought against him in this Court by the plaintiff on the original patent, before its extension, and in which suit a decision has just been given by this Court, (*ante*, p. 1,) on a hearing on exceptions to the master's report.

The bill sets forth, that a suit in equity was brought, in Ohio, by the plaintiff, in 1859, against one Werk, for infringing the patent; and that a decree was made in it, in 1860, (2 *Fisher's Patent Cases*, 229,) adjudging that the patent was valid. It also sets forth the bringing of the said suit in this Court against the defendant, and the decision therein, on final hearing, (2 *Fisher's Patent Cases*, 518,) adjudging the patent

Tilghman v. Mitchell

to be valid, and that the defendant had infringed it. It also, sets forth, that, in 1868, the plaintiff brought two suits in equity in Ohio, one against Werk and others, and one against Shillito, for infringing the patent, as extended; that the defendants in those suits alleged in their answers, in defence, that the extension of the patent was void for want of jurisdiction in the Commissioner of Patents, and for want of due publication, and for want of a proper account of profits, and because of fraud and collusion between the plaintiff and the Commissioner of Patents; that such defendants, also, in their answers, set up, in support of a defence of want of novelty in the invention, various publications and patents, fourteen in number, references to which are specified, so that they can be identified; that such defendants, also, in their answers, alleged that the plaintiff's invention, as described and claimed in his patent, was not useful and practicable, and, in proof thereof, offered in evidence the testimony of one Moinier, a witness residing in Paris, France, which testimony had originally been taken on the reference before the master in such first suit against the defendant in this Court, and is on file in this Court, and was admitted by consent of the plaintiff to be read in said two suits under the extended patent against Werk and others and Shillito; that the defendants in said two suits examined as witnesses the defendant Mitchell, and his former partner Florencé Verdin, to prove the want of novelty, of utility, and of practicability, in the invention described and claimed in the patent; that Werk and Shillito had been examined as witnesses on the part of the defendant Mitchell in such first suit against him in this Court; and that said two suits in Ohio, under the extended patent, went to final hearing in May, 1870, and it was decreed that the plaintiff was the original inventor of the invention patented to him, and that the patent and the extension thereof were valid. An affidavit is annexed to the bill, setting forth, that, on the 2d of March, 1871, the defendant was using and working at his factory, in the city of New York, the same process for decomposing fat into fat acids and glycerine by the action

of water at a high temperature and pressure, in the Wright and Fouché apparatus, which he had been using for several years previously and since the year 1861 ; that, in May, 1869, the defendant was decomposing every week about forty thousand pounds of fat into fat acids and glycerine, by the action of water at a high temperature and pressure, in the Wright and Fouché apparatus, by the same process which he had been using since the year 1861 ; that, in his answer to the bill in such first suit against him in this Court, the defendant stated that he was then decomposing fat into fat acids and glycerine by the action of water at a high temperature and pressure, in the Wright and Fouché apparatus, and that the said process of decomposing fats in the Wright and Fouché apparatus, as practised by the defendant, was adjudged by this Court, in November, 1864, to be substantially the same, in principle and operation, as that patented to the plaintiff, and to be an infringement thereof.

The defendant opposes the motion on an answer and on affidavits. The answer avers, that the Ohio suit, of 1859, against Werk, was decided without a full or complete presentation to the Court of the state of the art bearing upon the branch of manufacture to which the patent relates, and that such decision is not, and was not, in any manner, conclusive as to the real merits of the issues in said cause ; that the first suit in this Court against the defendant was decided without a full and complete presentation to the Court of all the testimony bearing upon the issues in the suit, and upon the state of the art relating to the branch of manufacture to which the patent pertains ; that the defendant, since such decision, has obtained certain testimony as to the practical operation of the alleged invention described in the patent, as applied or demonstrated by the plaintiff, and under his direction, proving its practical inability to produce the results claimed by the plaintiff in his patent ; that such testimony is highly pertinent to the issues in said cause, and, if it could have been introduced therein before the final hearing thereof, no decree, on final hearing, such as was made, would have been made, but such evidence would have shown the invalid-

ity of the patent, and would have prevented any decree in the suit against the defendant; that, by the decree in the suit, liberty was given to the defendant to give bond in the penal sum of twenty thousand dollars, with a condition to pay, on final decree, either in this Court or in the Supreme Court, on appeal, all sums of money which might be found due from him to the plaintiff, on an accounting before the master, in which case no injunction should issue against the defendant until a final decree in the cause; that the defendant duly gave such bond in such sum, and has since continued to carry on his business in the same manner as he was doing before the rendering of such decision and the entry of such decree against him, and that the plaintiff has made no application to have such order modified or set aside, or to have any injunction issued; that the master in said suit, under a reference, has reported that no gains or profits have been proven to have been received by, or to have arisen or accrued to, the defendant, from the manufacture, use, or sale of the improvements patented in the plaintiff's patent; that, in such suit against the defendant, the decision of the Court was made under a misapprehension on its part as to the mode of operation in the process described in the plaintiff's patent, Mr. Justice Nelson considering that the specification did not require either that the vessel containing the mixture of water and fatty matter was to be entirely filled therewith, or that no steam was to be permitted in it, whereas the specification makes both such conditions necessary; that, except for such misapprehension, the decision would not have been against the defendant; that the report of the master is correct; that the application for the extension of the plaintiff's patent was not made or proceeded with in conformity with law, and in such a manner as to give the Commissioner of Patents jurisdiction of the application, and the extension was obtained by fraudulent and deceptive proceedings as against the public, and by collusion between the plaintiff and the then Commissioner of Patents; that the plaintiff, before obtaining his patent in the United States, had obtained in England a patent

for the same invention, which English patent had expired previously to the extension of the patent for the United States, and that no prolongation of the term of the last named patent could legally be granted under the provisions of the law regulating extensions; that, in the suits brought in Ohio, in 1868, the defendants therein did not set up, as a defence, that the extension of the patent was void by reason of want of jurisdiction in the Commissioner of Patents, and the defences therein set up as to the invalidity of such extension were not urged or argued in the Court, on final hearing, and were not considered or passed upon by the Judge by whom the suits were decided, and it was not decided by the Court that the extension of the patent was valid; that the decision of the Court in the two suits brought in Ohio, in 1868, was not founded on the testimony introduced in those suits, and was not a decision on the real merits of those suits, as established by the evidence therein, but such decision was based upon, and declared to be given by reason of, the adjudications previously made in the suit in Ohio, and in the suit in this Court; that the Judge who rendered the decision declared in it, that he was not at liberty to consider the questions involved, unembarrassed by previous judgments, and that, although the record in the suits, in reference to views which a superior Court might take, contained material additional proof, they were not such as to authorize the same Court to overrule its former deliberate adjudications, and the cases already decided as to the patent must be followed, and that said Judge, after having referred to the defences set up in those suits, used the following language: "I thus briefly advert to the leading objections, solely to show that they are disposed of by the previous cases, and not to discuss them upon principle. Were I at liberty to treat the whole case upon principle, I fear I should be compelled to give the patent a more limited construction than it has received;" that, in those suits, the Court refused to order an injunction against the defendants therein, but held that a bond should be received from the defendants; that the plaintiff has never

Tilghman v. Mitchell.

applied to practical use the improvements described in his patent; that, as so described, they are incapable of being applied to practical use; that the patent is void, for the reason that no adequate means are described or shown in the specification or drawings, whereby the alleged invention can be reduced to practice; that the means of practising such invention, described in the specification and shown in the drawings, and stated in the patent as being, in the belief of the patentee, the best mode of carrying the invention into effect, are pernicious and dangerous, owing to the degree of heat and pressure required, and would also result in the destruction of the glycerine of the fat, and be otherwise impracticable and devoid of utility; that the claim of the patent does not set forth a patentable subject-matter, and that, by reason thereof, the patent is void; that, in view of the state of the art to which the patent pertains, the defendant has a right to use the process he employs, it being a far superior process to that described in the patent, and differing therefrom in principle, in mode of operation, and in effect produced; and that he is now using, and has been using since the 9th of January, 1868, the same process for decomposing fatty acids which he was using at the time of the commencement of the former suit against him, and that he has continually used such process, and has never used any other process. The answer further states, that the defendant has, since the 9th of January, 1868, decomposed fat into fat acids and glycerine by a process or method patented to Wright and Fouché, in which water at a high temperature and under pressure is employed, but an active automatic circulation of the moisture through the fat is provided for, and such circulation is absolutely necessary for the operation of the process, and without such circulation the process would be more expensive than saponification by lime; that the process so used by the defendant differs materially from the process patented to the plaintiff, not only in degree of temperature and pressure, but in the circulation of the moisture through the fat, which is not permitted by the plaintiff's process; that the defendant's process

Tilghman v. Mitchell.

is the same as that referred to in his answer to the bill in the former suit by the plaintiff against him; that the process as employed by him since the 9th of January, 1868, is as follows: The apparatus consists of two boilers connected by two pipes, one of which connects the top of the lower boiler with the upper portion of the upper boiler, and the other connects the bottom of the upper boiler with the lower part of the lower boiler, running through the top of the latter. The lower boiler and a small portion of the upper boiler are filled with hot water, and the remaining portion of the upper boiler is filled to within about two feet of its height, or about ten-twelfths full, with hot fat. Fire is then applied to the lower boiler, and the water subjected to a temperature of about 374° Fahrenheit. The water, being heated, rises, with the steam, through the first-mentioned pipe, to above the surface of the fat, then descends through the fat with the water formed by the condensation of the steam, to the bottom of the upper boiler, whence it is conducted, by means of the secondly mentioned pipe, to the lower part of the lower boiler; and this process of circulation is continually repeated. The pressure is run up to about twelve atmospheres, and maintained about twelve hours. The boilers used are about two feet in diameter, the upper boiler being about twelve feet in height, and the lower boiler about six feet in height—that the process used by the defendant prior to December, 1860, was substantially as follows: A tank was used, provided with steam pipes fitted with holes, to let the steam enter the tank. Into this tank was put about a foot of water, and into this tank the fat was thrown, and heated by steam, when there was added the milk of lime with a large excess of water. The tank was then covered, and the steaming continued for six or eight hours. This operation being completed, the glycerine produced was drawn off, and the fat acids in combination with the lime shovelled into an adjacent tank and heated by steam, with diluted sulphuric acid. The fat acids thus liberated were then drawn off and settled, and then run into pans to form cakes, which

Tilghman v. Mitchell.

were then subjected to hydraulic pressure, and afterwards pressed in a hot press until all traces of oleic acid were pressed out. Fourteen pounds of lime and twenty-eight pounds of sulphuric acid were used to each hundred pounds of fat—that, since the 9th of January, 1868, the defendant has decomposed into fat acids and glycerine about four and a half million of pounds of natural fat, saving, by the Wright and Fouché process used by him, about six hundred and thirty thousand pounds of lime, and about eleven hundred and sixty thousand pounds of sulphuric acid; that, by the Wright and Fouché process used by the defendant since January 9th, 1868, there may have been two per cent. of fat saved, depending upon the care exercised in obtaining the product; and that the solution of glycerine now obtained by the defendant is of greater strength and purity than that obtained prior to the use by him of the Wright and Fouché process, commenced in December, 1860. The answer then sets up, as establishing the want of novelty in the plaintiff's invention, twenty-one publications and patents. All of these except six were either set up in the answer of the defendant in the former suit against him, or in the answers in the Ohio suits of 1868, or were introduced on the reference before the master in such former suit against the defendant. Those six are the *Encyclopédie Roret*, of 1849; the French patent to M. Appert, of 1823, in volume 15 of the *Brevets d'Invention*, of 1828; the 15th volume of the *Journal of the Franklin Institute*, of 1848; the English patent to William Hawes, of 1839; the English patent to Samuel Guppy, of 1839; and the English patent to Alexander Alliot, of 1851. The answer also avers, that, upon the questions of novelty, originality, and the prior state of the art, as affecting the validity of the plaintiff's patent and the question of infringement, sixteen of the said twenty-one publications and patents were not cited or offered in evidence by the defendant in the former suit against him, and were not known to the Court at the time the decree was made, and that such evidence would have materially affected the decree in the suit.

Tilghman v. Mitchell.

I must regard the decisions in the three suits in Ohio, and the decision of Mr. Justice Nelson in the suit in this Court, followed by the decision on the hearing on the exceptions to the master's report in that suit, and the fact of the extension of the patent, its extension having been, as it appears, opposed by the defendant, on testimony put in by him, as establishing the novelty of the plaintiff's invention and the validity of his patent. So, too, the fact that the use of the Wright and Fouché process is an infringement of the patent, cannot be doubted.

The objection, that the plaintiff's invention, as described in his patent, cannot produce the results claimed in the patent, has been considered and disposed of adversely to the defendant, in the decision given on the hearing on the exceptions to the master's report, in the former suit against the defendant.

The objection, that the decision of Mr. Justice Nelson was made under a misapprehension on his part as to the mode of operation in the process described in the plaintiff's patent, is also without foundation. It is alleged, that Mr. Justice Nelson considered that the plaintiff's specification did not require either that the vessel containing the mixture of water and fatty matter should be entirely filled therewith, or that no steam was to be permitted in it, and that the specification makes both such conditions necessary. On full consideration, I concur in the views of Mr. Justice Nelson on these points, and have no doubt that his interpretation of the specification in regard to them was correct.

As to the validity of the extension, as it is regular on its face, no question of irregularity or fraud in granting it can be raised by an infringer, in a suit against him for infringement. (*Railroad v. Stimpson*, 14 *Peters*, 458; *Stimpson v. Railroad*, 4 *Howard*, 404; *Rubber Co. v. Goodyear*, 9 *Wallace*, 796; *Seymour v. Osborne*, 11 *Wallace*, 543, 545.)

The expiration of the English patent before the patent for

the United States was extended, formed no objection to such extension.

In the decision of the Court, given by Judge Emmons, in the two suits brought in Ohio, in 1868, he used this language: "Although the record in this case, in reference to some views which a superior Court may possibly take, contains some material additional proofs," (beyond those in the previous case in Ohio, and those before Mr. Justice Nelson in the case in this Court,) "still they are not such as to authorize the same Court to overrule its former deliberate adjudications, and to disregard the judgments of a coördinate one in a case in all respects substantially like it. Especially is this so where the Judge delivering the opinion has taken so leading a part in all the discussions upon this subject in the Court of last resort. After much consideration, I am confident that, without a violation of judicial propriety and the best interests of all who pursue or defend here, the cases already decided between these same parties must be followed. It would greatly impair the influence of the Court, and the confidence of the suitors, if any succeeding Judge turned it into one of appeal for all questions previously decided. Where doctrines are reconsidered, as often they are and should be, the circumstances of the case must be exceptional, and furnish the justification for the action in each instance where it is taken. There are none such in this case. More than ordinary deliberation attended the previous discussions and judgments." These are wise and sound views, and are fitly applicable to the action of this Court on the present motion. Nothing is now presented to this Court which would authorize it to overrule the deliberate adjudication formerly made by it. That adjudication is fortified by the decisions of the Court in Ohio.

The point urged, that the defendant uses a different degree of heat and a different pressure from those set forth in the plaintiff's patent, is considered and disposed of by Mr. Justice Nelson, in his opinion.

In support of the objection that the plaintiff never ap-

Tilghman v. Mitchell.

plied to practical use the improvements described in his patent, and that they are incapable of being applied to practical use, the defendant relies on two letters written by the plaintiff, one dated London, June 25th, 1856, to Thomas Emory & Son, of Cincinnati, and the other dated London, July 20th, 1857, to M. de Fontaine Moreau. But these letters lead to the opposite conclusion. The first letter shows, that the plaintiff had, in factories in London and Paris, exposed the fat and water to a higher heat and pressure for a shorter time, and to a lower heat and pressure for a longer time, and had come to the conclusion that the latter mode of operation was the more convenient one, and had, in connection with it, used an agitator in an ordinary digester; and that he was about putting up at Price & Co's works, in London, an apparatus on that plan, capable of treating several tons per day. The lower heat and pressure are within the patent, as has been shown by Mr. Justice Nelson, and the question of the use of an agitator was considered in the opinion given on the hearing of the exceptions to the master's report, in the former suit in this Court against the defendant. The second letter shows, that, at the time it was written, the plaintiff's process was being successfully worked in the factory of Price & Co., in London, at a moderately low pressure. In 1860, the plaintiff's process was put into practical use in Cincinnati, in an old form of apparatus. In 1862, it was put into use in Cincinnati, under license from the plaintiff, in another old and different form of apparatus; and, by 1867, ten factories in the United States were working the process under such license. In September, 1860, the defendant was notified by the plaintiff, in writing, not to infringe the patent by using the process he has used, but, in December, 1860, he commenced to practically operate with the Wright and Fouché apparatus, and he has ever since continued to do so.

The defendant, in using the apparatus described by him in his answer as that which he uses, uses the plaintiff's process, and infringes the patent. The process he used down to the time he adopted the plaintiff's process, was the lime

Tilghman v. Mitchell.

saponification process. He now saves the lime and sulphuric acid which he used in that process, and also saves fat, and obtains a solution of glycerine of greater strength and purity. The answer admits, that, up to the time it was put in, the defendant had, since the 9th of January, 1868, decomposed into fat acids and glycerine about 4,500,000 pounds of fat, and saved, by the use of the Wright and Fouché apparatus, about 630,000 pounds of lime, and about 1,160,000 pounds of sulphuric acid. If the price of lime be taken at only $\frac{1}{100}$ of a cent per pound, and the price of sulphuric acid at only $2\frac{1}{2}$ cents per pound, the saving of lime for 40 months would have been \$4,725, and the saving of sulphuric acid for the same time would have been \$29,000. The saving of fat, at 2 per cent. of the fat worked, would have been 90,000 pounds, for the 40 months, equal, at 12 cents per pound, to \$10,800. If the increased profit on glycerine, by reason of its greater strength and purity, be called $\frac{1}{4}$ of a cent per pound on the fat worked, such profit, for the 40 months, would have been \$9,000. Thus, the defendant may properly be regarded as having saved, in 40 months, by the use of the plaintiff's process, \$53,525, or at the rate of \$1,338 12 per month. The bases of calculation are those established on the hearing before the master in the former suit in this Court against the defendant, and the result shows the direct saving or profit which the defendant is making by continuing his infringement.

The defendant points to nothing in the six publications and patents which his answer sets up, and which had not, in previous suits, been set up or introduced in evidence, which goes to destroy the novelty of the plaintiff's invention, and there is nothing in the other fifteen to justify the withholding of an injunction.

The great merit and value of the plaintiff's invention, not only in the manufacture of candles, but as a process for obtaining pure glycerine for use in the arts, are shown by evidence, and it is quite time that he should have effective protection. After the decision in his favor by Mr. Justice

Tilghman v. Mitchell.

Nelson, on final hearing, a perpetual injunction would undoubtedly have been ordered to issue, as a part of the interlocutory decree, but for some special considerations which induced the Judge to suspend the injunction until the final decree, if the defendant should give a bond in \$20,000, conditioned to pay, on final decree, either in this Court or in the Supreme Court, all sums of money which should be found due from him to the plaintiff on the accounting before the master, on the filing and confirmation of the report on such accounting. The bond was given and no injunction was issued. If the original term of the patent had not expired, a perpetual injunction would now be ordered, as a part of the final decree. The plaintiff ought to be in no worse position because his patent has been extended, and he is compelled to make the present motion. I see no ground for allowing a bond to be given in this suit, as security, in place of issuing an injunction. The case is a clear one, on all points. Let an injunction issue, according to the prayer of the bill.

WHEN the order for the injunction came up for settlement, the defendant expressed his willingness to take a license from the plaintiff, under the extended letters patent, at the usual rate of license established by the plaintiff. Thereupon, an order was made, that, unless the defendant should accept and execute a license, duly executed by the plaintiff, in the usual form, within ten days, under the extended letters patent, an injunction should issue, as prayed for in the bill.

George Harding, for the plaintiff.

Charles M. Keller and *Stephen D. Law*, for the defendant.

JOHN H. KEYSER

vs.

ENOCH COE. IN EQUITY.

Whether, where noxious odors generated by the defendant, in a manufactory carried on by him outside of the jurisdiction of this Court, are transmitted through the air to the residence of the plaintiff situated within such jurisdiction, and there inflict injury, this Court has jurisdiction to arrest the evil, the parties being properly before it, *quere*.

Under the patent of Connecticut, of March 19th, 1681, known as the Warwick patent, and the charter of Connecticut, of April 23d, 1662, granted by Charles II, and the patent of Charles II to the Duke of York, of March 12th, 1664, upon which three documents the territorial limits and jurisdiction of the Colonies of Connecticut and New York rested, the islands lying easterly of the land boundary between the two, and adjacent to the Connecticut shore, are within the jurisdiction of Connecticut.

The possession of Connecticut has always been consistent with this view of the documentary title.

Although New York has claimed jurisdiction over three islands called Captain's Islands, lying some two miles to the westward of Goose Island, a small island lying about a mile from the shore, off Norwalk, Connecticut, yet Connecticut has never conceded such claim, and New York has never claimed jurisdiction over Goose Island.

Goose Island is within the territorial limits of Connecticut.

(Before WOODRUFF and SHIPMAN, JJ., Connecticut, September 19th, 1871.)

SHIPMAN, J. This is a bill in equity, to enjoin a nuisance. The plaintiff owns and occupies a residence on the shore of Long Island Sound, in the town of Norwalk, in the State of Connecticut; and the defendant owns a small island, called Goose Island, about a mile from the shore. On this island the defendant has an establishment, in which he manufactures artificial manures, from dead fish and other offensive materials, the odor of which often reaches the main land and the plaintiff's residence, and creates, as the bill alleges, an intolerable

Keyser v. Coe.

odor, exceedingly disagreeable and sickening. The plaintiff brought his bill against the defendant, to enjoin this nuisance, in the Superior Court of Connecticut for Fairfield county. The defendant removed the cause into this Court, and filed a plea to the jurisdiction, alleging that Goose Island is not within the State of Connecticut, and, consequently, not within the limits of this judicial District, and averring that, therefore, this Court is without jurisdiction. This plea the plaintiff traversed, and, the evidence on the issue of fact thus raised having been heard, Judge Woodruff delivered an oral opinion of the Court, in May last, finding this fact adversely to the claim of the defendant, and overruling the plea, at the same time stating that a written opinion, fully embodying the views then expressed, would be filed at a subsequent day. We now proceed to set forth, in somewhat more detail, the views then orally presented.

The main question is, whether the subject-matter of this suit is within the jurisdiction of the Court. The bill alleges, that the noxious odors complained of are transmitted through the air, from the defendant's works on the island, to the plaintiff's residence, which is in Connecticut, injuring the health, and destroying the comfort, of himself and family, and impairing the value of his property. It was suggested, on the argument, that, even if Goose Island, where the noxious odors are generated, be without the District of Connecticut, yet, as these odors are blown to the shore, and there inflict the injury complained of, this Court has ample jurisdiction to arrest the evil, the parties being properly before it. This is an interesting question, but, the conclusion which we have reached on another and more comprehensive branch of the case, renders it unnecessary that we should pass upon it. We, therefore, confine ourselves to the question of fact to which the proof was addressed, and the only one which was discussed on the argument, and that is, whether Goose Island is within the limits of the State of Connecticut.

The rules of evidence applicable to controversies touching the boundaries of States, do not differ materially from those

relating to the boundaries of land between individuals. In both cases, resort is made to documents and muniments of title, such as grants, charters, and deeds, and, where these fail, to evidence of use and occupation. We have, in this case, tested the question now under consideration by both of these classes of evidence.

The first piece of documentary evidence which claims our attention is the patent of Connecticut, well known, in her history, as the Warwick patent. The date of this patent was March 19th, 1631. It is stated by Trumbull, in his history of Connecticut, (*vol.* 1, *p.* 27), that Warwick derived his title from the Council of Plymouth, by a grant made to him in 1630, and confirmed by a patent from Charles I. The Council of Plymouth held under the great patent of New England, from James I, dated November 3d, 1620. Though the descriptive words of the grant in this Warwick patent of 1631 are peculiar, a careful consideration of them leaves no substantial doubt as to their true meaning, so far as they bear on the present controversy. This descriptive clause is as follows: "All that part of New England, in America, which lies and extends itself from a river there called Narraganset river, the space of forty leagues, upon a straight line, near the sea shore, towards the southwest, west and by south, or west, as the coast lieth, towards Virginia, accounting three English miles to the league; and, also, all and singular the lands and hereditaments whatsoever, lying and being within the lands aforesaid, north and south, in latitude and breadth, and in length and longitude, of and within all the breadth aforesaid, throughout the main lands there, from the western ocean to the south sea, and all lands and grounds, place and places, soil, wood and woods, grounds, havens, ports, creeks and rivers, waters, fishings, and hereditaments whatsoever, lying within said space, and every part thereof; and, also, all islands lying in America aforesaid, in the said seas, or either of them, on the western or eastern coasts or parts of said tracts of lands by these presents mentioned to be given, granted, &c." It will be noticed, that the eastern boundary

Keyser v. Coa.

of the tract here granted is not described, except by naming Narraganset river, (now called Narraganset bay,) as the line from which the belt of land included in the grant took its start. The northern boundary is not described at all, but it has universally been understood to be coincident with the southern boundary of the colony of Massachusetts Bay, as fixed by the grant of the Council of Plymouth to Sir Henry Roswel and others, March 19th, 1627. The western boundary of the land granted by the Warwick patent it is not necessary to determine in this controversy. It was long a subject of dispute between Connecticut and other colonies, and involved interests of great magnitude, but which do not now concern us. The words in this patent, "from the western ocean," refer, of course, to the Atlantic. This is clear, from the fact that the grant to Sir Henry Roswel and others, already referred to, and dated four years earlier than the Warwick patent, employs the words, "from the Atlantic and western sea and ocean, on the east part, to the south sea, on the west part." Whether the words "south sea," in the Warwick patent, meant what is now called the Pacific Ocean, as has been generally supposed, we do not stop to enquire.

We now come to that part of the southern boundary of the Warwick grant which is germane to the question before the Court. It commenced at Narraganset river or bay, on the east, and extended westerly "as the coast lieth, towards Virginia," forty leagues, or an hundred and twenty miles. The words, "upon a straight line," are not used in the instrument to designate the actual southern boundary, but merely as a line on which the distance between the two termini was to be measured, these termini being Narraganset river on the east, and a point on the coast forty leagues from that starting point. The words, "near the sea shore," must have been used in the sense of "along the sea shore." But, if we were to construe the words, "upon a straight line," literally, the boundary indicated by it would not support the defendant's plea to the jurisdiction. For, a straight line drawn from Point Judith,

the starting point, to Lyon's Point, which has long been practically settled as the western terminus, would leave Goose Island on the north, and within the limits of the grant. But, as already stated, we regard the southern boundary indicated by the descriptive words of the grant to be the coast washed by the sea. This interpretation is confirmed by other comprehensive words of the grant, by which are included in it not only all "havens, ports, creeks, waters, fishings," but, "also, all islands lying in America aforesaid, in the said seas, or either of them, on the western or eastern coasts or parts of said tracts of lands." The word, "seas," in this passage, cannot be confined to Narraganset bay on the east and the Pacific Ocean on the west, for, the former is called only a river, in this grant. "Seas" must have included the Atlantic, of which Long Island Sound was an arm. We need not trouble ourselves now to inquire whether or not Long Island could be properly covered by this grant, as Connecticut long and unsuccessfully contended. It is sufficient for us, that its obvious and natural import included all the small islands, including the one in question, contiguous to the north shore of the Sound.

The next document, in order of time, is the charter of Connecticut, granted by Charles II, April 23d, 1662. This instrument describes the country intended to be embraced within it, thus: "All that part of our dominions in New England, in America, bounded on the east by Narraganset river, commonly called Narraganset bay, where the same falleth into the sea, and, on the north, by the line of the Massachusetts Plantation, *and, on the south, by the sea*, and, in longitude, as the line of the Massachusetts Colony, running from east to west; that is to say, from said Narraganset bay on the east, to the south sea on the west part, with the islands thereunto adjoining, &c." It is immaterial to our present purpose whether the "sea" here mentioned as the southern boundary meant the Atlantic Ocean outside of Long Island, or that arm of it known as Long Island Sound. It certainly meant one or the other; and, if we interpret it to mean the Sound, and

 Keyser v. Coe.

thus restrict it within the narrowest limits which the language will bear, still the water is the southern boundary, while "the islands thereunto adjoining" the principal tract are expressly included and covered by the instrument. That, by the terms, "the islands thereunto adjoining," it was intended to include all those small ones scattered along the main shore, is too plain to admit of a doubt.

We now come to the patent of Charles II to his brother, the Duke of York, dated March 12th, 1664, thirty-three years subsequent to the Warwick patent, and two years later than the charter of Charles II to Connecticut. After granting certain portions of the "main land of New England," the instrument proceeds: "And, also, all that island or islands commonly called by the several name or names of Matowacks or Long Island, situate, lying, and being towards the west of Cape Cod and the Narrow Highgansetta, abutting upon the main land between the two rivers there called or known by the several names of Connecticut and Hudson's rivers, together, also, with said river called Hudson's river, and all the land from the west side of Connecticut to the east side of Delaware bay, and, also, all those several islands called or known by the names of Martha's Vineyard and Nantukes, otherwise Nantucket, together with all the lands, islands, * * * harbors, * * * fishings, * * * to the said several islands, lands, and premises belonging and appertaining, with their and every of their appurtenances, &c." From this description no one would have any doubt that Long Island was included in its scope, even if its names had been wholly omitted. Its location is given, and its length approximately indicated, so as to place its identity beyond mistake. "Abutting upon the main land between the two rivers there known as Connecticut and Hudson's rivers," of course, means, off, abreast of, the main shore, between the mouths of these streams. The "islands * * * belonging and appertaining" to that and the other main islands named, must refer to those contiguous to them, or in their vicinity. Of these there were a considerable number, too insignificant, in that day of large

and sweeping grants and imperfect geographical knowledge, to be described, but so contiguously situated as to be naturally and aptly included in the conveyance, by general terms. They would, perhaps, pass by implication, as incidents to the main subjects with which the instrument was dealing. But we know of no rule of construction that would warrant us in extending this grant to the small islands adjacent to the shore of Connecticut, even had the patent to the Duke of York antedated, instead of post-dated, the Warwick patent and the charter of Connecticut.

It is well known, that, long prior to the date of the patent of the Duke of York, Connecticut had exercised jurisdiction over a large part of Long Island. We are not called upon to vindicate her claim to that jurisdiction. She regarded it as included in the Warwick patent and in the charter of Charles II. The former expressly granted "all islands lying in America aforesaid, in said seas, or either of them, on the western or eastern coasts or parts of said tracts of lands." One of "said seas," as we have already seen, was the Atlantic Ocean, and Long Island was on the coast of the eastern part of the tract of land granted. There was nothing in any prior grant which conflicted with this claim. The great patent of New England, granted by James I to the Council of Plymouth, embraced the whole region from the fortieth to the forty-eighth degrees of north latitude, "with all the seas, rivers, islands, creeks, inlets, ports, and havens within those degrees." Out of this vast tract, that described in the Warwick patent was carved; and, as the latter lay on the coast, and the instrument which described it expressly included "all islands" on the coasts or parts of said tracts of lands, it is not surprising that Connecticut asserted her claim to Long Island, or, at least, to that part of it which lay abreast of her shore—a claim recognized by the Dutch, in 1650, in the treaty of Hartford, which gave Connecticut all that part of the island east of a line drawn from the westernmost part of Oyster Bay to the Atlantic Ocean, a treaty which was ratified by the States General of Holland. The charter of Charles II bounded her

Keyser v. Coe.

"south by the sea." She interpreted the word "sea" as synonymous with "ocean," and, on that ground, also, claimed to the Atlantic shore on the south side of Long Island. The grant to the Duke of York was in conflict with this claim, and the question of its validity came before a royal commission, in November, 1664. This commission was attended by delegates from Connecticut, duly authorized by the colony, and included the governor. The instrument which contained the result of their settlement of the boundary was signed November 30th, 1664, by the royal commissioners and those from Connecticut, and, so far as it bears upon the question before us, was as follows: "We do declare and order, that the southern bounds of his majestie's colony of Connecticut is the sea, and that Long Island is to be under the government of his royal highness the Duke of York, as is so expressed by plain words in said patents respectively." This is not very explicit, except as to Long Island. It was conclusive against the claim of Connecticut to that. But it uses the word "sea" as defining her southern boundary, the same word used in the charter of 1662. The eastern portion of her southern boundary was confessedly the Atlantic Ocean, but, whether the word "sea" was used as synonymous with "sound," and as thus defining the western and greater portion of her southern boundary, does not appear very clearly. Yet the explicit recognition of the title of the Duke of York to Long Island, would impliedly exclude the idea that the southern boundary of Connecticut extended south beyond the Sound. But, however this may be, the settlement now under consideration nowhere, either by express words or by implication, recognizes the title of the Duke of York to the small islands along the Connecticut shore.

It is true, that the settlement agreed on by the commissioners fixed, also, the west bounds of Connecticut, and that, in doing this, they commenced at the point on the east side of Mamaroneck creek, where it falls into the Sound, and from that starting point ran northerly. It is true, too, that, in all the adjustments of the western boundary line between Con-

necticut and New York, except that contained in the treaty of Hartford, in 1650, the southern terminus or starting point of the line defined was fixed at some point on the shore of the Sound. It now stands at Lyon's Point. But, the inference which we are asked by the defendant to draw from this fact, is not warranted by the fact itself, nor by any circumstance connected with it. That inference is this—that, inasmuch as the western boundary line of Connecticut was not defined further south than the north shore of the Sound, therefore, Connecticut had no territorial rights beyond that shore, in a southerly direction. To state this proposition is to answer it. The land part of the boundary on the west of Connecticut was the only portion that caused any trouble between her and New York. To define that, down to the waters of the Sound, was all that was necessary. The water was an arm of the sea, over which neither colony could have any exclusive control. It was a highway common to both, and open to the commerce of all who were at peace with England. To define the boundary line on the land to the water's edge, was all that was required, leaving the jurisdiction over the adjacent waters and islands to be determined by the respective patents or charters of the two colonies, and the law of nations. The claim, therefore, that the omission to define the line on the water, left the islands near the Connecticut shore and east of Mamaroneck creek under the jurisdiction of the Duke of York, is not even plausible. Just as well might it be claimed that the islands west of that creek were left within the jurisdiction of Connecticut. These remarks apply to all that part of the evidence which relates to the west boundary of Connecticut. This boundary, for many years, fluctuated east and west, and finally was settled, so far as the southern terminus was concerned, at Lyon's Point, where it now remains. This disposes of the objections of the defendant to the jurisdiction of this Court, so far as those objections are founded upon documentary evidence. Our conclusion is, that, upon any just construction of the three great muniments of title which we have considered, and upon which the territorial limits and jurisdiction of the

Keyser v. Coa.

colonies of Connecticut and New York rested, the islands lying easterly of the land boundary between the two, and adjacent to the Connecticut shore, are within the jurisdiction of the latter State.

The possession of Connecticut has always been consistent with this view of the documentary title. So far as these islands have been permanently occupied at all, that occupancy has been by citizens of this State, who have recognized its jurisdiction over their island possessions. In conveyances, the land of which they are composed has been described as lying within the State, and the deeds thereof, offered in evidence, have been recorded in the appropriate land records within the same jurisdiction. The defendant holds his title under a long line of conveyances describing the island in question as situated in Connecticut.

To this uniform possession of Connecticut, New York has made no adverse claim, so far as we are apprised, except in a single instance, to which we will now refer. On the 12th of February, 1765, Cadwallader Colden, then Lieutenant-Governor of New York, addressed the following letter to Governor Fitch, of Connecticut:

NEW YORK, February 12, 1765.

Sir: Having laid before his majesty's council the inclosed petition of John Anderson, holder of, by grant under the great seal of this province, three islands in the Sound, and complaining that he has lately been sued by Justus Bush, David Bush, William Bush, and John Gregg, inhabitants of the colony of Connecticut, for a supposed trespass on one of those islands called Captain's Islands, and praying the interposition of this government, in order to secure to him the effect of the royal bounty, I am, by the advice of the council, to propose to your government the submitting the matter of jurisdiction with respect to these islands, and such others in the Sound as are or may be contested, to the determination of his majesty in his privy council, on such state of the controversy as each government shall think fit to transmit to his majesty's ministers for this purpose, and that, in the mean time, all judicial proceedings be

Keyser v. Coe.

suspended, as ineffectual, and necessarily leading to great animosities between individuals, and to embroil the two governments.

As the matter proposed will answer the same end as a commission in the usual form, and, being attended with little expense, seems better adapted to a case in which the public interest in either colony is inconsiderable, I flatter myself that it will meet with the approbation of yours, in which case I shall order the proper papers to be prepared, and shall transmit them without delay.

I am, with great regard,

Sir, your most obedient,

humble servant,

CADWALLADER COLDEN.

The Honorable THOMAS FITCH, Esq.,

Governor of Connecticut.

This letter was received by Governor Fitch on the 18th of February, 1765, and, on the 22d, he replied as follows :

NORWALK, 22d February, 1765.

Sir :

On the 18th I received your letter of the 12th, acquainting me that John Anderson had exhibited his petition to you, complaining he has lately been sued by some of the inhabitants of this colony, for a trespass on one of the islands called Captain's Islands, and praying the interposition of your government, in order to secure to him the effect of the royal bounty in granting him those islands under your province seal. His petition you mention was not inclosed ; the purport, therefore, I collect from your letter.

The proposal you are pleased to make this government, of submitting the matter of jurisdiction with respect to those three islands, and such others as are or may be contested, to the determination of his majesty in his privy council, I shall lay before the General Assembly of this colony, as soon as opportunity presents, which will be in May, unless, on some special occasion, it may be found necessary to meet sooner.

I must observe, a proposal to this government to submit a matter of jurisdiction which it has exercised without controversy or interruption for more than one hundred years, founded, as we, at least, suppose, on good and legal authority, was unexpected ; and

Keyser v. Coe.

that, after New York and Connecticut had settled the lines of government with so great precision and certainty, and Connecticut had made such great condescensions therein, I hoped that they would have had no occasion to enter into further contests on that head. However, I shall refer the whole to the Assembly, who alone can properly determine the matter.

I am, Sir, with great regard, your
most obedient, and most humble servant,

THOS. FITCH.

The Honorable Lieut.-Governor COLDEN.

Governor Fitch, in pursuance of his promise to Governor Colden, did submit the letter of the latter to the General Assembly, in May following, together with Anderson's petition, which, in the meantime, had come to hand. The subject was referred to a special committee, a majority of whom were among the most eminent citizens and lawyers of the State. On the 28th of May, 1765, the committee made their report, which, after stating that the government had not interfered in the suit against Anderson, but had left the matter originally in dispute entirely with the courts of law, as it was a matter relating to private property, and that, even so far as the question of jurisdiction was concerned, it was too inconsiderable to engage the attention of the two governments, in the expensive mode of settlement proposed, concludes as follows: "And further, that the lines and boundaries between the two colonies have been so effectually and finally settled, by solemn agreements, ratified and confirmed by his Majesty's predecessors, that there appears no reasonable foundation for further controversy relative thereto." This report was accepted, and Governor Fitch was instructed to communicate the result to the Governor of New York. In the mean time, the suit against Anderson had proceeded to final judgment, the jury having found, under a plea to the jurisdiction, that the islands claimed by him were within the colony of Connecticut, instead of New York.

The petition of Anderson to Lieutenant-Governor Colden,

which referred to this suit, and led to the correspondence and legislative action already stated, deserves attention in this place; for, although Goose Island lies some ten miles to the eastward of the islands claimed by Anderson, yet the grounds of his claim that the latter were within the limits of New York, were broad enough to include all the islands, as well as a narrow strip of the main land, along the Connecticut shore, west of Fisher's Island. This petition, after reciting a grant of the three islands from his Majesty, under the great seal of the Province of New York, and the interference with his alleged rights by the suit in the Connecticut Court, set forth the descriptive clause of the charter of Charles II to Connecticut, which we have already referred to in another place: "All that part of our dominions in New England, in America, bounded on the east by Narraganset river, commonly called Narraganset bay, where the said river falleth into the sea, and, on the north, by the line of Massachusetts plantation, and, on the south, by the sea, and, in longitude, as the line of Massachusetts colony, running from east to west, that is to say, from the said Narraganset bay on the east, to the south sea on the west, with the islands thereunto adjoining." The petition then averred, that, "pursuant to this description, he is advised, that the corporation of Connecticut could justly claim no other lands than such as were comprehended between the south bounds of Massachusetts bay, (colony or plantation,) and a line parallel thereto, running west; which, it is supposed, will be in coincidence with the sea-side for several miles westward of Point Judith, near the mouth of Narraganset bay, until the shore bends more southerly than the parallel with the northern boundary, and such islands, (if any islands not included in those limits can be supposed to pass by the insensible, or, at least, inaccurate, epithet, "adjoining,") as are in Narraganset bay, or in the sea, as far as it coincides with the southernmost parallel, in its western course; for, by this construction, all the words of the patent are fully satisfied, and every other interpretation will be found extravagant and injurious to the crown, and imply so

Keyser v. Coe.

gross a want of knowledge of the country as cannot reasonably be supposed even at that early day. And thus, as the south parallel or boundary of Connecticut, running west, departs from the sea-side near Fisher's Island, and crosses the country, the course of the Sound being, from about Fisher's Island, south westerly, it follows, that the title to the greatest part of the land contiguous to the northern shore of the Sound, and all the islands near it, remained (the grant to Connecticut notwithstanding) in the crown; and, those islands not being affected by any subsequent settlement, his Majesty had good right to pass to your petitioner the grant above mentioned." This petition of Anderson was evidently drawn by a lawyer, and no doubt foreshadowed the legal ground upon which the province of New York rested her title, at that time, to the islands then in controversy. We do not need to discuss, at this late day, the claim then put forth by Anderson, under New York. The Warwick patent of 1631, the charter of 1662, the settlement of 1664, and the possession of Connecticut under all three, had, for more than a century, ignored any such claim, and fixed her boundary on the sea or Sound. We are aware that the State of New York adhered to the claim set up by the provincial government to the three Captains' Islands. On what precise grounds she did so we are not advised, but we infer that they certainly were not those set up by Anderson in his petition, in 1765. But the claim of that State has never extended, so far as any evidence before us indicates, to Goose Island, or any others on that part of the coast, except the three which were granted to Anderson. Connecticut has never conceded the claim of New York to those. The right of New York has never been deemed settled, and the commissioners of that State, appointed in 1856 to ascertain the boundary between it and Connecticut, stated, in their report to the legislature of New York, that they "learned, that, in addition to the boundary question, there is a controversy respecting the jurisdiction over Captain's Island, lying in the Sound, near Byram river. As the extent of our powers," say the com-

missioners, "in respect to this matter, was quite uncertain, we entered into no negotiations regarding it, and made no investigations, except, incidentally, into the origin and extent of the dispute. We are, however, satisfied, that some decision of the question is urgently required." This "controversy," as the commissioners call it, doubtless led the United States to obtain from both States a cession of jurisdiction over three acres of this island, on which a light house was erected by that government, about the year 1830. So far as the evidence before us shows, the United States have uniformly taken deeds of cession from Connecticut only, of all the other islands north of the middle of the Sound and between Lyon's Point and Fisher's Island, which have been used as light stations.

We are, of course, well aware, that Fisher's Island, though lying somewhat near the Connecticut shore, and near her present eastern boundary, has long been under the jurisdiction of New York. With regard to the foundation of the title of the latter State to that island, we make no observations, as there is no evidence before us relating specially to the subject, nor is it at all necessary to the proper determination of the present controversy.

An examination of the statute of New York defining the boundaries of that State, and the discussion by her Courts relating to its construction, discloses nothing which in any manner countenances the claim set up by the defendant in his plea. Goose Island is not only not included in the descriptive words of the New York boundary Act, but no construction of that Act has ever been suggested which would include it within the limits of that State. The language of that part of the Act relating to this subject is as follows, starting from Sandy Hook: "and then to the place of beginning," (Lyon's Point), "in such manner as to include Staten Island, and the islands of meadow on the west side thereof, Shooter's Island, Long Island, the Isle of Wight, now called Gardiner's Island, Fisher's Island, Shelter Island, Plum Island, Robin's Island, Ram Island, the Gull Islands, and all

Keyser v. Coe.

the islands and waters in the bay of New York, and within the bounds above described." (1 *Rev. Stats. of N. Y.*, 65.) This is somewhat obscure, as neither courses nor distances are given, but the line, however run, is to include certain islands and waters.

The construction of this clause of the Act was discussed in the case of *Manley v. The People*, (3 *Selden*, 295.) The plaintiff in error in that case had been indicted and convicted of theft. The indictment alleged the offence to have been committed in the county of New York. The proof showed that it was, in fact, committed on board of a steamboat on Long Island Sound, opposite the county of Suffolk, near the shore of Long Island, between Sands' Point and Huntington. The accused took the ground, in the Court below, that the proof showed that the offence was committed out of the boundaries of the State, and, if not, then out of the limits of the county of New York, and within those of Suffolk county. A majority of the Court of Appeals held that the *locus in quo* was in Suffolk county, and not in the county of New York. But they did not attempt to define the boundary of the State from Sandy Hook to Lyon's Point. Welles, J., however, in his opinion, suggested two modes of defining the line indicated by the words of the statute, one of which he thought should be adopted: "The first is, to start from Sandy Hook, and run the line, by straight courses, so as to include the islands mentioned, making, with a direct straight line from Sandy Hook to Lyon's Point, an irregular figure, the exterior of which shall consist wholly of straight lines, with angles of unequal quantities, and with the vertex of each angle pointing outward from the interior of the figure. This would run the northern line of the figure or tract from some point on Fisher's Island to Lyon's Point in a direct course. * * * The second is to run the line directly from Sandy Hook to the place of beginning, in the mouth of Byram River," (Lyon's Point,) "diverging from a direct course so far, and so far only, as is necessary to include the islands, &c., mentioned, and, as soon as that object is attained, to return

to the original straight direction. By this mode, it is intended to include the whole of the Sound lying east of the first mentioned direct line from Sandy Hook to Lyon's Point, and, consequently, the place where the offence was committed. I am inclined to adopt the latter of these modes." The learned judge then states his reasons for that preference, which it is not necessary for us to cite here. By an examination of the map of the territory and Sound, in connection with the statute and the opinion just cited, it will be seen, that a straight line from Fisher's Island to Lyon's Point is the furthest northern limit assigned to the boundary of New York in the Sound, upon any construction of her own statute. The line would leave Goose Island within the State of Connecticut.

In the case of *Mahler v. Transportation Co.*, (35 N. Y. R., 352,) the same subject is discussed by Porter, J. That case arose out of a collision between vessels in the Sound, between the shores of New York, and west of the Connecticut boundary. But the discussion in that case sheds no light on the question now before us, and lends no support to the claim set up by the defendant here, that Goose Island is within the limits of New York. In both of the cases which we have cited, as well as in that of *The Sloop Elizabeth*, (1 Paine's C. C. R., 10,) the question was, what waters of Long Island Sound were included within the territorial limits of New York, and, therefore, subject to her exclusive civil and criminal jurisdiction. The title to no islands was in dispute, though, in tracing the boundary of the State over the waters of the Sound, of course, the islands would be included or excluded, as the case might be. But, as we have already seen, no line was suggested which would include Goose Island within the territory of New York.

It will be noticed, that the statute of New York, in describing the boundary line, includes within it not only Long Island, but, also, "the Isle of Wight, now called Gardiner's Island, Fisher's Island, Shelter Island, Plum Island, Robin's Island, Ram Island, the Gull Islands," &c. Some confusion

has, at times, arisen out of the fact that Ram Island was thus included in that Act, as it was, also, in the Act fixing the limits of Suffolk county, (3 *Rev. Stats. of N. Y.*, 2). Now, there are three islands known by the name of "Ram Island," one in Gardiner's Bay, a little south of Gardiner's Island, one just at the mouth of Mystic river, between Fisher's Island and the Connecticut shore, sometimes called Mystic Island, and a third opposite the town of Norwalk, and a little to the westward of Goose Island. It is obvious, that the Ram Island referred to in the New York statutes, is the one in Gardiner's Bay. Both Acts name this island in immediate connection with others in the vicinity of the east end of Long Island. It cannot be said that some other Ram Island, than that in Gardiner's Bay, was meant, because that is located within waters confessedly within the limits of the State of New York and of Suffolk county; for, Shelter Island and Robin's Island are both named, and are both still more landlocked than Ram Island. Robin's Island is in Great Peconic Bay, a sheet of water almost entirely enclosed by the main land of Long Island. We conclude, therefore, that the Ram Island mentioned in the statutes referred to is the one in Gardiner's Bay, instead of either the one at the mouth of Mystic river, or that off Norwalk, both of which are very near the Connecticut shore. This point is not very material, but we have alluded to it to correct an error which has sometimes arisen by confounding the Ram Island in Gardiner's Bay with one or the other of the two of the same name which lie far distant, and north of any boundary line ever claimed by New York since she became a State.

From these views, it will be seen, that the fact set up by the defendant in his plea to the jurisdiction of this Court is unsupported by proof of any kind, and this plea, therefore, fails, and must be overruled. Goose Island, where the alleged nuisance has been created by the defendant, is within the territorial limits of the State of Connecticut, and, there-

Bevin v. The East Hampton Bell Company. *

fore, within this judicial District and the jurisdiction of this Court.

Asa B. Woodward and *Tilton E. Doolittle*, for the plaintiff.

George H. Watrous and *Levi Warner, Jr.*, for the defendant.

ABNER G. BEVIN

vs.

THE EAST HAMPTON BELL COMPANY. IN EQUITY.

In January, 1852, B. applied for a patent. His application was rejected in April, 1852. He did not appeal, or apply for a re-examination. In May, 1852, he took from the Patent Office his application, and all the papers connected with it, except one drawing, but made no formal withdrawal. The papers so withdrawn were never returned. From May, 1852, until April, 1862, he had no communication with the Patent Office, and took no steps towards obtaining a patent. During that interval, his invention went into extensive use, with his knowledge, and without his objection. In April, 1862, he filed a new application for a patent for the invention, and paid a new fee. The new application made no reference to the application of 1852. The fee paid to the Patent Office in 1852 was not withdrawn: *Held*, that the application of 1852 had been abandoned, and that a patent granted in 1869, on the application of 1862, was void, because of the public use of the invention, for nearly ten years before 1862, with the permission of the inventor.

(Before WOODRUFF and SHIPMAN, JJ., Connecticut, September 19th, 1871.)

SHIPMAN, J. This is a bill in equity, praying for an injunction and an account, and is founded upon a patent issued to the plaintiff, May 4th, 1869. The alleged invention is called, in the patent, an "improvement in metallurgic fur-

- Bevin v. The East Hampton Bell Company.

naces." The device is a simple one and need not be described here. It is sufficient to say, that it required inventive thought to originate it, and that it is a useful improvement. That the plaintiff was the original and first inventor may, also, be conceded. The defence, as set up in the defendants' answer, rests upon the following grounds: (1.) That the invention "was in public use, with the knowledge and consent of the inventor, for more than two years prior to his application for the said letters patent." (2.) "That the plaintiff, since his application for said letters patent, and before the issuing of the same, and during the period of seven years which elapsed between said application and the obtaining of said letters patent, knowingly permitted his alleged invention to become public property, and abandoned the same to the public."

There is very little dispute between the parties about the facts. In January, 1852, the plaintiff applied for a patent, and, in April of the same year, his application was rejected. From this rejection no appeal was taken, or re-examination applied for. In May next following, the plaintiff took his application, and all the papers connected with it, except one drawing, from the Patent Office, but no formal withdrawal appears to have been made. The papers thus withdrawn from the Office were never returned. From May 28th, 1852, till April 28th, 1862, the plaintiff had no communication with the Patent Office, and the only evidence which that Office contained, during these ten years, of his alleged invention, was the drawing, and the entries on the file wrapper of the date of filing the petition and other papers, the rejection of the application, and the delivery of the papers, on the order of the plaintiff, to his brother, May 28th, 1852.

At the time his application was rejected, in April, 1852, the Office referred the plaintiff to "Wyman on Ventilation," as containing evidence that his invention had been anticipated and antedated. The plaintiff, in his testimony, states what he subsequently did in reference to securing a patent under this application, as follows: "I consulted Mr. Barnes," (his attorney through whom he had made his application.) "Mr.

Barnes said to me, that I had paid in thirty dollars in gold, that I could, if I wished to abandon it, draw back twenty dollars from the Government, but his advice was to let it lie and think of it, and, perhaps, I might think it best to take it up some other time, and I might see some others, perhaps some one in Washington, who would be able to go and explain the matter, and see more particularly about the reasons; and, in the course of two or three years, or a year or two, my brother saw Mr. Truman Smith, a member of Congress. Mr. Smith said he would undertake to obtain the rejected patent, but he thought I had better make some little alterations, and, in looking at the thing, I did not see how I could, and never did make any alterations, and so it run along till 1862, I think it was, when I became acquainted with Munn & Co., of New York, who said they would undertake to obtain it for me and made application." "The patent was rejected," (the application of 1852,) "because it was supposed to be anticipated by "Wyman on Ventilation." Mr. Barnes said that he had never seen the book, and could not find it in Middletown, and thought that perhaps I might find it in Hartford or New Haven. I could not find it in Hartford, and I went to New Haven, probably in the course of a year or two after the rejection. I consulted Professor Olmsted, of Yale College. He said, (after looking at the book,) that he did not think it ought to have been rejected on that account." No other or further steps were taken by the plaintiff, or any one on his behalf, towards obtaining a patent for this invention, till April, 1862.

In the mean time, the plaintiff, who resided in the village of East Hampton, Connecticut, where most of the sleigh bells used in this country were, and still are, made, erected, in 1852, a furnace embodying his invention. The same year Buell & Veazy erected one, and, in 1853, another. In 1853, one was built by J. S. Hall & Co. In 1856, the defendants built theirs. In 1856, 1857 and 1860, three others were erected. All these furnaces embraced the alleged invention of the plaintiff, were situated in the village where he con-

Bevin v. The East Hampton Bell Company.

stantly resided, and have been openly in use down to the present time, in the same business as that in which the plaintiff has been engaged. The fact that these furnaces were all erected upon the same plan as that described in the plaintiff's patent, and used for the same purpose, was known to him from the time each was built, down to the date of his patent, in 1869. During all this time, the plaintiff made no objection to this open and continued use of his invention by his neighbors and competitors in business, with all of whom he appears to have been on friendly terms. It is true, he gave them no express permission. The only references ever made to the subject, so far as the evidence discloses, are those testified to by the plaintiff. He says: "I don't know that I ever objected. Mr. Abell, (of the East Hampton Bell Co.,) came to me, when they were about to build theirs, and asked me if he could see our furnace and chimney. I told him he could, but I could give him no license to build one like it, for I had applied for a patent and might some time obtain it. About the same time, J. G. Hinckley" (who had constructed the plaintiff's) "was about to build one for J. S. Hall & Co., and he came to see me and said he had heard something about my applying for a patent. I told him I had, and could give him no license to build one." Hinckley also testifies, that he built many of the chimneys already referred to, and that he had conversations with the plaintiff about them on various occasions, but that he never asked his permission to build any of them. This embraces the whole history of this invention and the dealings of the plaintiff and others with it down to April, 1862, when he filed another application for a patent.

In April, 1862, the plaintiff filed the new application, paying the fee of fifteen dollars, as prescribed by the Act of 1861, then in force, that Act requiring that sum to be paid on filing an original application. In this new application, no reference was made to that of 1852, nor to the payment of the fee required by the former Act, nor to any circumstance connected with it. Indeed, the fact that any prior application had been made, seems to have been studiously ignored. This

application of 1862 was filed April 28th, and rejected May 10th in the same year. The specification and one drawing which had been used on that application appear to have been taken from the Office, and were returned by the plaintiff's agents, Munn & Co., March 17th, 1863. No further communication with the Office was had by the plaintiff, or his agents, till April 5th, 1869, when a re-examination was applied for. In regard to the course of the plaintiff after the rejection of May, 1862, he testifies as follows: "After that I went to Washington myself, and saw Mr. Smith there then. He was not a member of Congress at that time. He thought it would cost considerable, and I concluded that I would think of it, and see what the prospect was of its value, and I neglected to employ him, or any one else, to make further application, until 1868, I think it was," (it was, in fact, in March, 1869,) "when I employed Theodore G. Ellis, and he obtained the patent in controversy." During the period which elapsed between the rejection of the application in May, 1862, and the application for a re-examination in 1869, four or five other furnaces were erected in the same village, all embodying the plaintiff's invention. They were all built, and put into use, with the knowledge of the plaintiff, and continued in use, without objection on his part, till his patent was finally issued.

As to the means employed by the plaintiff to prevent his invention from being known and used between 1852 and 1869, he says: "The first five or six years after I built this chimney, I put up a notice on the door, 'No admittance without permission;' but, of course, all the workmen knew it, and I think it wore out after five or six years, and that was the only measure I took to keep people from coming into the shop and looking around."

The plaintiff never withdrew the twenty dollars paid to the Patent Office at the time of his first application. He also testified that he never intended to withdraw that application or abandon his invention. There is some evidence, also, that,

Bevin v. The East Hampton Bell Company.

during the erection and use of the chimneys referred to, they were sometimes spoken of as "Bevin's chimneys."

We have thus given, in detail, the whole evidence which the plaintiff has offered to meet the issues of more than two years' use before the application of 1862, and of abandonment of the invention after that and before the patent issued.

There is no evidence, that we deem satisfactory, which would warrant us in concluding that these defendants knew or supposed that the plaintiff claimed this form of furnace as his exclusive property, or that he intended to secure a patent therefor, until near the time when the patent was granted. Even after this suit was commenced, and down to the time of filing the answer, they were ignorant of the application of 1852, as well they might be, for the application of 1862 purports, on its face, to be an original and independent one, and there was nothing in the proceedings of the Patent Office or the plaintiff, in connection with that application, which hinted at a prior one. The drawing to which the new specification referred was not the old one, but a new and different one; and, in the oath of the plaintiff, made on the 26th of March, 1869, and filed in support of the re-examination, then asked for, he refers to his invention as one "for which he made application for letters patent of the United States, on or about the 28th day of April, 1862, and which was *once* rejected, May 10th, 1862." In the application on his behalf, by his attorneys, for a re-examination, dated April 5th, 1869, they refer to his rejected application, and state: "The *first* rejection was dated May 10th, 1862." Indeed, so completely was the application of 1852 ignored, in all those proceedings, that it would be difficult for us to repress the suspicion that concealment of that fact was intended, if there existed any adequate motive for such a course.

The first question which obviously arises on these facts is, whether the plaintiff must be deemed to have abandoned his application of 1852. His testimony on the trial, that he never did intend to abandon it, is entitled to very little consideration, in view of his acts. His undisputed acts were,

certainly, very cogent evidence of abandonment. He withdrew his application, and all the papers connected with it, from the Office, May 28th, 1852, and never, from that day to this, furnished the Office with any evidence whatever that he intended to pursue that application. It is true, that he made no technical withdrawal; but he took away all the papers except one drawing, and never returned them, or made any allusion to them, in his subsequent transactions with the Office. The only evidence of his intentions, or invention, which the Patent Office contained, for ten years, was a single drawing, which had been filed in support of an application soon rejected, and which had been left behind when all the other papers were withdrawn. In the mean time, his invention went into open and notorious use, in his own neighborhood and under his own eyes, and so continued for ten years, without one word of precaution or remonstrance on his part, either communicated to the public directly, or through the Patent Office constructively. His remark to one or two persons, in casual conversations, that he had applied for a patent and might some day obtain one, and, therefore, could give no license to use his invention, is of little importance, in view of the other facts in the case. No one asked his permission or license. He forbid no one the use of his alleged invention. His notice, on the door of his factory, that no one could enter without permission, is of still less consequence, as evidence of his intention to pursue a claim for a patent. Such notices are common on the doors of manufactories. They are as often put up to keep out idlers, as to conceal unpatented inventions. Besides, this notice was effaced by time long before he renewed his application, and, if its presence on his door, while it lasted, was evidence of his intention to obtain a patent for something within, its subsequent absence, for years, was evidence that he had abandoned that intention. But, while it was there it had no effect to conceal the invention, or notify the public against its use, for it was in daily and public operation throughout the village. During all this time, the plaintiff took no steps to secure a patent. He knew the ground

Bevin v. The East Hampton Bell Company.

on which the Office rejected his application, and ascertained from Professor Olmsted that, in the opinion of the latter, the reason given by the Office for the rejection was not sound. This was within a year or two after the rejection of May, 1852. Here the matter slept. No fact is given in the evidence, nor is any reason suggested, by which we can account for the plaintiff's long continued inaction, if he intended to pursue his claim. His device was a simple one. His application had been rejected for a simple reason. No considerable expense or trouble was required to endeavor to revise and reverse the decision of the Office. The common plea of poverty is not set up. The plaintiff was, during all these ten years, prosecuting a successful business. This is clearly inferred from the fact that establishments of the same character as his were going into operation every year, and are still pursuing the same business. The plaintiff was misled by no suggestion of discouragement or difficulty in his path. The remark of Mr. Smith, that it would "cost considerable," was not made till after the rejection of 1862, and, if it had been, there is no pretence that the plaintiff was not able to defray the necessary cost of any legitimate effort to secure a patent. In view of all the evidence on this point, it is impossible to resist the conclusion, that the plaintiff wholly abandoned his first application, gave up all idea of obtaining a patent under it, and, for that reason, permitted it to go into unmolested public use.

But, the plaintiff insists, that the fact that he filed an application in 1852, is conclusive evidence in his favor, and cites, in support of this claim, the case of *Adams v. Jones*, (1 *Fisher's Patent Cases*, 527, 530). In that case, Mr. Justice Grier remarked: "By the application filed in the Patent Office, the inventor makes a full disclosure of his invention, and gives public notice of his claim for a patent. It is conclusive evidence that the inventor does not intend to abandon it to the public. The delay afterwards interposed, either by the mistakes of the public officers, or the delays of Courts, where gross laches cannot be imputed to the applicant, cannot affect his right." With this doctrine, in its application to the facts of

Bevin v. The East Hampton Bell Company.

that case, we have no controversy. Adams filed his application in 1850, but did not receive his patent till 1857. There is no suggestion that he took his papers, including his application, from the Office, and never returned them, thus withdrawing from the public the disclosure he had made of his invention, and all evidence of its character, except a drawing, from which, alone, no one could tell precisely or substantially what he claimed. There does not appear to have been any voluntary delay on the part of the applicant. On the contrary, he not only did not withdraw his application, but "continued to insist upon his right to a patent." The delay in prosecuting his appeal to a hearing "was not in consequence of any laches of the complainant's, but of the inability of the aged Chief Justice to attend to the business of his office." In applying the language of Courts, attention must be paid to the facts with which they are dealing. This is of especial importance when citing their opinions in patent causes. When it was said by the Court, in the case above cited, that, by an application filed in the Patent Office, the inventor makes a full disclosure of his invention, and gives public notice of his claim for a patent, and that this is conclusive evidence that he does not intend to abandon it to the public, the Court must be understood as referring to an application remaining on file, and prosecuted with at least some diligence, unless prevented by some cause other than that of the applicant's voluntary omission to move in the matter. An application for a patent can disclose nothing to the public, nor give the public notice of any definite intention of the inventor, while that application, and the most important papers in which the invention is described, are, not in the Patent Office, but in the inventor's pocket. The remarks of the Court in that case, which immediately follow those already cited, show that the opinion will bear no such construction as that sought to be put upon it by the present plaintiff. "The statute," Mr. Justice Grier adds, "forfeits the right of an inventor to a patent, only where the invention has been in public use more than two years before the application. A man might justly be treated as having abandoned his appli-

Bevin v. The East Hampton Bell Company.

cation, if it be not prosecuted with reasonable diligence. But, involuntary delays, not caused by the laches of the applicant, should not work a forfeiture of his rights. In this case, the complainant did not commence the manufacture of his improved lock till some time after his application was on file. The delay was not in consequence of his laches; and, within a reasonable time after the decision of the Court as to the extent of his invention, a patent was granted for that portion of it to which he was clearly entitled. Here is no abandonment, either by the letter or spirit of the statute, but a continual claim, amid difficulties arising either from the obtuseness of officers, or accidental but unavoidable delays of public tribunals." In the case before us, no part of this long delay of ten years is chargeable to any body except the plaintiff himself, unless it be the "obtuseness of the officer," who rejected his application in 1852. It certainly did not require ten years' deliberation on the part of the plaintiff for him to determine whether he would even attempt to overcome that "obtuseness." This long delay he does not pretend to excuse. It was, under the circumstances, not only not reasonable diligence, but it was no diligence at all. It was not only laches, but very gross laches.

The case of *Adams v. Edwards*, (1 *Fisher's Patent Cases*, 1,) also cited by the plaintiff, has no special bearing on the present controversy. The charge of Mr. Justice Woodbury conceded that an application might be abandoned, and, whether it had been in that case, was one question submitted to the jury. But, though, in that case, the patent was not granted till seven years after the first application was made, the original application was renewed, amended, and persisted in, until it was finally granted. The same patent was involved in the case of *Rich v. Lippincott*, (2 *Fisher's Patent Cases*, 1,) cited by the plaintiff.

But the plaintiff relies particularly on the case of *The Dental Vulcanite Co. v. Wetherbee*, (2 *Clifford*, 555, and 3 *Fisher's Patent Cases*, 87.) In that case, the facts are given by the reporter as follows: "It appeared, that John A. Cum-

mings first made an application for a patent for his invention in 1855, and that the same was, after three examinations, finally rejected, upon appeal, by the Commissioner of Patents, in 1856. The application was not further appealed, and was not renewed till March 25th, 1864, when a new application was filed, upon which the patent issued. In the interval between the filing of the original application and that of 1864, the invention had gone into use to a considerable extent, with the knowledge and consent of the then applicant, proved thereto; and it also appeared, that, during the same interval, the inventor had made certain assignments of interests in the invention. Certain letters of the patentee, and other evidence, were introduced, tending to show that the inventor had not relinquished his design of obtaining a patent, at any time between the date of the original application and the final allowance of the patent." (2 *Clifford*, 557.) The following are the remarks of Mr. Justice Clifford on this point: "The next objection to be noticed is, that the inventor abandoned his invention, because his application for a patent, which was made April 12, 1855, was rejected February 6, 1856, and because he did not appeal at all, or make any new application, until the 25th of March, 1864. Strong doubts are entertained whether any new application was necessary; but, if it was, it is believed to be well settled, that the second application must be regarded as having been filed in aid of the first, on which the rejection took place. (*Godfrey v. Eames*, 1 *Wall. S. C.*, 317.) Actual abandonment is not satisfactorily proved; and it is not possible to hold, that any use of the invention, without the consent of the inventor, while his application for a patent was pending in the Patent Office, can defeat the operation of the letters patent after they are duly granted. Such delays are sufficiently onerous to a meritorious inventor, if his patent is allowed to have full operation after it is granted, but it would be very great injustice to hold, that any delay which the inventor could not prevent, should, under any circumstances, affect the validity of his patent." The plaintiff insists that the doctrine of that

case is applicable to the one now before us, and fully supports the validity of his patent. We have, therefore, examined it with some care. The Court evidently considered two questions as arising under that branch of the case—first, the relation of the last application to the first; and, second, that of actual abandonment of the invention while the application was pending. The first, if we correctly understand the remarks of the learned judge, seems to have been regarded as a question of law, which had been conclusively settled by the Supreme Court in *Godfrey v. Eames*: “Strong doubts are entertained whether any new application was necessary; but, if it was, it is believed to be well settled, that the second application must be regarded as having been filed in aid of the first, on which the rejection took place. (*Godfrey v. Eames*, 1 *Wall. S. C.*, 317).” And it is true, that the Court, in the latter case, say: “In our judgment, if a party choose to withdraw his application for a patent, and pay the forfeit, intending, at the time of such withdrawal, to file a new petition, and he accordingly do so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application, within the meaning of the law.” But this language of the Court must be read in the light of the facts of the case before them. Those facts were, that “Godfrey, on the 31st of January, 1855, filed an application for a patent for boot-trees. This application the Commissioner, on the 17th May, 1855, rejected for want of novelty. On the 24th April, 1857, within the time required by the rules, Godfrey submitted his case again. The old application was withdrawn, and a new one filed, *simultaneously*, the withdrawal fee of \$20 going to make part of the new application fee of \$30, and not in fact being received by the applicant.” On these facts, the Court might well regard the two applications as connected together by an unbroken continuity. That they did not intend to decide that every subsequent application for a patent should be deemed, in judgment of law, to relate back to the first, whatever the interval of time, or the intervening acts of the applicant between them, is clear; for,

Bevin v. The East Hampton Bell Company.

they immediately add: "The question of the continuity of the application *should have been submitted to the jury*. In directing them to return a verdict for the defendant, we think the learned judge who tried the cause in the Court below committed an error." On that ground, a new trial was ordered.

On the second question, that of abandonment of the invention, the opinion in *The Dental Vulcanite Co. v. Wetherbee*, as already cited, remarks: "Actual abandonment is not satisfactorily proved; and it is not possible to hold, that any use of the invention, *without the consent of the inventor*, while his application for a patent was pending in the Patent Office, can defeat the operation of the letters patent after they are duly granted. Such delays are sufficiently onerous to a meritorious inventor, if his patent is allowed to have full operation after it is granted, but it would be very great injustice to hold, that any delay which the inventor could not prevent, should, under any circumstances, affect the validity of his patent." We conclude, that the facts which the learned judge had in view when he made these remarks have been inaccurately reported. They speak of the knowledge and consent of the inventor to the use as having been proved; while the opinion refers to a use without the consent of the inventor. The onerous delays referred to in the opinion we infer to be the delays interposed by the action of the Patent Office. Those were the only delays which the "inventor could not prevent," or, at least, provide against, by notice to those whom he knew to be using his invention. (*Goodyear v. Hills*, 3 *Fisher's Patent Cases*, 134; *Gates v. Benson*, *Decisions of Comr. of Pats.*, 1870, p. 65, *Cartter*, Ch. J.)

Now, in the case before us, as we have already stated, we are constrained, by the undisputed facts, to hold, that the plaintiff abandoned his first application. In coming to this conclusion, we have not overlooked the cases of *Pitts v. Hall*, (2 *Blatchf. C. C. R.*, 229,) and *McCormick v. Seymour*, (*Id.*, 240,) cited by the plaintiff. But, in neither of those cases, was this precise question before the Court. In each, the

Bevin v. The East Hampton Bell Company.

point was, whether the inventor had abandoned his invention to the public within the two years next preceding his application for a patent. As Mr. Justice Nelson well remarked, in his charge to the jury, in *Pitts v. Hall*: "An abandonment or dedication may occur within the two years, and at any time down to the procurement of the patent. The mere use, or sale, however, of the machine, within the two years, will not alone, or of itself, work an abandonment. There must be something more, because the 7th section of the Act of 1839 permits the sale or use by the patentee at any time within two years before his application, without its operating to invalidate his right." And, again, in *McCormick v. Seymour*, the same learned judge informed the jury, that "the mere fact of making and selling an improvement or invention, or of putting it into public use, at any time within two years before the application of a patent, is not, of itself, an abandonment of the invention to the public. The right thus to use his invention before the granting of a patent is a right conferred on the inventor by the Act of 1839." In both the cases cited, he charged; that where a defendant relies on an alleged abandonment of the invention to the public, within the two years next preceding the application for a patent, he should be required to prove it beyond reasonable doubt or hesitation. That is undoubtedly a sound rule. But the question now before us is, whether Bevin abandoned his *application*, made in 1852. On this question, we think the proof ample and conclusive. He filed his application, it was acted on by the Office without delay, and rejected for a simple and intelligible reason. Instead of taking any steps to reverse the action of the Office, he withdrew all his papers, including the application itself, except a single drawing, and then, for ten years, permitted his invention to go into notorious public use. During all this time the records of the Patent Office contained no evidence whatever of the character of his invention, or of his claims in regard to it. By inspecting this drawing left behind, nobody could tell what portion of the chimney or furnace was claimed

Bevin v. The East Hampton Bell Company.

as new, or of what the inventor supposed his discovery to consist.

But, we are told that the new application of 1862 must, in judgment of law, be deemed to relate back to the first one. We have already shown that the continuity of these applications is, according to the doctrine of *Godfrey v. Eames*, a question of fact, and not of law. The evidence does not establish that continuity, either in fact or intent. The original application, although not formally and technically, was practically, withdrawn. The papers were taken from the Office in 1852, and never returned. The application of 1862 made no reference to that of 1852, not even to the old drawing. When the application of 1862 was filed, there was practically no prior application pending, to which it could relate back. It follows, that, as the application of 1852 was abandoned, and there was no continuity between that and the one filed in 1862, the latter must be deemed the original application, upon which alone the patent issued; and, as the plaintiff failed to make that application until after his invention had been in public use, with his permission, for nearly ten years, his patent is void.

This conclusion renders it unnecessary that we should consider the other question raised by the answer, whether the invention was abandoned after 1862. Let a decree be entered dismissing the bill, with costs.

W. Edgar Simonds, for the plaintiff.

John S. Beach, for the defendants.

WALLACE AND SONS AND OTHERS

vs.

HOLMES, BOOTH, AND HAYDEN. IN EQUITY.

Where, in a suit in equity, the want of parties is not set up or suggested in the answer, it cannot avail, on final hearing, unless the case is one in which the Court cannot proceed to a decree between the parties before it, without prejudice to the rights of those who are proper to be made parties, but who are not brought into Court.

In the absence of a restraining statute, a guardian of the person and estate of an infant, appointed by a Court of Probate, has, as incidental to his office and duties, the power to sell personal property of his ward.

The statute of Massachusetts, (*General Statutes of Massachusetts, chap. 109, § 22.*) providing that the Courts therein named may authorize or require a guardian to sell personal property held by him as guardian, and invest the proceeds in real estate, or otherwise, does not take away the power of the guardian to sell such personal property without an order of the Court, and to confer title thereto on the purchaser.

Where a structure consisting of several parts is patented as a combination, one who manufactures and sells some of the parts, they being useless without the residue, with the understanding and intent that such residue shall be supplied by another, and the whole go into use in its complete form, is liable as an infringer of the patent.

Letters patent were granted to Michael H. Collins, September 19th, 1865, for an "improvement in lamps." The claim was to "the improved lamp, as not only constructed with its cone or deflector, (F,) and its chimney-rest, (D,) and chimney, arranged with respect to each other as described, but as having the said deflector provided with peripheral springs, or the same, or the slits, (A, A,) and the rest, (D,) made concavo-convex, and provided with an annular groove or lip at the bottom, for supporting the chimney, the whole being substantially as described or represented." The specification described the main purpose of the invention to be, not only to keep the lower part of the glass chimney of the lamp cool, so that it might readily be removed by the hand, but also to support the chimney without the use of a spring catch, or other devices, such as are ordinarily used. The distinguishing feature of the invention claimed was the burner, with its chimney-rest, a deflector having peripheral springs, to sustain the chimney without the aid of a catch or screw, and with air-passages operating, when in use, to keep the lower part of the

chimney cool, and tending, by that means, and by the greater elevation of the flame, to prevent the lower portion of the burner and top of the reservoir from becoming unduly heated. The burner alone, or the burner attached to the reservoir, was useless, without a chimney; and a chimney was useless without a burner. The defendants made and sold burners substantially like the patented invention, but, although they used such burners with chimneys placed therein, to exhibit the burners to customers, they did not make or sell the chimneys:

Held, that the claim of the patent was a claim to the burner in combination with the chimney.

Held, also, that the defendants must be regarded as active parties in the whole infringement, by making and selling the burner to be used with the chimney.

(Before WOODRUFF, J., Connecticut, September 19th, 1871.)

WOODRUFF, J. The complainants sue, as the assignees and owners of letters patent granted September 19th, 1865, to Michael H. Collins, for an improvement in lamps, for an alleged infringement by the defendants, praying an injunction and an account of the gains and profits made by the defendants by the unlawful manufacture and sale of the invention so patented. The answer puts the complainants to proof of the patent, and of their title as assignees, denies that the defendants have infringed the patent, and alleges that, if the patent recited in the bill of complaint shall be construed to cover anything contained in lamps heretofore and now manufactured and sold by the defendants, then, and in that case, such letters patent are, to that extent, void, for want of novelty.

Upon the trial, the defendants rested their defence solely upon two grounds—want of sole title in the plaintiffs, and the non-infringement of the patent by the defendants. The Court, is, therefore, relieved from any examination of the testimony and documents which were apparently intended to show that Collins was not the first inventor, or any other proofs, except such as bears directly upon the two points above mentioned.

(1.) As to the complainants' title. They first show that, on the 23d of September, 1867, Michael H. Collins was, by the Probate Court of the county of Suffolk and State of Massachusetts, appointed guardian of the person and estate of his

Wallace & Holmes.

minor child, Florence E. Collins, upon his own petition and her nomination, and upon the giving of bonds in the form required by the statutes of that State.

They next produce an instrument dated September 24th, 1867, which recites the granting of the foregoing and other patents to him, the said Michael H. Collins, that the said Florence E. Collins and Frances M. Collins have become the owners of the said invention for the territory of the United States, that Frances M. has assigned her interest to Sylvester W. Warren, that the said Michael has been appointed guardian of the said Florence E., whereby he is empowered to dispose of all the real and personal estate, goods, chattels, &c., of the said Florence E., and that it appears to the said Michael to be for the interest of his ward that her interest in the patents should be sold. It thereupon, in consideration of \$50, sells, assigns, &c., to Warren, all the right, title, and interest the said Florence has in the patent right and in the invention, by virtue of an assignment to her and Frances M., dated February 12th, 1867. The instrument is executed, under seal, by the said Michael, as guardian of the said Florence.

Next, an assignment by Frances M., dated, also, September 24th, 1867, (reciting, also, the assignment of February 12th, 1867, by Michael H. Collins to her and Florence E.,) whereby, in consideration of \$50, Frances M. assigns to Warren.

Next, an assignment under the same date, by the said Sylvester W. Warren to the said Michael H. Collins, in consideration of \$50, assigning to the latter the same patent, for the territory of the United States.

Next, an assignment, dated December 24th, 1867, which recites the granting of the patent, the assignment thereof to Florence E. (a minor daughter) and Frances M. Collins, and that said rights had been attempted to be reconveyed to the said Michael, but that some doubt exists as to the precise effect of said conveyances, and therefore, in consideration of \$30,000 paid to him, the said Michael, in his own behalf, and as guardian to the said Florence E., by the complainants in this suit,

he, the said Michael, in his own right, and as guardian of the said Florence E., assigns to the complainants the said letters patent and the invention secured thereby, and all rights of re-issue, extension, &c. Finally, an assignment under date of December 25th, 1867, reciting a doubt whether, Frances M., being the wife of Michael, received or now holds any interest in the patent, by the conveyance to her by her husband, and therefore the said Michael and Frances M., husband and wife, assign all the interest which she may have in the patent or invention, to the complainants herein.

The defendants insist, that Michael H. Collins, as guardian of Florence E., had, under the laws of Massachusetts, no authority to sell her interest in the patent, without the order or license of one of the Courts of that State, having jurisdiction for that purpose; and that the complainants, therefore, own only one-half of the patent, (as tenants in common with her,) and cannot maintain this suit without her presence as a party. The want of parties, not having been set up or suggested in the defendants' answer herein, cannot avail, unless the case is one in which the Court cannot proceed to a decree between the parties before the Court, without prejudice to the rights of those who are proper to be made parties, but who are not brought into Court. Whether the suggestion of want of parties, first made on the trial, has any sufficient foundation in fact, depends upon the construction and effect of the statutes of Massachusetts. It was claimed to be apparent on the face of the assignments, that Michael H. Collins had practised a fraud upon his infant daughter, through the form of a sale of her interest for a consideration of \$50, with intent that that interest should be immediately conveyed to him by the apparent purchaser, and so it was plain that he made use of his guardianship for the mere purpose of obtaining title to his ward's property, that he might sell the entire patent for the large consideration of \$30,000 paid to him by the complainants.

Whatever reason the assignments of the 24th of September, 1867, furnish for such a suspicion, the actual transfer to the complainants is free from any such appearance of fraud.

That instrument recites the doubt of the effect of the previous sale, and, in appropriate form, acknowledges the receipt of the full consideration in his own behalf, and as such guardian, and sufficiently charges him, in his capacity of guardian, with accountability for the actual proceeds of sale. If, therefore, he had authority to sell, the complainants, being plainly *bona fide* purchasers, acquired good title to the whole patent.

This question of authority must be determined by considering the effect of a statute of Massachusetts. Independent of the particular statute in question, it is not doubtful, that a guardian of the person and estate of an infant, appointed by the Court of Probate, has, as incidental to his office and duties, the power to sell personal property of his ward. His duty to pay debts, and to provide for the support, maintenance, and education of the ward, and, generally, to manage the estate, and his trust, indicated and expressed in the bond he is required to give, conditioned to manage, dispose of, and apply the same, and to account for all property and the proceeds thereof, all imply the power of the guardian in this respect. In this management, he is under a rigid responsibility, not only for the property but for its management and disposal for the best interest of the ward. If, therefore, he assumed to sell, for investment in other property, and, especially, if he ventured to change the nature of the property by investing in real estate, he would incur the hazard of an accounting in that respect, it may be many years afterwards, in which, in case of depreciation, the discretion exercised by him might be assailed and impeached, and he be subjected to loss on the one hand, and, on the other, the estate might be depreciated, notwithstanding the good faith of the guardian. And yet, at times, the interest of the ward may often be greatly promoted by change of investments, for the making of which the guardian would be unwilling to assume the responsibility.

The statute referred to enacts, that "the Probate Courts in the several counties, or the Supreme Judicial Court, on the application of a guardian, or any person interested in the estate of a ward, after notice to all other persons interested

therein, may authorize or require the guardian to sell and transfer any stock in the public funds, or in any corporation, or any other personal estate or effects held by him as guardian, and invest the proceeds thereof, and all other moneys in his hands, in real estate, or in any other manner that shall be most for the interest of all concerned. Said Courts respectively may make such further order, and give such directions, as the case may require, for managing, investing, and disposing of, the estate and effects in the hands of the guardian." (*Gen'l Stats. of Mass., ch. 109, § 22.*)

It is argued, that this statute has taken away the power of the guardian to sell any personal estate of his ward without an order of Court, and that a sale and transfer by the guardian, without such order, is void, and confers no title on the purchaser. I do not think that this was the design of the statute, or that such is its effect. It unquestionably gives jurisdiction to the Courts named summarily to control the guardian in this respect. So, also, it gives them power to control him generally in the management of the estate. But, the construction claimed would imply that he can, since the statute, do nothing lawfully except under a special judicial order obtained for the purpose. This jurisdiction is useful, in a high degree. It looks chiefly to the investment, and change of investment, of the estate. It enables the guardian to obtain advice and protection. He may often think a change of the property, and even an investment in real estate, best for the interest of his ward, and yet be unwilling to make it at the hazard of the result, and of the judgment which may be passed thereon at the end of, perhaps, very many years. He can, therefore, apply to the Court, and obtain recorded judicial approval, which will be his conclusive protection in the future. So, also, when any party interested in the estate is dissatisfied with the management of the estate, or deems a change in the investments desirable, he can apply, and, if it seem best, the Courts may require change of investments, or make other order touching management or disposal of the property. This summary jurisdiction is conservative, it may be availed of by

all parties, it protects the guardian in circumstances of doubt, and enables him to make investments not within the general line of his duty as guardian, and to make changes of investment without liability therefor on an accounting which may be required long afterwards, when, perhaps, unforeseen events make the acts seem negligent or improper; but it was not intended, and it does not operate, to deprive the guardian of power to sell personal property. In doing so, he acts subject to responsibility for good faith, proper prudence, and the proper use of the proceeds; and, in such case, the purchaser obtains title to the property sold.

This view of the complainants' title renders it unnecessary to say what, in this suit, would be the effect of a holding that they were not sole owners of the patent. The objection that Florence E. is not a party to the suit, not having been made either by plea or answer, would not necessarily defeat the suit. Even then, the complainants have title, though not as sole owners. At law, in an action for a tort, such non-joinder could only be urged by plea in abatement, or in diminution of damages; and, in equity, if the Court were of opinion that complete justice could be done between the parties before the Court, without prejudice to the absent party, it might perhaps proceed, treating the defendants as having waived the objection, or, at most, in such a state of the case, direct the absentee to be made a party, if that was deemed necessary. The conclusion, however, that the complainants have title, disposes of the objection.

(2.) The ground upon which alone the defendants claimed, on the trial, that they had not infringed the patent, is this—that the patent is for a combination of several parts, together constituting the improved lamp described in the patent; and that the defendants have only made and sold some of the parts of that combination, and cannot, therefore, be charged as infringers.

The patent is, in terms, for “a new and useful improvement in lamps.” The specification describes “the main purpose of the invention, or the principal part thereof,” to be,

not only to keep the lower part of the glass chimney of the lamp cool, so that it may readily be removed by the hand, but, also, to support the chimney without the use of a spring catch, or other devices, such as are ordinarily used. It thereupon proceeds to describe what is ordinarily called the burner of the lamp, namely, that portion which holds the wick tube, and which is to be screwed into the cap of the reservoir or body of the lamp, containing the oil or fluid used for combustion, consisting of an "air induction annular plate" at the bottom, convex, and provided with holes, to admit the air, and turned slightly up at the outer edge, to receive and sustain the chimney. The wick tube rises above it, and near, but just above the top, is surrounded by an "umbelliferous cone, or deflector," which extends outward to the sides of the chimney, and, the outer edge being cut or slit radially, the divided edge forms springs, which press against the interior of the chimney, and sustain it firmly in its upright position. The parts of the deflector between the slits being inclined downward, and being elastic, are adapted to receive the chimney, though there be irregularities and differences in the interior dimensions of chimneys which may be used. Other details are given pertaining to the construction, mode of operation, and uses of the parts, which it is not necessary to mention. It must suffice to say, that what is called the burner embraces all the metallic portion of the lamp containing, surrounding, or placed above the wick, and to be screwed into the cap of the reservoir. The specification also describes the glass chimney to be used, thus: "The lower part of the chimney, or that portion which extends from the deflector to the chimney rest, is constructed tubular and cylindrical. Above this part, the chimney bulges out, and finally is contracted to its top, in manner as shown in the drawings;" and, in the operation of the lamp, stress is laid upon the effect of perforations in the chimney rest, in its convex sides, through which the air, passing in currents, is alleged to impinge against the inner surface of the cylindrical portion of the chimney between the deflector and the chimney rest, and keep that part of the chimney cool, so that it may

Wallace v. Holmes.

readily be seized between the thumb and finger, when it is desired to remove it.'

The claim is as follows: "I claim the improved lamp, as not only constructed with its cone or deflector, (F,) and its chimney rest, (D,) and chimney, arranged with respect to each other as described, but as having the said deflector provided with peripheral springs, or the same, or the slits, (h, h,) and the rest, (D,) made concavo-convex, and provided with an annular groove or lip at the bottom, for supporting the chimney, the whole being substantially as described or represented."

The proof shows, that the defendants, from the fall of 1867, have been engaged in the manufacture and sale of lamp burners, called the "comet burners," which were not claimed on the trial to differ in any material particular from the patented invention, the principal apparent difference being in the substitution of a spiral elastic wire wound into the edges of the deflector, to press against the interior of the chimney and maintain its upright position, instead of the slit edge of the deflector itself, formed into springs, performing the same office. This, however, was not claimed to be a substantial difference, but was treated by both parties, for the purposes of the case, as, (which, I think, it unquestionably is,) an equivalent device, operating in the same manner and producing the same effect.

But, although it is proved that the defendants used their burners, so manufactured, in their store, with chimneys placed thereon, to exhibit their burners to customers, in order to make sales, and to demonstrate their superiority over other burners, there is no proof that the defendants ever manufactured or sold a chimney; and, hence, they insist, that, having made and sold only some of the parts included in the patented combination, they are not liable in this suit.

It is quite obvious, that the distinguishing feature of the invention of Collins is the burner, with its chimney rest, a deflector having peripheral springs, to sustain the chimney without the aid of a catch or screw, and with air passages operating, when in use, to keep the lower part of the chim-

ney cool, and, obviously, tending, by this means, and by the greater elevation of the flame, to prevent the lower portion of the burner, and top of the reservoir, from becoming unduly heated. It is, also, clear, and was proved, that the burner alone, or the burner attached to the reservoir, is utterly useless. A chimney must be applied, in order to its operation. So, also, a chimney without a burner is wholly useless.

It was claimed, in behalf of the complainants, that the chimney is no material part of the invention, as patented, and, therefore, that the defendants have made and sold all that is material in the patent. I incline, however, strongly to the opinion, that the patentee, in his specification and claim, instead of claiming the burner as new, and securing the exclusive right in respect to that, has claimed it in combination with a chimney, and must stand by his patent under that construction. In that view of the construction of the patent, the case stands thus: The complainants having a patent for an improved burner in combination with a chimney, the defendants have manufactured and sold extensively the burner, leaving the purchasers to supply the chimney, without which such burner is useless. They have done this for the express purpose of assisting, and making profit by assisting, in a gross infringement of the complainants' patent. They have exhibited their burner furnished with a chimney, using it in their sales room, to recommend it to customers, and prove its superiority, and, therefore, as a means of inducing the unlawful use of the complainants' invention. And now it is urged, that, having made and sold burners only, they are not infringers, even though they have distributed them throughout the country in competition with the complainants', and have, to their utmost ability, occupied the market, with the certain knowledge that such burners are to be used, as they can only be used, by the addition of a chimney. Manifestly, there is no merit in this defence, and it must be regretted if the law be not such as will protect the complainants against this palpable interference. If the complainants were to succeed in

Wallace v. Holmes.

finding those who manufactured chimneys for the express purpose of selling them to be used on these burners, the latter could clearly urge the same, if not a better, defence, to a prosecution; and so the complainants would be driven to the task of searching out the individual purchasers for use who actually place the chimney on the burner and use it—a consequence which, considering the small value of each separate lamp, and the trouble and expense of prosecution, would make the complainants helpless and remediless.

The rule of law invoked by the defendants is this—that, where a patent is for a combination merely, it is not infringed by one who uses one or more of the parts, but not all, to produce the same results, either by themselves, or by the aid of other devices. This rule is well settled, and is not questioned on this trial. The rule is fully stated by Chief Justice Taney, in *Prouty v. Ruggles*, (16 *Peters*, 336, 341,) and in other cases cited by the counsel. (*Byam v. Farr*, 1 *Curtis' C. R.*, 260, 265; *Foster v. Moore, Id.*, 279, 292; *Vance v. Campbell*, 1 *Black*, 427; *Eames v. Godfrey*, 1 *Wallace*, 78, 79.) But I am not satisfied that this rule will protect these defendants. If, in actual concert with a third party, with a view to the actual production of the patented improvement in lamps, and the sale and use thereof, they consented to manufacture the burner, and such other party to make the chimney, and, in such concert, they actually make and sell the burner, and he the chimney, each utterly useless without the other, and each intended to be used, and actually sold to be used, with the other, it cannot be doubtful, that they must be deemed to be joint infringers of the complainants' patent. It cannot be, that, where a useful machine is patented as a combination of parts, two or more can engage in its construction and sale, and protect themselves by showing, that, though united in an effort to produce the same machine, and sell it, and bring it into extensive use, each makes and sells one part only, which is useless without the others, and still another person, in precise conformity with the purpose in view, puts them together for use. If it were so, such patents would,

indeed, be of little value. In such case, all are tort-feasors, engaged in a common purpose to infringe the patent, and actually, by their concerted action, producing that result. In a suit brought against such party or parties, a question might be raised, whether all the actors in the wrong should be made parties defendant; but I apprehend, that, even at law, and, certainly when non-joinder was not pleaded, the want of all the parties would be no defence. Each is liable for all the damages.

Here, the actual concert with others is a certain inference from the nature of the case, and the distinct efforts of the defendants to bring the burner in question into use, which can only be done by adding the chimney. The defendants have not, perhaps, made an actual pre-arrangement with any particular person to supply the chimney to be added to the burner; but, every sale they make is a proposal to the purchaser to do this, and his purchase is a consent with the defendants that he will do it, or cause it to be done. The defendants are, therefore, active parties to the whole infringement, consenting and acting to that end, manufacturing and selling for that purpose. If the want of joinder of other parties could avail them for any purpose, (which is not to be conceded,) they must set it up as a defence, and point out the parties who are acting in express or implied concert with them. Nor is it any excuse, that parties desiring to use the burner have all the glass manufacturers in the world from whom to procure the chimneys. The question may be novel, but, in my judgment, upon these proofs, the defendants have no protection in the rule upon which alone they rely as a defence against the charge of infringement.

Independent of this question, the proofs show an actual use by the defendants of the entire subject of the patent; but, as the conclusion reached charges them as manufacturers and vendors, it is not material to enquire whether that use is within the scope of the bill of complaint, or would, by itself alone, entitle the complainants to charge them as infringers, in this suit.

The Waterbury Brass Company v. Miller.

The complainants must have a decree for an injunction and account, as prayed in the bill of complaint.

William B. Wooster, John S. Beach, and George Gifford,
for the plaintiffs.

Charles R. Ingersoll, Charles M. Keller, and Charles F. Blake, for the defendants.

THE WATERBURY BRASS COMPANY

vs.

EDWARD MILLER AND COMPANY AND EDWARD MILLER. IN
EQUITY.

The two re-issued letters patent granted to the Waterbury Brass Company, May 24th, 1870, as assignees of Hiram W. Hayden, the inventor, one for an "improvement in machine for making kettles," and the other for an "improvement in brass kettles," are valid.

The first named patent is for a machine, and the other patent is for the product of the process wrought by such machine, the machine and the process being described in the same terms in each.

The plaintiff's machine consisted of an engine lathe, a form, a clamp and other devices, and an adjustable tool-carriage, sustaining and guiding a burnishing or spinning tool in a definite, prescribed path, pressing the tool against the disk of metal operated upon, the tool carriage being moved by a screw connected by a gear wheel with the power moving the lathe. The defendant's machine was, in substance, in all respects, like the plaintiff's, except that the tool-carriage was moved by a rod connected with a cam acted on by a gear wheel actuated through a crank by the hand of a workman: *Held*, that this was not an essential difference.

The words, "substantially as described and shown," in the claim of the patent, held to relate only to material features of the combination specified, to be ascertained by considering the purpose of the machine, and what are the elements of the combination which constitute its distinctive character, and are effective in producing the peculiar result for which the contrivance is made.

The Waterbury Brass Company v. Miller,

Where the specification of a patent for a product fully describes the machine, and the process by which the product is produced, such patent may be good, even though the same specification, annexed to a patent for the machine, may not fully secure the patentee against the use of his actual invention, because of a defect in the claim of the latter patent.

(Before WOODRUFF, J., Connecticut, September 19th, 1871.)

WOODRUFF, J. The bill of complaint herein is filed to restrain the defendants from infringing two re-issued patents granted to the complainant as assignee of Hiram W. Hayden—one for an “improvement in machine for making kettles,” the other for an “improvement in brass kettles”—and for an account of the gains and profits hitherto made by the defendants by their alleged infringements. The defence contained in the answer of the defendants, and relied upon on the trial, consists in a denial that Hayden was the first inventor of the patented machine, or the kettle produced thereby, and, second, a denial that the defendants have infringed the patents.

It is not necessary to state the history of the complainant's patents, further than to say, that, on the 16th of December, 1851, letters patent were issued to Hayden for what he claims to have invented, which were afterwards extended for seven years, and subsequent surrenders and re-issues were made, upon the last of which the re-issued patents were granted to his assignee, on the 24th of May, 1870, which are relied upon in this suit.

The re-issued patent for an “improvement in brass kettles,” in its specification, sets out a process of making kettles upon a machine described in the very terms and details employed to describe the machine which is the subject of the other patent; that is to say, one patent describes a machine and mode of making a kettle, and other similar articles, and the other patent claims, as the invention of Hayden, “(1.) A kettle, or other similar metallic article, or vessel, made from a single sheet, or flat disk, or blank, of metal, stretched and compressed, so as to extend the sheet into its ultimate form,

The Waterbury Brass Company v. Miller.

by the process substantially as herein set forth; (2.) A kettle, or other similar metallic article, or vessel, having its greatest thickness at the bottom, and thinned, or gradually reduced in thickness, towards the top, by the process substantially as set forth." Hence, one patent is for a machine, described and operated as set forth in its specification. The other is for a product of the process, substantially as set forth in both.

Whether the product patent has been infringed, or can be infringed, by the defendants, without, at the same time, infringing the patent for the machine, may, perhaps, be a question of interest to the parties. It was asserted, and substantially assumed, by the counsel for the defendants, on the trial, that it could not. It may not be necessary to consider that question. If deemed material, some observations will be hereafter made on that subject. Assuming, for the present, that the questions between the parties are identical under each of the complainant's patents, as the machine and process of making kettles, and other articles, are described in precisely the same terms in each, and that neither is infringed unless both are infringed, it will be sufficient to describe the machine and its operation in very general terms.

For the purpose of bringing into view the questions to be decided in this case, the machine may be generally described as of two parts, each having, in the process of making a kettle, distinct offices or functions. 1st. An engine lathe, with its mandrel made to revolve by ordinary pulleys and gearing, and its mandrel foot or spindle pointed, to sustain the subject of the operation when clamped to the mandrel, or a chuck attached thereto, and made to revolve therewith. This differs in no material respect from an ordinary cutting lathe, although supplementary devices are added, to adapt it to the particular service intended, such as, a form or pattern, (in the shape of the interior of the article to be produced,) made fast to the mandrel and to revolve with it—a clamp, adapted to the office of pressing the material upon the form, which also revolves with the form and on the point or end of the spindle—and an arrangement at the lower end of the

lathe, by which the spindle is readily drawn back when it is desired to remove the kettle, &c. 2d. A burnishing or spinning tool and tool carriage, secured to the frame of the lathe, consisting of a burnishing or spinning tool, (either rigid, like an ordinary tool, or a roller, with a beveled rounded edge, held at the end of an adjustable arm,) and a carriage therefor, set upon slides, so adjustable, and so guided when adjusted, that the tool is sustained and guided in a precise path, prescribed for it before motion is given to the machine, the path being such, that the tool will, when moved, travel along and in near proximity to the form set upon the mandrel, as above described. It will be readily seen, that, by these two parts of the machine, provision is made, *first*, for inserting in a lathe a circular disk or blank of metal, clamping it firmly against a form, and causing it, together with such form, to revolve with rapidity; and, *second*, a burnishing or spinning tool, adjustable, so that it may set firmly against the disk, at or near its centre, and, if moved, it is mechanically guided along and in near proximity to the bottom and side of the form.

So far, nothing is described which produces the desired result. The lathe may be set in motion, and the disk or blank will revolve. The tool impinges on the disk near its centre, and the friction may produce some impression on the small circle, at the point of contact. But that is all. The material is in proper position, a form is in contact therewith, to communicate the desired shape, the tool is impinging on the disk near its centre, and a path is prescribed in which it must, if moved, inevitably travel, and, so travelling, it will spin or stretch the disk upon the form to the precise shape thereof, and, at the same time, reduce its circumference at its upper or outer edge; or, in other words, it will spin the metal to the size and form desired. Motion of the tool is, therefore, alone wanting to the operation; and this motion is, in the machine described by the specification in the complainant's patent, taken, by gear wheels and pinions, from the wheels or pulleys of the revolving lathe. These wheels and

pinions act upon a screw connected with the tool carriage, which will move it forward or backward, but with such arrangement of devices, that, as already stated, the tool must move in its prescribed path. By these means, the machine, being set in motion, spins the disk to the form inserted in the machine, and, by a succession of forms, to any shape desired, the slides of the tool carriage and path of the tool being readjusted with every change of form. This statement does not give the details of the machine, and it may not be sufficient to give a full comprehension of its operation. But I think it sufficient to bring into view the questions in contest, and, with some other details which may be suggested in the further discussion, to make the device intelligible.

The machine, in all its details, being described, and its complete operation stated, the specification annexed to what is called the machine patent, proceeds to state the claims:—"What is claimed as new, and the invention of the said Hiram W. Hayden, is as follows: 1. The application of a rotary metallic form or mold, or successive forms or molds, in combination with a proper tool or tools, roller or rollers, sustained, moved and directed in a proper path, by competent mechanical means, for the purpose of operating on a disk, blank, or plate of metal, so as to reduce it gradually from the centre to the edge, at the same time forming it with straight sides, by successive stages, into a complete kettle, or into any similar articles to the forming of which this apparatus can be applied, substantially as described and shown." The second claim relates to the peculiar arrangement for withdrawing or moving the spindle, to facilitate the removal of the kettle, which is not claimed to be infringed, and need not be further noticed.

1st. It was not questioned, on the trial, that the complainant's machine is useful. Prior to Hayden's invention, kettles and like articles had never been produced by machinery. With especial reference to brass kettles, the manner of producing by machinery, introduced by Hayden, wrought an entire revolution in the manufacture. Small articles of thin

The Waterbury Brass Company v. Miller.

metal had long been spun on a lathe, the spinning tool being held, guided and forced against the metal by the hand of the workman, sometimes aided by making the handle of the tool a lever, by a pin on the tool rest of the lathe, but the power of the workman was inadequate to apply the tool to thick disks or portions of metal, with force sufficient to spin kettles of suitable size and strength for most ordinary uses. Such kettles were produced by hammering, or by forcing plates or disks of metal into dies, and, to some extent, by stamping successively into various dies, gradually approximating the form desired, and, intermediate the stampings, burnishing the partially formed kettle upon a form. The defendants, however, on the trial herein, relied, as above stated, upon their allegations that Hayden was not the first inventor, and that they have not infringed his patent. They have proved, that the art of spinning metals is ancient. They produced one or more witnesses, who made small articles of brass, such as "binnacle bowls," parts of lamps and lanterns, &c., before the invention of Hayden, by spinning the sheets or disks of metal, or burnishing to a form on a lathe, the spinning or burnishing tool being held in the hand, guided thereby, and applied by the power of the workman to the revolving metal, to reduce it to the required form. Holtzapffel's work, on "Turning and Mechanical Manipulation," was also produced, in which the "spinning" of metals on a lathe, or "burnishing to form," is described, the tool, however, being directed, guided and applied by the power of the workman, aided by a pin in the lathe rest, as a fulcrum, to increase the pressure of the tool upon the metal.

These proofs fall far short of establishing that Hayden's machine was not new. In neither case was the tool sustained, guided, directed or applied by mechanism; it was not forced against the metal by the power of the machine; and it travelled, not in a path definitely and accurately prescribed, in which it was held by the mechanical devices employed, but it moved on or along the metal in such direction, and in such relation thereto, as the strength and skill of the workman

The Waterbury Brass Company v. Miller.

might avail to give to it. Whether it produced, even in the small articles which were thus made, a uniform thickness, or a gradually diminished thickness, or an irregularity in this respect, depended on the skill and ability of the workman, and not on any mechanism contrived to secure the result desired in this respect. Hayden, on the other hand, by his adjustable slides and guides, made the path of the tool even and certain, producing if he desired, a thickness of the sides of the kettles, &c., manufactured, diminishing upwards from the angle at the bottom, effecting, as the complainant alleges, an important and obviously useful result, especially in the kettles produced, much more perfectly, at least, than had ever before been attained in their manufacture, namely, that they were thick at the bottom, and at the angle, where thickness and strength were important, and diminished in thickness up the sides and at the top, where lightness was desirable.

The defendants also produced a patent, granted in England, dated February 3d, 1846, to T. F. Griffith, for "stamping and shaping metal." It must suffice to say of this, that the invention, so far as it has any possible relevancy, consisted, as described by the patentee, of an improvement in the form of dies used when shaping sheet metal by stamping, by which improvement the metal, in all parts, will more nearly retain the thickness of the original sheet metal from which the vessel or article is raised by stamping; and, also, in improving the process of manufacture, by changing the shape, intermediate the successive stampings, by burnishing it upon, and to the shape of, a form, by the ordinary burnisher. It is entirely manifest, from this statement, and, more distinctly, from other parts of his specification, that spinning the metal, to extend it, was no part of his design. He repudiates that, as a disadvantage, which his process avoids, and, in order to this, he uses a disk of a diameter about equal to the diameter of the upright vessel added to its depth. His process is a combination of stamping and burnishing. He invented no machine for the burnishing, and claims none; and, although, in the burnishing which he describes, he

changes the form of the article to fit the form inserted therein, and that may involve, in some slight degree, the spinning of the metal, he neither claimed, nor did, in fact, extend the metal by spinning it, so as to extend and make thin the sides, employing a disk of much smaller radius than the length of the completed vessel measured from the top to the centre of the bottom, nor does he describe or claim to have invented any machine whatever, by which any spinning or burnishing can be done.

On the question of the novelty of the invention of Hayden, the defendants put in evidence another patent, which assumed the appearance of much importance. It was granted in France, under date of December 4th, 1835, to Messieurs Japy, brothers, for "*une machine à rétreindre et à planer,*" which was translated by one of the witnesses, "*a machine to spin and smooth;*" and, also, an addition, or supplement, to such patent, which was granted under date of June 26th, 1838—both long prior to the invention of Hayden. Under the direction of one of the expert witnesses, the defendants had caused to be constructed a machine which, in most of its features, was strikingly like Hayden's machine, but, in the particular which, on the question of infringement hereafter to be considered, constitutes the difference between the Hayden machine and those the defendants make and use, conforming to the latter. Whereupon, the defendants claim, that the Hayden machine was not new in any of the features in which their machines are like it, Japy, brothers, having anticipated it by their machine, in 1835; and that, in any particulars in which the Hayden machine differs substantially from the Japy machine, the defendants have not copied it—in short, that the machines which the defendants use are, in substance, the Japy machine, invented long before Hayden made any invention. The machine constructed under the direction of the expert, and claimed to conform to the Japy patent, was produced on the trial, and was there set in operation. A disk of sheet brass was inserted, and it was reduced, by the tool, to substantially the same form as is produced by

The Waterbury Brass Company v. Miller.

the Hayden machine. The question, therefore, whether the machine described in the Japy patent was, in fact, so far like the Hayden machine, as to anticipate his invention, is of great importance, should it appear, in the further consideration of the case, that the machines used by the defendants are infringements of the Hayden patent.

On that question, I observe, first: It is entirely plain, upon a careful examination of the Japy patent, specification and drawings, that no idea of spinning the metal, to reduce it to the desired form, ever occurred to the Messieurs Japy, either in the making or use of their machine, or when they described it and the manner of constructing articles therewith. They formed the article sought to be produced by successive stamping in dies or collars, until, according to their express declaration, "the desired height of the sides is produced," and "it is finished in regard to shape, when it leaves the last collar." This process of stamping to a completed form is described in detail, and illustrated in the drawings, and the difference between the mode patented in the addition or supplement to the patent, and that at first employed by them, with the superiority of their new mode of stamping, are distinctly pointed out. This advantage consisted in raising the sides of the vessel, by using, first, a stamp and die or collar much larger than the diameter of the vessel to be produced, and raising a rim or very short portion of the side; then, by a stamp and die a little smaller, raising the side a little higher, and so on, through six or seven successive stampings, with stamps diminishing in size, but larger than the bottom of the vessel, until the last stamping, when a die and stamp of the size and form of the finished vessel was used. By this means, the metal at the angle of the bottom was bent but once, and was, therefore, less weakened, and less liable to be torn, broken, or made thin, than in former modes, where each successive blow, in the gradual raising of the sides by stamping, brought each bending and each concussion upon the metal at that precise angle. The vessel, thus completed in form, was inserted in a lathe, and upon a form which cor-

responded with the interior of the vessel, (called, in the original, "un emprunt,") attached to the mandrel, and, by the application of a tool or tools, while revolving, the bottom and sides were made smooth, the angle at the bottom was slightly rounded, and wrinkles and other inequalities were pressed to an even or polished surface. No suggestion of spinning or of burnishing is found in the description, and it is palpable that neither of them was effected in the operation. Neither the tool used, nor the process detailed, nor the power of the machine, was adapted to the making of kettles as described by Hayden, the lathe process being in truth a smoothing process, and nothing more.

The vessel having already received its form, it is obvious, that, if the process of spinning were applied to its bottom, its diameter would at once be enlarged, so that it would no longer fit its counterpart ("emprunt") on which it was supported; and, consequently, when the pressure of the finishing tool was applied at the angle, there would be no interior support between which and the tool the rounding process would be smoothly effected. So, also, if spinning was applied to the sides, they would be extended, and the form or shape of the vessel would be correspondingly changed, contrary to the distinctly declared purpose and intent of the patentees.

Besides this, the tool was not adapted to spinning. For the bottom, a roller was used, of a thickness greater than its radius, and, on its outer circumference or face, rounded to a half circle, the bottom only requiring to be passed over lightly, to polish it, since the stamping produced no wrinkles or irregularities therein. For the angle, another roller was used, of like size, having its outer circumference or face hollowed out, so as to round off, by pressure, the angle at the bottom. For the side, a third roller, of like size, was used, having its outer circumference or face flat and straight, like the surface of a short cylinder, one of the edges being slightly rounded, so as, in its movement along the side, to slide readily over or upon the wrinkles or other inequalities to be smoothed. Neither of these rollers was like an ordinary bur-

The Waterbury Brass Company v. Miller.

nisher, or like the spinning tool used by Hayden. Pressed firmly against the revolving vessel, they smoothed its surface, and their effect is aptly described by the patentees by the word "planer"—to smooth or planish.

The tool used to round the angle, being adjusted and pressed against the vessel, required no other motion; but the tools for the bottom and sides, sustained in carriages adapted to slide in a path parallel with the surface to be smoothed, were moved by means of a screw passing through the tool carriage in the like parallel, (or a cog wheel acting thereon with a similar result,) and terminating, at the outer end, by a crank turned by the hand of the workman, who thereby moved the tool faster or slower, backward or forward, at his pleasure. Though each tool was fixed to a separate carriage, the mechanical principle of each was the same, and they could be applied successively to the same lathe or each to a separate lathe, as convenience and economy of the time of the workman might make most advantageous. It is this application of the tool to the article produced, while such article is placed upon its counterpart, and made to revolve, and the use, for that purpose, of the adjustable sliding-tool carriage, with a set screw to press the tool or roller against the metal, which constitutes the likeness of the machine to the machine of Hayden. But I am decided in my conclusion, already stated, that spinning the metal was not the intent or purpose of the machine, and that no such conception was in the mind of the patentees, nor was the machine adapted to produce that effect. Possibly, the pressure upon the metal might very slightly enlarge it, the operation being, in a degree, like passing metal between two pressure rollers; but this effect, if produced, was not desired or sought, but constituted an imperfection, rather than an advantage, to the perfect operation. It cannot be denied that this device for smoothing the kettle, already complete in form, would be very suggestive to an ingenious mind already conversant with the art of hand spinning on a lathe. It was a near approach to a device for spinning by a machine; but I think it clear that it stopped short of it.

The Waterbury Brass Company v. Miller.

It is earnestly insisted, that, although Japy, brothers, did not conceive the idea of spinning the metal by the machine, it is enough for the defendants to show, that the machine which they invented had capacity to spin in the very manner of Hayden's; and that Hayden acquired no right as an inventor, by making substantially the same machine and putting it to a new and more beneficial use, namely, to spinning the metal into the desired form, although Japy, brothers, were wholly ignorant that any such capacity could be attributed to it. What I have already said expresses quite distinctly my conviction, that their machine had, in truth, no such capacity, or, certainly, not in any such degree as made it useful, as Hayden's machine is useful, for spinning metals.

On the trial, some importance was attached to the title given by Japy, brothers, to their invention, "*une machine à rétreindre et à planer*," as in conflict with the conclusion above expressed. A translation of their patent was produced, made by one of the witnesses, no doubt in entire good faith, in which the above words were translated, in one place, "a machine to spin and smooth," and, in another, "a machine for spinning and smoothing." The translator, however, with entire frankness, explained, that the word "*rétreindre*" did not, by its own mere force, mean, "to spin," but that, when used in connection with words indicating the employment of the lathe in stretching or extending metals, the whole, as, for example, "*rétreindre à la tour*," (to raise on or by a lathe,) meant the process of spinning. When, therefore, on a perusal of the Japy patent, he observed that a lathe was used in a portion of the operation, he assumed that this title of the patent imported "*rétreindre à la tour*," although those words were not used. An examination of the whole patent shows, that this conception of the translator was a mistake. The word "*rétreindre*" refers simply to the process of raising the sides, and that was done in dies or collars, and not on the lathe. In the supplement to the patent the word is used, and it is solely applied to the "raising" by punches and collars. In short, the word "*rétreindre*," in the title, is used to

The Waterbury Brass Company v. Miller.

designate the process of raising by punches and collars or dies, and "planer" to the lathe process, namely, to smooth or planish. The terms employed by the patentees, therefore, are in no conflict with the conclusion stated, but tend rather to confirm it.

The defendants rely, further, on their alleged practical demonstration, made on the trial, that the Japy machine had capacity to spin metals, including kettles, whether Japy, brothers, knew it or not, and that, when so used, it was substantially the same, in principle, structure and operation, as the machine of Hayden, except in the particular hereafter to be noticed, in which, also, the machines of the defendants differ from Hayden's. The machine which they had caused to be constructed, and which they produced as an example of the Japy machine, did, undoubtedly, reduce, on a small scale, a disk of metal to the form of a kettle, by compressing it upon a series of forms like those used by Hayden; but I was not then satisfied, and further examination and reflection have strengthened my doubt, that such machine, constructed and operated as it was, did, in fact, in a just sense, spin the metal to the desired form. It did unquestionably extend the metal, and conform it to the shape of the form on which it was compressed, it may, in a slight degree, have spun the metal, but the extension of the metal was mainly by pressure, as if the metal were between two rollers, pressed with great force thereon while in revolution. This would be the effect of pressing a short revolving cylinder strongly against the revolving metal, sustained by the revolving form on which it was placed. It may not be easy to define with precision how, in that process called spinning, the atoms or particles of metal are made to move upon each other, so as to assume a new aggregate form; but, in the product of the machine exhibited on the trial, the surface of the metal was not moved, it was compressed, the inner and outer surfaces being brought nearer together, as in the process of rolling metals. Witnesses testified that it did spin, some of them that it spun imperfectly, imputing the effect, so far as it was entitled to be called

spinning, to a change in the form or position of the tool, used by Japy, made to bear on the surface of the metal.

I do not find it necessary to suggest any bad faith in the defendants, or in the expert under whose direction this machine was constructed, by imputing to them an intentional exhibition of a machine, as the Japy machine, which differed substantially therefrom, or of conducting an operation therewith differing materially from the operation of which the Japy machine was capable. They have failed to satisfy me that the machine which they did produce and set in operation is, as a practicable thing, useful for spinning metals, or even that it is capable, without modification, of spinning metals of the thickness required for the large vessels produced by Hayden's machine.

In confirmation of the suggestion that it was not by spinning, but by pressure, as between the two rollers of a rolling mill, that the extension of the metal was effected, it was a fact worthy of notice, as distinguishing the machine produced from the Japy machine, that the defendants added to the tool carriage of Japy, brothers, a powerful standard or post, containing a set screw, to hold the revolving tool or short cylinder more strongly upon the metal to be extended. For the purposes for which the Japy machine was used, to wit, to smooth the surface, comparatively slight force was requisite. When the machine was sought to be applied to a new use, this supplemental device, or some other equivalent thereto, was necessary.

It might be added, that the product of the operation of the machine produced was less perfect than the similar product of the Hayden machine. The wrinkles caused by forcing the larger circumference of the disk upon the form were imperfectly removed, and, I think, there should be no hesitation in saying that an inspection of the two products shows that the machine of Hayden produces a different as well as a more complete result.

It was a pertinent and quite plausible suggestion of the counsel for the complainant, that the inventor of a machine

The Waterbury Brass Company v. Miller.

should be presumed to know not merely its purpose, but its capacity; that, when the product sought was in great demand, the art of spinning upon a lathe well known, the best mode of producing kettles and like articles the subject of attention and study, the objections to the process of stamping known and appreciated, the fact that an inventor of a machine, contrived expressly for the making of such articles, should have made a machine, and had no suspicion that it could raise the disk which he used to the required form by spinning, is no slight evidence that it had no such capacity; that the wisdom which comes to an alleged infringer after another inventor has perfected a similar machine by which the operation can be usefully performed, is not to destroy the claim to an original invention; and that an alleged example of a machine claimed to produce an effect which the original never did produce, and which its inventor never claimed for it, is to be looked upon with some distrust of its actual likeness to such original.

A doubt was created by the proofs, whether so much of the extension of the metal as could be imputed to spinning, in the operation of the machine produced, was not due to a slight change in the form of the tool or cylindrical roller used by Japy, brothers, and to a setting thereof in contact with the metal obliquely in a small degree, so that the corner pressed against the same. These changes would conform the action of the tool more nearly to that of the Hayden machine. It is not essential that I should go further than to say, that such doubt reasonably exists, upon the whole evidence. It is sufficient, that, upon all the proofs, and, especially, for the reasons I have stated, I am convinced that the invention of Japy, brothers, had neither design, purpose, nor capacity to effect the results produced by Hayden's machine; and it is, therefore, upon all the grounds which are above suggested, not established that Hayden was not the first inventor of the machine described in the complainant's patent. It is hardly necessary to add, that the burden rested on the defendants to establish this, if they rely on want of novelty as a defence, as

the patent itself is *prima facie* evidence that Hayden was such first inventor.

2d. The second ground of defence does not depend so much upon any disputed question of fact, as upon the proper construction and legal effect of the patents granted to the complainant for the inventions of Hayden. The defendants deny that they have infringed the patents. To make the foundation of this denial intelligible, the two principal parts of the Hayden machine have been already described, namely, an ordinary engine lathe, with a form attached to the mandrel, a clamp attached to the spindle, and other devices to facilitate the operation, which have been sufficiently referred to; and, second, an adjustable tool carriage, sustaining and guiding a burnishing or spinning tool in a definite prescribed path, pressing the tool against the disk of metal operated upon. To the actual working of the machine, it is essential that, when the form and disk of metal are revolved in the lathe, the tool should also be moved in its prescribed path, as already, with some particularity, stated. The patentee, in the specification, describes the Hayden machine as self-acting. The tool carriage is moved by a screw acting upon the tool carriage. As the screw is turned one way or the other, the carriage, and, of course, the tool sustained and guided thereby, is drawn in the desired direction along the face of the metal to be operated upon, in proper proximity to the form on the mandrel, and, for this purpose, this screw is connected, by a gear wheel, with the power which moves the lathe, so that both move together and by the same power.

The difference between this arrangement and that employed by the defendants in the machines claimed to be infringements of the complainant's patent, which is chiefly relied upon, is this—the rod which moves the tool carriage in the defendants' machine, is connected with a cam turned by a gear wheel, and a crank moved by the hand of the workman, instead of a screw and gear wheel acted on by the power which turns the lathe. The lathe, the form, the clamp, and their adaptations to this particular service, are substantially

The Waterbury Brass Company v. Miller.

the same. The tool carriage, tool post, and tool are substantially the same. The tool is sustained, guided and directed by slides and guides, differing in some details, but, for the purposes of this question, substantially the same. The tool is pressed against the revolving disk by a set screw, in the same manner. And the path in which the tool must travel is definitely prescribed by an adjustment of the slides and guides in the same manner, in substance, as in the Hayden machine. The tool is made to move, in the Hayden machine, by a screw acting on the tool carriage for that purpose; in the other, it is made to move by a cam. In Hayden's machine, the screw is turned by the power of the machine, acting through a gear wheel; in the machine constructed and used by the defendants, the cam is turned by a crank, or crank wheel, moved by the hand of the workman, acting through a gear wheel on the cam. Hereupon, two questions may be propounded—first, Does this difference relieve the defendants from the charge of appropriating the invention of Hayden? and, second, Is their machine an infringement of the letters patent? The latter is the important question here; for, it was correctly insisted by the counsel for the defendants, that it might be true that Hayden was the first inventor of the patented machine, and the defendants might have appropriated the product of his inventive skill, and might be in the actual use of his invention, and yet the letters patent granted for his invention may be, and the defendants insist, that the letters patent, or the specification and claim, are, in fact, expressed in such terms, and are thereby so restricted in their legal effect, that the patent itself is not infringed.

Where no patent is granted, the invention, however novel, ingenious or useful, may be used by any one; and, when a patent is granted, the patentee must stand by his patent. He gains no exclusive right except for such a machine as his patent describes and secures, though it may be far less broad or comprehensive than his actual invention. That the defendants' machines are within the actual invention of Hayden, seems to me to admit of no doubt. Its scope and its sub-

stance were the application of mechanism to the process of spinning metals to form, so as to produce a result theretofore never attained by mechanical means. The mechanical instruments, their arrangement, and their adaptation to the result were devised—brought into their proper relations. The requisite motion of the parts of the machinery was fully conceived. It was thenceforth in no wise essential to any principle involved in the invention, by what means motion was communicated to the machine, or either of the parts. It was only necessary to the successful operation of the machine, and to the certain production of the desired result, that the parts of the machine should move at the same time; that the lathe should revolve, with the form and the disk clamped thereon; and that the tool should also move in the path mechanically prescribed thereto. In the principle of the machine, or of its operation, it made not the slightest difference whether the lathe and the tool carriage were acted upon by the same power, whether the movement of the tool carriage was taken from the pulleys of the lathe, or from other belts and pulleys driven by the same engine, whether the movement of the lathe was by the power of one engine, and the movement of the tool carriage by the power of another. It sufficed if there was power applied adequate to move both, from whatever source derived. The source of power was no part of the invention. The means of producing motion in the lathe were the ordinary means, by belt, pulleys or equivalent instrumentalities. The specific means of moving the tool carriage was the screw. Any mechanical means of moving the tool, under the sustaining, guiding and directing influence of the devices for those purposes, would have been within the just scope of Hayden's invention. Movement, under pressure against the disk, and in the definite path prescribed to it, was the only essential, the substitution of one motor for another being a change only, without a substantial difference in the substance of the invention. One mode of producing the motion might be better than another; a party might improve upon any mode suggested by Hayden, and might patent his improvement;

The Waterbury Brass Company v. Miller.

but, the substance of Hayden's invention would still consist in his machine, however set in motion by power adequate to its operation.

It, however, remains to consider, next, whether the defendants infringe the patents actually granted to the complainant. What is claimed in the specification as the invention of Hayden, has already above been recited, and it is equally descriptive of the defendants' machines, unless the application of power derived from man, instead of the revolving lathe pulleys, constitutes a substantial difference, as that term is used in the law of patents.

Their machine or device consists of the application of a rotary metallic form or mold, or successive forms or molds, in combination with a proper tool or tools, roller or rollers, sustained, moved and directed in a proper path by competent mechanical means, for the purpose of operating on a disk, blank, or plate of metal, so as to reduce it gradually from the centre to the edge, at the same time forming it with straight sides, by successive stages, into a complete kettle, or into any similar articles to the forming of which such an apparatus can be applied; and, so far, this is precisely what is claimed, and, I think, shown, to be Hayden's invention. The claim in the patent is, the application of these instrumentalities, "substantially as described and shown" in the preceding specification; and the defendants insist that the terms of the claim so limit the operation of the patent, that the manner in which the defendants employ these instrumentalities is without the patent, and that they do not use them "substantially as described and shown," because they do not draw the power which moves the tool carriage from the engine which moves the lathe, but supply it by the hand of the workman, through a crank. The argument of the defendants' counsel did not present the point in the bald terms just stated, but I think that, when applied to the case in hand, that is its true expression.

In one of these machines, the turning and reversing of the screw moves the tool carriage and tool forward and backward

in its prescribed path ; in the other, the turning and reversing the cam does the same. In both, the motion is communicated through a gear wheel, the power that turns the lathe acting thereon in one case, and the power of the workman, through a crank, in the other. It was not claimed, on the trial, that the mechanical means for producing the actual movement of the carriage and tool were not substantially the same. It could not, with propriety, be so claimed. The proof was that they were the same, or precisely equivalent, excepting only that the power applied was drawn from a different source.

It is true, that the specification describes the Hayden machine as automatic ; and such is the effect of connecting the tool carriage with the power that turns the lathe. But this is merely incidental. It is in no sense essential to the machine, as an operative instrument to spin the metal and produce the article desired. It was necessary that the patentee should describe the means he employed to effect the process, and he has done so. But it was not of the essence of the invention, or of the means employed to apply it to use, that it should be automatic. Connecting the tool carriage with another power producing like motion, would be precisely equivalent, producing the same precise operation of the effective parts of the machine, and the same precise effect upon the disk of metal to be converted into the kettle, or other article. Many of the observations already made concerning the scope and essential features of the actual invention are pertinent to this point.

The positions assumed in behalf of the defendants, and most ably and ingeniously urged upon my attention, lead to this—Where a patentee describes a completed machine, however complicated, novel and useful in its combinations, and effective in those parts which alone have any peculiar influence in producing the article to be manufactured, but describes his machine as receiving motion through a gear wheel, from a shaft common to the entire machine, any other party may construct and use a machine in precise likeness thereto,

The Waterbury Brass Company v. Miller.

if he omits the connection of such gear wheel with the shaft, and substitutes a crank, to be turned by extraneous means. I cannot regard this as the effect of the words of the claim, "substantially as described and shown." They relate only to material features of the combination specified, and these are to be ascertained by considering the object or purpose of the machine, and what are the elements of the combination which create its distinctive character, and are effective in producing the peculiar result for which the contrivance is made. When these are ascertained, whatever embraces those elements, in the same combination, is an infringement. Those elements so combined constitute the machine patented, and "substantially as described and shown" is satisfied when another machine embodies those elements, thus combined. In this, the machine is complete, within the just and proper construction of the patent, before it is set in motion, and the source from which power to move it is derived is wholly immaterial; and, therefore, the instrument, out of the many ordinarily used to communicate the motion, that is, connect the power to the machine, is, also, immaterial. It is no distinctive feature of the machine. Any instrument adapted to receive the power, whether crank, pulley, cog wheel, or screw, is equivalent, in such a case. The particular instrument which the patentee uses is not an essential feature, in the subject of the patent.

The defendants insist that no part of the complainant's machine was new, that that machine, and all of Hayden's invention, consisted of a combination of old elements, and they, therefore, invoke the principle, perfectly well settled and familiar, that, where a patent is granted for a mere combination of old devices to produce a new result, such a patent is not infringed by one who produces the same result without using all the devices which are included in the combination patented. (*Prouty v. Ruggles*, 16 *Peters*, 336, 341; *Vance v. Campbell*, 1 *Black*, 427; *Eames v. Godfrey*, 1 *Wallace*, 78, 79; *Byam v. Farr*, 1 *Curtis' U. C. R.*, 260, 265; *Foster v. Moore, Id.*, 279, 292; *Doubleday v. Bracheo*, 2 *Fisher's Patent Cases*, 560; *Bliss v. Haight*, 3^d *Id.*, 621.)

In any proposed application of this principle, it should be borne in mind, that, in a certain sense, nearly all new machines are but combinations of old devices, that is to say, they do, or may, combine frames, bolts, screws and nuts, rods and pulleys, cranks and wheels, levers and pins, nails and boards, and, as the case may be, various other and more complicated devices, none of which, regarded singly or separately, are new; and yet the machine formed by the combination is new, as a structure, new in its operation, and new in the effect produced. The patent, in such case, is not for a mere combination, under the rule above referred to; and another machine, having the like construction, operation and effect, in all that constitutes the principle of the machine, and the efficient means of its operation, is an infringement of the patent, notwithstanding it may be moved by a less number of wheels, or be held together by a less number of clamps, screws or nails, bolts or keys, and notwithstanding drum and pulley may be substituted for cog wheels or other gear, or bolts for screws and nuts, or like changes be made in other devices employed to construct the machine. Such machine, notwithstanding such changes, is substantially the same, in its patentable characteristics, and would be within the terms of the specification, "substantially as described."

This is true, in my opinion, of the machines used by the defendants, in their relation to the complainant's patents. They appropriate its essential features, and employ the same process to which the metal is subjected in the manufacture.

The complainant's patent is not strictly for a combination, but, rather, for a machine, or a process wrought by a machine. Like all machines, it is constructed by combining elements or details. In its distinctive features, as a machine for the purposes described in the claim, and as a process of making kettles, it has been copied by the defendants. In the very particular which was claimed to distinguish their machine, namely, an arrangement for the movement by and under the control of the workman, its structure is within the description of the complainant's patent. The tool is moved, as well as guided

The Waterbury Brass Company v. Miller.

and directed, by mechanical means. The power alone is different. It may be true that there is an advantage in having the motion of the tool under the control of the workman. Witnesses so testified. Whether such advantage countervails the convenience and labor-saving of the power of the engine, is not very material; but if, in this respect, the device used by the defendants is an improvement, it cannot justify the use, in substance, of the complainant's machine.

Another observation, not essential to my views, is, if I have not misunderstood the structure and operation of the Hayden machine, quite significant, in showing a more complete likeness between the two than has hitherto been assumed. Although the Hayden machine may be operated automatically, it is not true that the motion of the tool is not under the control of the workman and by his hand. It was claimed that this feature in the defendants' machine was not only an advantage in enabling the workman to linger upon parts of the metal which might be found to require longer spinning, but that this was a distinctive peculiarity. Unless I have misunderstood the construction of the Hayden machine, that, also, is furnished with a lever under the hand of the workman, by means of which he can, at any moment, by disconnecting the gear, arrest the forward motion of the spinning tool, and so spin longer in any place where it is found necessary. In practice, my observation constrains me to doubt the practical importance of this feature, but, as matter of mechanical arrangement and capacity, it may not be unworthy of notice.

In the course of the trial, a fact was stated, in respect to which the expert witnesses differed, which, it was suggested, might affect the determination of the case. It was this—that the sliding-tool carriage, in the defendants' machine, does not move the tool in a perfectly straight line, but in a line very slightly curved, by reason of which the sides of the defendants' kettles are, in a barely perceptible degree, thinner at about half the distance from the bottom, than at the top. The degree will depend upon the length of the longitudinal arm

of the slide, and the height of the side of the article to be made. Such a thinning of the side is not a result of the process desired or desirable. It is, at most, an imperfection in the particular kind of sliding carriage which the defendants employ. Without entering into a detailed explanation, or occupying further time in the discussion of the point, it must suffice to say, that this circumstance does not render the defendants' machine no infringement. It embodies the principle, process, and substantial means which the Hayden machine embodies, and operates substantially in the same way, though, it may be, less perfectly.

I am aware, that I have been led to a discussion, in this case, of most unreasonable length; and, yet, there are some other considerations, on both sides, which might be suggested. I trust that, in my deliberations, I have not overlooked any which are material to the result, whether here stated, or not. The importance of the case to the parties, the learning, skill, and ardor exhibited by the respective counsel, the interesting nature of the questions, some desire, on my part, that parties should be assured that the case is not decided without careful examination and deliberation, and that the precise grounds of decision may be fully exhibited, and especially, the want of time, (when other cases, already argued, demand my attention,) to rewrite and abbreviate the opinion, must explain, if it do not excuse, so great prolixity.

I purposed adding some observations on the proposition of the defendants, that, if they have not infringed the patent for the machine, they cannot be held to have infringed the patent for the product, or the kettle, &c. The conclusion reached upon the other branch of the case renders this, now, unnecessary. I desire, however, for the present, not to be taken to assent to the proposition, in this case, even though I should express no dissent. A patent may be good for a product, although no patent has been obtained for the machine or process by which it is produced. So, a patent may be good for a product, even though the inventor has received a patent for the machine or process, which, by reason of imperfection in the

In re The Boston, Hartford and Erie Railroad Company.

specification and claim, fails to cover the whole invention. Where the patent for a product is accompanied by a specification which does, in fact, describe the machine and process, so as fully to satisfy the requirements of the law, and enable any one, of proper skill in the arts, to produce the article patented, by the means described, the patent for the product may be good, even though the same specification, annexed to a patent for the machine, might not fully secure the patentee against the use of his actual invention, because the claim was narrower than the invention, or because the claim was too broad, or was otherwise imperfect and ineffectual. In such case, the patent for the product might, possibly, be infringed, although no action could be maintained, based on the patent for the machine.

The complainant is entitled to a decree for an injunction and account, as prayed in the bill of complaint.

Edwin W. Stoughton and Charles M. Keller, for the plaintiffs.

John S. Beach, Benjamin F. Thurston, and Samuel S. Fisher, for the defendants.

In re THE BOSTON, HARTFORD, AND ERIE RAILROAD COMPANY.

The Boston, Hartford and Erie Railroad Company was a corporation, chartered by the State of Connecticut. It afterwards received a grant of corporate privileges, and was declared a corporation, by an Act of the Legislature of the State of Massachusetts, in which State it had an office, and carried on business. In October, 1870, a petition was filed by A., in the District Court for Massachusetts, in bankruptcy, upon which the corporation was, on the 2d of March, 1871, adjudged bankrupt. In December, 1870, J. filed a petition in the District Court for Connecticut, praying that the corporation be adjudged a bankrupt by that Court. Pending this latter petition, A. petitioned the District Court for Connecticut, and set forth, in his petition, and in a supple-

In re The Boston, Hartford and Erie Railroad Company.

mental petition, his proceedings in Massachusetts, and the adjudication there made, averring, also, that the proceedings in Connecticut were collusive between the corporation and J., and would prejudice the creditors of the corporation, create expense and conflict, and embarrass the settlement of the estate, and praying that he, A., might be allowed to appear and defend against the petition of J. The District Court for Connecticut dismissed such petition of A., and proceeded to an adjudication of bankruptcy against the corporation, and issued a warrant:

Held, (1.) That, A. being, in fact, a creditor of the corporation, his petition to the District Court for Connecticut should have been entertained, and that the facts set forth therein warranted his intervention;

(2.) That, whether the bankrupt was to be regarded as a single corporation, or as two corporations, united in interest, having one and the same corporators, and common property, rights, and franchises, and owing the same creditors, the District Court for Massachusetts should be permitted to exercise the jurisdiction it had acquired over the bankrupt and the estate, and carry the proceedings in bankruptcy to their final conclusion, without the interference of the District Court for Connecticut, and that all proceedings in that Court should be stayed.

(Before Woodruff, J., Connecticut, September 19th, 1871.)

ON the 20th of December, 1870, a petition was filed in the District Court, by James Alden, an alleged creditor of the Boston, Hartford and Erie Railroad Company, alleging the insolvency of the corporation, and the commission of an act of bankruptcy, and praying an adjudication declaring it bankrupt. To this petition, another alleged creditor, the Adams Express Company, by leave of the Court, became a party, as co-petitioner. Pending the proceedings, Seth Adams presented a petition to the District Court, and afterwards filed a supplemental petition, by which it appeared, that, before the filing of the petition of Alden in this District, he (Adams) had, on the 21st of October, 1870, filed, in the District Court for the District of Massachusetts, his petition against the same corporation, alleging insolvency and an act or acts of bankruptcy, and that such proceedings were thereupon had, upon due notice, that, on the 2d of March, 1871, the corporation was adjudged bankrupt. The petitioner also averred, that the proceedings in the District Court for Connecticut were collusive, and intended to, and would, prejudice the rights of the petitioner and other

In re The Boston, Hartford and Erie Railroad Company.

creditors ; that various defences existed thereto, which the company would not interpose ; and that, if the proceeding was further prosecuted in Connecticut, it would lead to great embarrassment, expense, conflict of title and jurisdiction, and consequent litigation, to the prejudice of the creditors, and the reduction of the assets. The petitioner, therefore, prayed, that he, as a creditor, upon whose application the company had been decreed bankrupt, in the District of Massachusetts, might be permitted to appear and defend against the petition of Alden in this District, and for other and further relief.

The District Court held these petitions of Adams to be insufficient, on their face, to warrant his admission as a co-defendant, for the purpose of resisting that of Alden, and dismissed them. To reverse this decision, Adams brought the present petition of review, before the Circuit Court. In this petition, he set forth the facts already recited, and averred that the District Court, after dismissing his petitions, adjudged the company bankrupt, and directed that a warrant issue to take possession of its estate, and that a meeting of the creditors had been called to choose assignees. He also averred, that the alleged bankrupt was chartered, under the name of the Boston, Hartford and Erie Railroad Company, by the State of Connecticut, in 1863, with the right to purchase, from any persons or corporations interested, the franchises and property of any and all railroad companies located, in whole or in part, in the State of Connecticut, whose routes, or any part thereof, were on the railway lines running from the harbor of Boston, in Massachusetts, to Willimantic, in Connecticut, and from Providence, in Rhode Island, through Willimantic, to Waterbury, in Connecticut, and thence to Fishkill, in the State of New York, together with the right to make joint stock with any of said other railroad companies, located or having routes upon said railway lines ; that said company was duly organized, under that Act ; that afterwards, and before the year 1868, the State of Massachusetts granted permission to certain railroad companies in that State to sell and transfer their franchises and property to the

In re The Boston, Hartford and Erie Railroad Company.

said Boston, Hartford and Erie Railroad Company, and declared the latter a corporation within that State, vested with all the franchises and powers pertaining to such corporations; and that, thereupon, under and by virtue of an Act of Massachusetts, approved April 29th, 1868, the said Boston, Hartford and Erie Railroad Company became and was incorporated and established a corporation in the last-named State. He also averred, that that corporation owned and operated a railroad in the States of Massachusetts, Rhode Island, and Connecticut, owning other property, also, in those States, and had its principal office, place of business, and domicile, in the city of Boston, in Massachusetts, where the same were, for more than six months before the petitioner filed his petition against the bankrupt in the District Court for the District of Massachusetts; that the petitioner was, in fact, a creditor; and that the said company had committed an act of bankruptcy, which was set forth.

Simeon E. Baldwin, for Adams.

WOODRUFF, J. The petition of review presented by Seth Adams, a creditor of the bankrupt corporation, was brought to a hearing upon an order to show cause, which was duly served upon the bankrupt, and upon the petitioning creditors prosecuting the proceeding in the District Court. No party appeared to oppose the application for a review and reversal of the order of the District Court, or to deny the allegations in the petition presented for that purpose. They are, therefore, for the purposes of such review, to be taken as admitted. The question, therefore, is—Ought Adams, upon the facts alleged by him, and not denied, to have been permitted to intervene, in the District Court for Connecticut, for the protection of the interest he had in the estate of the bankrupt corporation, and to take part either in arresting or controlling the proceedings in this District?

This may depend upon two questions: first, whether a creditor of an alleged bankrupt is, in any case, entitled to be

In re The Boston, Hartford and Erie Railroad Company.

heard in the District Court, touching any order which that Court may be asked to make by the bankrupt, or by a creditor petitioning that the debtor be adjudged a bankrupt, or, is such a proceeding so strictly *inter partes*, that no other creditor can intervene, for any purpose, prior to the adjudication; and, second, whether the present petitioner presented a case in which intervention was necessary or proper, for the protection of the estate, or his interest therein.

It has been said, that no creditor is entitled to be heard until he has proved his debt in due form, so as to entitle him to share in the assets of the estate. This may, perhaps, be true when the object of such intervention is simply to interfere with the distribution of the assets, though I am not willing to hold even that so broadly as to say, that no proof short of that of the formal and technical character contemplated by the forms of procedure will be sufficient to justify the court in entertaining an application by an actual creditor. *In re The Troy Woolen Co.*, (8 *Blatchf. C. C. R.*, 465,) on review, I affirmed an order of the District Court, setting aside a sale of real estate by the assignee, on the application of creditors of the bankrupt, although such formal proof had not been made, and their claim was, in fact, contested. I cannot admit that a creditor of the bankrupt can have no standing in Court to be heard touching the proceeding, in any case, prior to the adjudication, if he show, by proofs, satisfactory to the Court, that he is in fact a creditor, and that his interests will be affected by the adjudication. Formal proof of the debt, under the proceeding instituted, is, in some sense, a submission to the jurisdiction of the Court, and an apparent admission, if not a claim, that the adjudication should be made, and the estate administered, upon the petition then and there pending.

At first view, it is natural and agreeable to our ordinary ideas upon this subject, to assume that a petition by an alleged creditor against his debtor, to compel a submission of his estate to the bankruptcy Court, is a contest between two parties, with which a third person may not meddle. But

In re The Boston, Hartford and Erie Railroad Company.

this is by no means a complete view of the scope and effect of the proceeding. It is not a mere suit *inter partes*. It rather partakes of the nature of a proceeding *in rem*, in which every actual creditor has a direct interest. The proceeding is summary, and, in a high degree, informal, and it should be free from technical embarrassment. It is true, that no one is entitled to be heard therein who has no interest to protect; but, it seems to me, that, if the applicant does, in fact, show that he is a creditor, and has an interest to protect, it is not in accordance with the spirit of the proceeding to compel him first to file that formal proof of his debt which would import a recognition of the jurisdiction of the Court over the question of adjudication, and the administration of the assets, which, by his application, he seeks to contest. It is, also, true, that, to justify such intervention, the object or purpose disclosed must be one which, in a legal sense, is meritorious, and not purely officious. Therefore, the facts alleged as grounds of intervention must be such as entitle the applicant to consideration. The Court must be able to see that the intervention may serve some useful purpose, either in protecting the rights of the applicant, or those of the creditors at large. On this subject, the case of *Brewster v. Shelton*, (24 Conn. R., 140,) furnishes no remote analogy. There, a creditor made application to the proper Court to compel the appointment of trustees of the estate of his alleged debtor under the insolvent law of Connecticut. By that law, the appointment of trustees operated to defeat liens acquired by prior attachment of the debtor's property. Certain creditors, who had made the attachments, intervened for the protection of their liens, and were successful in defeating the application. The objection that they were not parties, and that they were not entitled to be heard, was urged: but the Supreme Court of Errors overruled this objection, and fully established their right to thus intervene. If it be suggested that the parties intervening in that case had acquired a specific lien, which was distinctly involved in the matter before the Court, such suggestion brings into view the precise relation of

In re The Boston, Hartford and Erie Railroad Company.

Adams, the present petitioner, to the matter pending in this case before the District Court for Connecticut.

Leaving, then, the general question, in what cases and for what purposes a creditor is entitled to be heard pending the proceeding—one of which is provided for in the 31st section of the bankrupt Act, under which the Courts have repeatedly held, that a creditor has a right to be heard in opposition to the discharge of the bankrupt, whether he has made formal proof of his debt or not, (*Bump's Bankrupt Law*, 4th ed., p. 433, and cases there cited,)—it is sufficient for us now to deal with the precise case presented by this petitioner. He is the petitioning creditor in the District of Massachusetts, and has there obtained an adjudication declaring the debtor bankrupt. He has thereby acquired a clear legal right to have its property applied to the payment of its debts, and, in a proper sense, has obtained an equitable lien on all the property and estate of the bankrupt, (assuming, of course, for the purposes of this question, that the proceeding in Massachusetts is legal and operative,) and has an interest in protecting it from embarrassment, complication, and waste, or withdrawal from the control of that Court, and, especially, in preventing the administration of any part of the assets from being transferred, under the forms of law, by collusion between the debtor and other creditors, to another and distant forum. But, nevertheless, as already observed, no intervention should be permitted, unless the case made by the petitioner shows that he is seeking a proper object, and presents the facts necessary to warrant the relief for which he asks. This leads to the consideration of the second question, and that is, whether the petitioner has shown a case which entitles him to intervene for the protection of his interest in this estate.

In determining this point, it is not necessary that I should express any opinion on the question whether the Boston, Hartford, and Erie Railroad Company is, under the laws of Connecticut and Massachusetts, one corporation, or two corporations having a common stock, a common property, com-

In re The Boston, Hartford and Erie Railroad Company.

mon powers, and identical corporators. Nor is it necessary to enquire here, whether railroad corporations are amenable to the bankrupt Act, as bankrupt debtors. For the purposes of this case, I might rest that point on the opinion of the learned justice of the Supreme Court, (Mr. Justice Clifford,) by which the jurisdiction of the bankrupt Courts over such corporations was affirmed, in the case against this company in the District of Massachusetts, (*Sweat v. Boston, Hartford & Erie R. R. Co.*, 5 *National Bankruptcy Register*, 234;) but the question is not material for the disposition of the case now before me. If such jurisdiction exists, then this case is to be considered in other aspects. If it does not exist, then, surely, that fact should be no obstacle to an intervention to stay its assumption and exercise.

The petition shows, that the debtor is either a single corporation, exercising corporate powers by authority of Massachusetts, having its principal office and place of business in Boston, in the District of Massachusetts, and, therefore, within the jurisdiction of the bankrupt Court there; or, two corporations united, owning all their property in common, conducting their business for the joint benefit, exercising like powers, having in all respects a common interest, performing all their functions to compass one object, for the benefit of the same corporators and stockholders, and having one set of creditors. In this aspect, they may be something more than partners; but they are so united that they are plainly within the section (§ 36) of the bankrupt Act relating to partnerships, as well as within that relating to joint stock companies (§ 37), and are, therefore, liable to be proceeded against in the District of Massachusetts. It is no less true, that, in either view of the character of the company, it was equally liable to be proceeded against in the District of Connecticut. The District Courts of both Districts had jurisdiction over the debtor, as a bankrupt.

In this state of the law, if no express rule were prescribed, no doubt would, I think, exist as to the proper practice, where the jurisdiction of both Courts, to adjudge the debtor bankrupt and administer its estate, was invoked. The familiar

In re The Boston, Hartford and Erie Railroad Company.

practice of Courts of equity, acting under the same general jurisdiction, would require them, when their jurisdiction should be invoked for the distribution of the same fund, by different complainants, to permit the Court first obtaining jurisdiction of the fund, by the institution of a suit, to proceed therewith to its full and complete disposal. For, it will be observed, that such a case is not analogous to that of two suits proceeding at the same time in different States, under different laws. Both the District Courts here are Federal tribunals, acting under Federal laws, constituting a single system, operating alike in both jurisdictions, and necessarily governed by the same rules, and proceeding to the same identical result. It would be a mere act of comity for a State tribunal to stay its own proceedings, on the ground that a suit was pending in a Court of another State, both suits being for the administration of the same fund; as, for example, in a case for the construction of a will, and the proper distribution of the estate under it. Here, there can be but one administration, there is but one bankrupt law, the authority and jurisdiction of the Courts are derived from one source, and the reasons for confining the administration of the estate to a single tribunal are of greater fitness and force.

I am, therefore, of opinion, that, in the absence of any express provision, it would be the duty of the other District Courts to yield the control and direction of the entire proceeding to that one whose jurisdiction was first invoked, and whose power is ample to accomplish all the purposes of the law, and protect the rights of all parties interested, under the authority of the same Act which governs each of them. (See the principle and some analogies in *Smith v. McIver*, 9 *Wheat.*, 532; *Ex parte Robinson*, 6 *McLean*, 355; *Shelby v. Bacon*, 10 *How.*, 56, 68; *Peale v. Phipps*, 14 *Id.*, 368, 374.) Without this, it is difficult to see how the law can be safely, uniformly, and legally administered. On the appointment of an assignee, all the property of the bankrupt is, by express terms, vested in him, by the assignment made, and such assignment relates back to the commencement of the proceedings. When, there-

In re The Boston, Hartford and Erie Railroad Company.

fore, one Court, having jurisdiction, has adjudged a debtor a bankrupt, appointed an assignee, and executed the assignment, nothing of the property of the bankrupt remains in him to be taken or administered by another tribunal. All is vested in the assignee appointed by the other, as of the time when the first petition was filed. If, on a second petition, filed in another Court, the latter were to proceed to appoint an assignee, it is difficult to perceive that the title of the latter would not be completely overridden. To use, for illustration, the present case. The petition to put this debtor into bankruptcy was first filed in the District Court in Massachusetts, which clearly had jurisdiction, and that Court had adjudged it bankrupt before any such adjudication had taken place in Connecticut. If, then, as the statute expressly provides, the appointment of the assignee, and the assignment to him, relate back to the commencement of the proceedings, how can any assignee appointed in Connecticut, under proceedings commenced subsequent to the beginning of those in Massachusetts, acquire any title or right to intermeddle with the administration, as against the assignee appointed in the latter District, and, by relation, if not by prior appointment, having prior and exclusive title?

The law, however, contains other provisions bearing on the subject, and the General Orders of the Supreme Court, made by express authority of the Act, shed further light for our guidance. In the case of co-partnerships, when the co-partners reside in different districts, and, therefore, more than one Court has jurisdiction, it is provided, that the Court in which the petition is first filed shall retain exclusive jurisdiction over the case, (§ 36.) This provision is to prevent the complication which might arise if both Courts were to attempt to administer the same estate, and furnishes an apt analogy, if not a rule, for this precise case. It is possible, that the same assignee might be chosen and approved in each jurisdiction; but it is also possible, that different ones might be chosen. And, if the same were chosen in both, there is no fitness nor propriety that there should be a double accounting,

In re The Boston, Hartford and Erie Railroad Company.

or a double series of orders, with double services and costs. The Act authorizes proceedings against a single debtor, either in the district in which he resides, or that in which he carries on business. Proceedings might, therefore, be commenced against him in both; and I find, in the terms of the Act, no express declaration as to which Court shall have priority of jurisdiction. The implication, however, resulting from the vesting in the assignee the title to all the property of the bankrupt by relation back to the commencement of the proceedings, seems necessarily to involve the same rule as that expressly prescribed in the case of co-partnerships.

But, the Supreme Court, whose orders, in cases not otherwise provided for, or, at least, so far as they are consistent with what is provided by the Act, are conclusive, by General Order number sixteen, have directed, that, "in case two or more petitions shall be filed against the same individual in different districts, the first hearing shall be had in the district in which the debtor has his domicile; * * * and, in case of two or more petitions against the same firm in different Courts, * * * the petition first filed shall be first heard; * * * and, in either case, the proceedings upon the other petitions may be stayed until an adjudication is made upon the petition first heard, and the Court which makes the first adjudication of bankruptcy shall retain jurisdiction over all proceedings therein until the same shall be closed." Upon the facts stated in this petition of review, if the bankrupt be regarded as a single corporation and having a domicile, within the meaning of this order of the Supreme Court, that domicile is as truly in Massachusetts as in Connecticut, the bankrupt having been incorporated by both States. If, however, it is to be regarded as composed of joint parties, and in the nature of a copartnership, then the petition filed in Massachusetts was entitled to be first heard, and then, as in the other case, provision was made for staying the proceedings in Connecticut; and the Court in Massachusetts, having made the first adjudication of bankruptcy, retained jurisdiction over all proceedings therein until the same shall be closed. But, if the char-

In re The Boston, Hartford and Erie Railroad Company.

acter of the debtor here is anomalous, not precisely answering either description, then the law and the order of the Supreme Court prescribe a rule, which, from its obvious fitness and propriety, should be the guide of the Court in these proceedings, in order to avoid the complication, embarrassment and expense, if not inevitable conflict, resulting from an endeavor to administer the same fund in two districts.

It may not follow, that the Court in which the latest petition is filed, must, or ought to, dismiss the proceeding lawfully and regularly instituted; but it should, at least, in my opinion, on a proper application, stay the proceedings, until some adjudication touching the bankruptcy be had in the tribunal in which the petition was first filed; or, if the debtor has been already adjudged bankrupt there, abstain from an apparent interference with the title of the assignee to the estate.

If these views are correct, then there was ground for the application to the Court in Connecticut to stay proceedings, and yield to the already acquired and exclusive jurisdiction of the Court in Massachusetts. This ground was fully shown by the petitioner in his application to the District Court, and it was further alleged that the debtor was in collusion with the petitioning creditors here, and would make no resistance to their petition. Who, then, was authorized to present these facts to the District Court in this State, and assert the prior and exclusive jurisdiction of the Court in Massachusetts? The debtor would not. The petitioning creditors would not. If they were acting in collusion, their purpose could only be to complicate and embarrass the proceedings, to the prejudice of the creditors, and to produce conflict and litigation. I feel no hesitation in saying, that the petitioning creditor in Massachusetts was eminently the proper party to bring the state of this case to the attention of the Court, and ask to be heard in resistance to further proceedings which tended to his prejudice, as the prosecuting creditor, and which, if permitted to have any operation, tended to defeat the rights he had acquired, and the effect of the adjudication, in Massachusetts.

In re The Boston, Hartford and Erie Railroad Company.

Unless this be so, then the neglect of the debtor to resist the later proceedings defeats the express provision giving exclusive jurisdiction to the Court in which a petition is first filed, or that which gives to the Court making the first adjudication exclusive jurisdiction; or it leaves the Court to proceed to an idle and useless form of adjudication and administration, after its jurisdiction has been, for the time at least, defeated, and when the property of the bankrupt is divested, so as to leave nothing for the Court to administer. I think, therefore, that the petition of Adams should have been entertained, and, if the facts therein alleged were not controverted, or were found true, the proceedings in the Court below should have been stayed.

Since the argument of this petition of review, the creditors, proceeding under the adjudication of bankruptcy in the District Court, have chosen the same assignees who were chosen by the creditors under the proceedings in Massachusetts, and they have been approved by both Courts.

I find nothing whatever in the case to warrant the conclusion that the adjudication of bankruptcy in this State was an improper decree. Surely, the petitioning creditor, who himself sought a like decree in Massachusetts, cannot deny that the debtor was bankrupt, and could be properly so adjudged. And, as to the assignees, they are duly appointed by the Court in Massachusetts, and the further sanction of an appointment in Connecticut can by no possibility prejudice the petitioner. There is, therefore, in the present condition of the matter, no occasion for disturbing what has been done. All that can be said is, that, according to the views which I have here expressed, the petitioner was entitled to have the proceeding earlier stayed, to avoid a possible result that cannot now happen. It may be suggested, that these subsequent occurrences are not regularly before me on this review. In technical strictness, that is true; but I have ample power to permit them to be brought before me. Such supervision as is conferred on this Court in these cases, summary in its na-

In re David Cornwall.

ture, is not to be so hampered by technical rules, as to prevent my dealing with the case as it now exists.

It seems to me, therefore, that, unless the petitioner desires to deny that those subsequent proceedings took place as I have stated, all that is necessary now is, to stay the proceedings in the District Court. It is not easy to see that there can ever be occasion to move further therein; but, if the jurisdiction of the Court in Massachusetts should in any way be defeated, or the proceedings therein be reversed, or dismissed, upon any grounds not also applicable to those pending in this District, it may be of the utmost importance to all the creditors, and especially to the petitioner himself, that those proceedings be resumed and continued to the final close of the administration of this bankrupt estate.

In re DAVID CORNWALL.

In a proceeding in involuntary bankruptcy, the alleged debtor may deny that the petitioner for an adjudication is a creditor, and may, if he maintains such denial by proof, have the petition dismissed.

Where a person, whose property exceeds in value all that he owes, with a view to the payment of his debts, and to secure to himself a maintenance in the future, conveys that property to another, on an agreement that the grantee shall pay all that he owes, and support him during the residue of his life, such a conveyance is not, *per se*, fraudulent and void, as against creditors.

Where the statutes of limitation of the State in which the petitioning creditor in a proceeding in involuntary bankruptcy and his alleged debtor reside, have created a bar to the recovery of the alleged debt by action, such debt cannot form a basis for an adjudication of bankruptcy on the petition; and the holder of a claim, so barred, is not entitled to prosecute such a petition.

Where a debt is barred by the statute of limitations, a promise by the debtor to pay it when he is able, is conditional, and does not create an obligation, as a revival of the debt, until ability to pay appears; but, where there is a

In re David Cornwall.

present debt, a promise to pay it when able does not destroy or postpone the right of the creditor to sue, or prevent the running of the statute.

(Before WOODRUFF, J., Connecticut, September 19th, 1871.)

THIS was a petition by Nathaniel O. Cornwall for the review and reversal of an order of the District Court dismissing his petition, as a creditor of David Cornwall, for an adjudication, declaring the latter a bankrupt.

Simson E. Baldwin and *Edwin E. Marvin*, for the petitioner.

Charles E. Perkins and *Alfred Hall*, for the respondent.

WOODRUFF, J. On the 16th of June, 1870, Nathaniel O. Cornwall, a resident of Portland, in this District, presented to the District Court his petition, under the 39th and 40th sections of the national bankrupt law, alleging that he is a creditor of David Cornwall, (his father), also a resident of said Portland, averring that the latter has committed an act of bankruptcy, and praying that he be declared a bankrupt, and that a warrant issue to take possession of his estate, that the same may be distributed, &c. The act of bankruptcy, as stated in the petition, is, that the said David Cornwall, being possessed of certain estate or property, situated in Portland, real and personal, and being indebted to the petitioner and others, did, on the 31st day of March, 1870, with a view to insolvency, and with intent to delay, hinder or defraud, as the case may be, his creditors, convey the property mentioned in the petition to Maria and Elizabeth Cornwall, of the said Portland, (his daughters, and sisters of the petitioner,) the same being all the property, real and personal, which he possessed, or which could be held as security for the payment of his, the said David Cornwall's, just and lawful debts. The indebtedness, claimed by the petitioner to constitute him a creditor of David Cornwall, is stated to be upon a promissory note, for money loaned to the said David, dated Portland, August 29th, 1869, for five hundred dollars, payable to the

petitioner, or to his order, on demand, with interest from its date; and, also, the sum of five hundred and twenty dollars and eighty-eight cents, loaned to the said David, July 14th, 1854, the receipt of which is acknowledged in writing, with a promise to deposit the same, for the petitioner's benefit, in the savings bank; together, amounting to \$1,020 88, exclusive of interest.

The respondent, David Cornwall, appeared and answered the petition, and, by his answer, denies that he is indebted to the petitioner in any sum whatever. He admits that he did, on the 31st day of March, 1870, execute the alleged conveyance of all his property to his daughters, Maria A. and Elizabeth, but denies that the same was done with a view to insolvency, or with any intent to delay, hinder, or defraud his creditors, and states, that, at the time of such conveyance, he had no creditors except his two daughters, (to whom he was then largely indebted,) and except a few small bills in the neighborhood, not amounting to three hundred dollars; that his two daughters, in consideration of such conveyance, promised and agreed with him, that they would support him during life, and would pay all his debts then existing; that they are ready and willing to pay all valid claims existing against him; and that they informed the petitioner, before he commenced the proceedings, that they would pay all valid claims he had against his said father. The answer also states the history of the apparent indebtedness of the respondent to the petitioner, in detail, averring, that the \$520 88, received from the petitioner in 1854, was given to him by his said son in consideration of, and in part repayment of, advances which he had made for the education of the petitioner at college, in order to which he had been compelled to borrow money; that, afterwards, in his advanced years, he was embarrassed by debts, which he had been unable to pay, while his said son had accumulated large wealth, and such sum was given and received to relieve him from such embarrassment, and without any expectation that the respondent was to repay the same, or be considered or treated as a debtor to his said son therefor; that more than six years have elapsed since the said

In re David Cornwall.

sum was so given to him by his said son, and, if the same constituted a debt, it has been barred by the statute of limitations of the said State of Connecticut; that the note for \$500, dated August 29th, 1869, was made without legal consideration; that the sum of \$500 was a voluntary gift made by the petitioner for the especial relief and benefit of his aged and infirm mother, to be expended, and, in fact, was expended, in repairing a portion of their dwelling house, which had become old and decayed, and which the respondent had not means then to repair; that such repairs were proposed by the petitioner, the furnishing of the money for the purpose was tendered by him, and the repairs were consented to, and were made by the respondent, in assent to the petitioner's proposal, and on his agreement to give the money to pay therefor; that, when the petitioner requested a note therefor, he reiterated that the money was a gift, but stated, that, as the respondent was then embarrassed by indorsements for another, he desired to hold a note for the benefit of his sisters, so that, if the respondent should fail or die, he could present said note against the respondent's estate, and obtain something for his said sisters; and that the respondent, in confidence in his said son, gave him a note, as requested, and afterwards, on the 29th of March, 1869, upon the request of the petitioner, and his statement that said note was lost, he gave him another note for the same purpose, which is the note mentioned in the petition, and is without consideration and void.

Upon the petition and answer, and upon the proofs of the parties respectively, the matter was brought to a hearing in the District Court, and the petition was dismissed. The opinion of the District Judge shows that, without deciding other questions, he deemed it sufficient to find that the petitioner is not in fact a creditor, upon two principal grounds—*first*, that the note mentioned in the petition was without legal consideration, the moneys advanced, and alleged by the petitioner to be the consideration of the note, having been, in truth and in fact, a voluntary gift by the petitioner, out of his abundance, to and for the relief and comfort of his aged and

infirm parents, and accepted as such; and, *second*, that, if the moneys furnished to the father in 1854, and applied by him to the repayment of moneys borrowed, ever created or constituted an indebtedness by the father to the son, the latter was, by the statute of limitations of the State of Connecticut, barred from having or maintaining any action therefor, and he, therefore, had no standing thereupon to ask, as a creditor, that David Cornwall be decreed a bankrupt.

Upon this appeal or review of the order of the District Court, it is insisted, that the order should be reversed, on various grounds, the chief whereof may be stated and considered in the following order, namely:—1st. That the petitioner having, by his petition and the proofs furnished in support thereof, shown himself to be apparently, or *prima facie*, a creditor, the respondent was not at liberty, by putting that fact in issue, to have a trial of the question, and an adjudication dismissing the petition, but the cause should have proceeded to a decree upon the matter charged as an act of bankruptcy, and, that being established, the petitioner, when he offered proof of his debt, with a view to share in the distribution of the estate, would, if his claim was contested and disallowed, be entitled to a trial by jury before its final rejection; 2d. That the proofs do not warrant the finding that the \$500, advanced for the repairs of the respondent's dwelling house, were a gift, but, on the contrary, they show, that the money was sought as a loan, advanced as a loan, and secured as a loan by the promissory note of the respondent, upon the loss of which the note mentioned in the petition was given, as a new or substituted security; 3d. That the State statutes of limitation have no application to proceedings in bankruptcy; that, notwithstanding the lapse of time, the debt still exists; that, while it may be true, that, in one or even more States, no action will lie for its recovery, an action may be maintained therefor in another State, if the respondent is found therein; and that, unless it is shown that it cannot be recovered in any of the United States, it must be declared a debt, and the Court of bankruptcy, as a national

tribunal, must recognize as a creditor any one who has a cause of action valid in any State of the Union; 4th. That, if the statute of limitations in Connecticut be, in general, recognized by the Federal Court in bankruptcy, as disabling the holder of a claim from proceeding against his debtor, the petitioner's claim, in the present case, is not barred thereby, for two reasons—*first*. The promise made in 1854, as it appears by the proofs, in writing, was, that the respondent would, "as soon as it is in his power," deposit it in the savings bank, according to the petitioner's previous direction, so that the latter would be able to control it at pleasure, and that it has not been proved that six years have elapsed since it was in the power of the respondent to do this, and, therefore, it does not appear that six years have elapsed since the cause of action accrued; or, *second*. The respondent held the money of the petitioner upon a trust, to deposit it in the savings bank, to the account of the petitioner, and to such a trust the statute of limitations does not apply, and, therefore, the claim is not barred.

1. The claim, that, in proceedings for a compulsory decree, declaring a respondent a bankrupt, the latter may not deny that the petitioner is a creditor, or may not, by proofs, maintain such denial, and thereupon dismiss the petition, is, I think, wholly untenable. It is true, that, where a party has been adjudged a bankrupt, no one claiming to be a creditor can be excluded from a share in the distribution of the estate, without having the opportunity, furnished by the 24th section, to appeal, and, on that appeal, to have his claim tried, as in an action at law, in the usual manner in the Courts of the United States. But, this does not reach the question, whether a party has been, by the law, made liable to be declared a bankrupt, at the instance of one who has in fact no claim against him, and no interest in the question whether the party has committed an act of bankruptcy or not.

Section 39 of the bankrupt law declares what shall be deemed acts of bankruptcy, and makes him, who has committed such an act, liable to be "adjudged a bankrupt, on the

petition of one or more of his creditors, the aggregate of whose debts provable under this Act amount to at least two hundred and fifty dollars, provided such petition is brought within six months after the act of bankruptcy shall have been committed." To the maintenance of the petition, or to give the petitioner any standing in Court, several things must concur. The petitioner must be a creditor, the debt due to him must be provable under the Act, and the amount thereof must be at least two hundred and fifty dollars. Unless all these concur, he has no right to prosecute the petition; and, however he may be able to prove, or does prove, the commission of acts of bankruptcy, he is not, by the law, clothed with the right or power to begin or sustain a prosecution, or ask a decree. It is nowhere, expressly or impliedly, said, that one who can furnish proof which, unexplained and uncontradicted, would show, *prima facie*, that he is such creditor, may file such a petition, or that a party may be adjudged a bankrupt upon such a petition. The objection goes not merely to the disability of the petitioner, but to jurisdiction of the cause. And this should be so. It would be monstrous injustice, if parties were not only liable to be proceeded against, but must necessarily be adjudged bankrupt, submit to a warrant, and be dispossessed of all their property, at the instance of any one and every one who, either dishonestly or by mistake, was able to present, by petition and affidavits, *prima facie* evidence of a debt, when, in truth, none existed. It might often happen, that the only act of bankruptcy alleged depended, for its character, upon the very question whether any debt was owing to the petitioner; and, if a mere *prima facie* case, shown by the petitioner, precluded further inquiry on that question, a party might be declared a bankrupt, his property be subjected to administration under the law, and, in the end, it would appear, that, the petitioner having no debt, no act of bankruptcy had been committed, and the whole proceeding, imperious as it must be, was wholly groundless. Not only so; no other creditor appearing, the proceeds of the estate must be returned to the party groundlessly prosecuted.

In re David Cornwall.

If, therefore, there were nothing further in the Act bearing upon this point, I should not hesitate to say, that a respondent, called by the petition into the District Court, had the clear and full right to meet the petitioner at the threshold of the proceeding, by denying and disproving any of the facts without which the petitioner has no authority in law to maintain the proceeding. But, section 41 gives this right in express terms, and makes it the imperative duty of the Court to proceed summarily to hear the allegations of the alleged debtor; and, as to the commission of the act of bankruptcy, it must order a trial by jury, if he demands it, and if, upon such hearing or trial, the debtor proves that the facts set forth in the petition are not true, "the proceedings shall be dismissed, and the respondent shall recover costs." What are "the facts set forth in the petition?" Obviously, all those which are, by the 39th section, necessary to make it the duty of the Court to adjudge the respondent a bankrupt. That is to say, there must be before the Court a creditor, by a provable debt, to the required amount, and, this being true, there must be established an act of bankruptcy, within six months before the filing of the petition. Let it be supposed, that the petition did not state all these facts, it cannot be doubted that it would be the duty of the Court to dismiss it. So, if the respondent shows that any of these facts, when alleged in the petition, are not true, the statute requires that the proceedings be dismissed.

The inquiry in the District Court, whether, in this case, the petitioner was a creditor, having a debt against the respondent provable under the Act, was, therefore, a proper inquiry, and, if it was properly found in the negative, the order dismissing the proceeding was not erroneous.

2. Upon the merits of the case, there is, to my mind, a difficulty in sustaining the petitioner's application, in the point upon which no opinion was expressed in the District Court. As already observed, to warrant the adjudication sought, it must appear that an act of bankruptcy has been committed. In the petition herein, the precise act upon

which the petitioner relies is stated, to wit, that the respondent, being indebted to the petitioner and others, conveyed his property to Maria and Elizabeth Cornwall, with a view to insolvency, and with intent to delay, hinder or defraud, as the case may be, his creditors.

Now, the proof is, that the object of the conveyance was the payment of all the debts of the respondent, and to make provision for his support by his daughters in his old age. This was not a purpose fraudulent as to any one. So far from being a conveyance with a view to insolvency, it contemplated actual solvency, and actual payment of all he owed; and his property, according to the proof, was fully adequate, and more than adequate, for the purpose, even conceding that the petitioner was a creditor to the full amount which, according to his own statement of the transactions, he could be allowed. Unless, then, the transaction was, *per se*, fraudulent and void, as against creditors, it could not, upon this proof, be pronounced an act of bankruptcy. This raises the question—When a person, whose property exceeds in value all that he owes, with a view to the payment of his debts, and to secure to himself a maintenance in the future, conveys that property to another, on an agreement that the grantee shall pay all that he (the grantor) owes, and support him during the residue of his days, is such conveyance, *per se*, fraudulent and void, as against creditors? Such arrangements, by aged and infirm parents, to relieve themselves of care and labor in their declining years, have not heretofore been unusual. They are commonly made with children, or with some one selected, and, in a sense, adopted, to stand in that relation. The facts, that the grantor is aged, infirm, and incapable of labor to make his estate productive, that the grantee is already a creditor, and, therefore, has a claim to receive a portion of such property, that the grantor owes but little besides, that the grantee is already, (irrespective of such conveyance,) of sufficient ability to pay all the debts, and that he proceeds to do so, and stands ready and willing to pay all that the grantor owes, may not give a transaction validity, which, on

its face, must be held fraudulent; but, they do utterly repel the suggestion of fraudulent intent or purpose in the minds of the parties thereto, and all these facts concur in the present case. And, according to the proofs here, the only reason why the petitioner has not been paid is, that there is a question, and a very serious question, to say the least, whether there is any debt whatever due to him.

The grantees here have always been ready and willing, and have declared to the petitioner, that they are ready and willing to pay him whatever, if anything, his father owes him. If, in fact, anything is due, he could not, (had no such conveyance been made,) recover it, in the face of his father's denial thereof, until he had established the indebtedness by an appropriate proceeding therefor; and there is no existing difficulty in obtaining payment when he has so established a debt, the said grantees being ready and willing, thereupon, to pay it, and being compellable to pay it, by proofs and proceedings adapted to such a state of facts. Under such circumstances, the allegation of the petitioner savors more of bitter, not to say malignant, hostility, provoked by the confidence reposed by his father in his sisters, or some unexplained family dissension, than of any sincerity or belief, even by the petitioner, that any fraud was intended.

The Court below having expressed no opinion upon this point, it received little attention from the counsel, on the argument of the review in this Court. I have, therefore, deemed it proper to examine the other grounds upon which the propriety of the order was discussed, instead of resting the decision upon a failure to prove an act of bankruptcy.

8. Upon the question, whether, upon the proofs, it was rightly held that the petitioner was not a creditor of the respondent, it is not insisted that, if the advance of five hundred dollars, for the repairs of the dwelling house, was in fact a free gift, made chiefly for the relief and comfort of the petitioner's aged mother, and in part, (as the evidence tended to show,) to provide a room which the petitioner might himself conveniently occupy on his visits to his parents, there was

any error in holding, that such gift constituted no legal consideration for the note set forth in the petition, or the prior note for which, on the loss thereof, such note was given ; and that, it being without legal consideration, the petitioner could not be held a creditor by reason thereof.

That the advance was a gift, voluntarily made, and accepted as such ; that the repairs were consented to by the respondent, and the money received and expended upon that understanding, was distinctly found, as a fact, by the District Judge, upon the trial of the cause, with the witnesses before him, and with an opportunity to hear, observe and consider, not only what the witnesses testified, but their appearance and their manner while testifying. Such finding, it is true, is not conclusive upon this hearing. It is open to review ; but it ought not to be lightly regarded, nor should it be overruled, except upon a very decided conviction that it is erroneous. A careful study of the evidence, aided by the suggestions of the petitioner's counsel, has not produced that conviction. On the contrary, the preponderance of the testimony is, that it was a purely voluntary contribution by the son, under the then influence of filial affection towards his mother, to render her latter days more comfortable ; that it was received as such, and mutually so understood ; that there was, on the part of the respondent, neither intention nor willingness to run in debt for the purpose ; and that it was in distinct response to the son's offer to bear the expense, that the father consented to make the repairs. True, the giving of the note for the amount is very strong persuasive evidence that the respondent regarded it as a loan. Unexplained, it might override the evidence of the previous offer and acceptance. But the explanation makes the whole transaction consistent. Upon further reflection, and in view of the motive which had prompted his generosity, it occurred to the son, that, as his father was under some indorsement or indorsements for a third person, and might fail or die insolvent, it might happen that his purpose to benefit his mother by the gift might be defeated, and that he might

In re David Cornwall

better secure his whole purpose, if he could induce his father to execute a note, to be held, and, in such a contingency, be made a claim against his estate, for the benefit of his mother and sisters. Whatever might be said of such a design, if the contingency had happened, and the attempt had been made thus to withdraw a portion of that estate from creditors, it is clear that such an arrangement was entirely consistent with the original and actual intent of the petitioner to advance the money as a gift, and with its acceptance and appropriation to the repairs, upon that understanding. So that it not only remains true, that the consideration for the note was a gift, but the force of the evidence, which the giving of the note involves, is weakened, and, in fact, overcome, by the proof of the purpose for which it was solicited by the petitioner and given by his father. And this view of the subject is greatly strengthened by the fact, that when, on the representation that the first note was lost, another was given, there was no claim for interest, as upon a loan to the father. If it appeared, that, upon all other grounds, the note was a valid note, I should hesitate, at least, in allowing parol evidence of an agreement with the father, either prior or contemporaneous therewith, that he should not be held bound to pay it. But, on the question whether it ever had any legal consideration, whether the money advanced was a gift, which neither party intended or expected would be repaid, or would create any indebtedness by the respondent, the facts, that it was not treated as a debt, that the father was never called upon to pay it, and that, when a note was given in apparent renewal thereof, it was not treated as if given for a loan, and no interest was charged, go very strongly in support of the direct testimony to the point in controversy.

4. Whether, where the statutes of limitation of the State in which the parties reside have created a bar to the recovery of an alleged debt by action, the holder may, nevertheless, pursue the alleged debtor, under the bankrupt law, and, by that means, compel its payment, is a question of wider and greater importance than the immediate effect of this particular litigation.

In the present case, both parties reside in the State of Connecticut. If the advance secondly mentioned in the petition was a loan or created an indebtedness, it was for money received by the respondent in this State, in the year 1854, he then and ever since residing here. For the purposes of this question, it is assumed that such advance did create a debt, and, therefore, that the cause of action arose more than fifteen years before the filing of the petition in the District Court, and is within the statute of the State, which declares, that no action "shall be brought but within six years after the right of action shall accrue."

In the construction of this statute, and in declaring its effect, the Courts of the State hold, that the statute does not merely prohibit the maintenance of an action technically so called, but it bars the claim in whatever form it may be asserted. They declare, that it applies to the nature of the indebtedness as well as to the form of the action; that, although in terms applicable to actions only, it applies to all claims which may be the subjects of actions, however presented; that the lapse of time prescribed as a bar is regarded as furnishing a presumption of payment; that this presumption, when it is not overcome by a new promise, withdrawing it from the operation of the statute, is conclusive; and that the presumption, from the lapse of time, is, that the defendant has lost the evidence which would have availed him in his defence, if seasonably called upon for payment. Hence, after the lapse of six years, the claim can no more be used as a set-off than it can be made the subject of an action in form. Nor can it be successfully urged before commissioners appointed by a Court of Probate to receive and allow claims against the estate of a deceased, with a view to the distribution of such estate. This construction and declaration of the effect of the Connecticut statute, establishes fully that the claim of this petitioner is, in their view and by force of the statute, absolutely barred. The appropriation of the estate of a deceased to the payment of his debts by an auditing and allowance thereof, presents a close analogy to the appropri-

ation of the estate of a bankrupt; and, in effect, the Connecticut Courts declare, that no legal claim exists in favor of the petitioner, if the statutes of limitation of this State are to have their actual legal operation. See, on this subject, *Robbins v. Harvey*, (5 Conn., 335;) *Hart's Appeal from Probate*, (32 Conn., 520,) and the cases there cited.

The Federal Courts, sitting within the respective States, regard their statutes of limitation, and give them the interpretation and effect which they receive in the Courts of the State. This has been repeatedly declared in the Supreme Court of the United States, and is now the familiar practice. (*Shelby v. Guy*, 11 Wheat., 361; *M'Cluny v. Silliman*, 3 Peters, 270; *Green v. Neal's Lessee*, 6 Id., 291; *Ross v. Duval*, 13 Id., 45, and cases therein cited.) In *Ross v. Duval*, Mr. Justice McLean says: "These Acts are of daily cognizance in the Courts of the United States, and no one has ever doubted, that, in fixing the rights of parties, they must be regarded as well in the Federal as in the State Courts." More than this, instead of regarding the nature and design of statutes of limitation as a mere withholding of the remedy, while a subsisting cause of action is nevertheless supposed to continue, the Supreme Court, in recent cases, regard them as proceeding on the presumption which, as above stated, the Courts of Connecticut declare to lie at their foundation. Thus, in *United States v. Wiley*, (11 Wallace, 508, 513,) Strong, J., says: "Statutes of limitations are indeed statutes of repose. They are enacted upon the presumption, that one having a well-founded claim will not delay enforcing it beyond a reasonable time, if he has the power to sue." In *Levy v. Stewart*, (11 Wallace, 244, 249,) Clifford, J., says: "Statutes of limitations exist in all the States. * * * They are regarded as statutes of repose, arising from the lapse of time and the antiquity of transactions, and they also proceed upon the presumption that claims are extinguished whenever they are not litigated in the proper forum within the prescribed period." (See, also, the recognition of State statutes of limitation, and their binding force in the Federal

Courts, in *Stewart v. Kahn*, (11 *Wallace*, 493,) and in *Hanger v. Abbott*, (6 *Wallace*, 532.)

It may be suggested, that an Act of Congress, (*Act of September 24th*, 1789, § 34, 1 *U. S. Stat. at Large*, 92), requires the Federal Courts, sitting in the respective States, to make the laws of such States the rules of decision in trials at common law, and that the recognition of State statutes of limitation is founded on that Act. Doubtless, the Act so requires; but it does not follow, that, looking to the grounds upon which statutes of limitation proceed, as above stated, in repeated cases, the Federal Courts would not have recognized those statutes as a defence, had there been no such Act of Congress. The reason of the statutes, and the obvious justice of giving them due application, as well as consistency of adjudication, and the right of each State to prescribe the conditions and limitations of the liabilities of its citizens, all forbid that a plaintiff should be legally entitled to recover in the Federal Court against one whose defence is perfect in the State tribunals. The terms of the Act of Congress do not reach the Federal Courts when sitting as Courts of Equity; and yet it is certain, that, as Courts of Equity, they do recognize and allow lapse of time as a defence, in precise analogy to the statutes of limitation, in cases where such analogy is appropriate. Besides this, if the Act of Congress be the ground of these decisions in the Federal Courts, it may be regarded, for the purposes of this question, as an adoption, by Congress, of the statutes of limitation of the respective States within which the Federal Courts are held; and, thereupon, the same rules of interpretation and of application obtain as are above stated to govern the State Courts, and the foundation and scope of the statutes will be as also above stated. This leads to the same result. They will be held to apply to claims according to their nature, and in whatever form asserted. They will be deemed statutes of repose, proceeding upon presumption of payment, and of loss of evidence, and will bar all claims which may be the subjects of actions at law, however presented; and hence, also, their

In re David Cornwall.

recognition by the Federal Courts, when sitting as Courts of equity, as furnishing the proper analogy.

With these declarations before us, of the nature, foundation and effect of statutes of limitation, by the Courts of the State and of the United States, and in the face of the well-settled recognition thereof by the latter, in their several Circuits and Districts, at law and in equity, we are called upon to say, that, when sitting as a Court of bankruptcy, in the State of Connecticut, the District Court of the United States may and must disregard the statutes of limitation of the State, entertain a party alleging a claim long since barred, as a prosecutor, upon his demand take possession of the estate of the respondent, and actually appropriate such estate to the payment of such claim; and this is claimed notwithstanding the second section of the bankrupt law requires this Court, on review of the proceedings, to determine all cases arising under that law as in a Court of equity. If there be any warrant for thus calling upon the District Court to depart from the settled rule governing the Federal Courts on this subject, it must be sought in the express provisions of the bankrupt law, in its necessary construction, or in an evident intent of Congress to produce this result, manifested in the Act itself or in the circumstances of its enactment.

It is not claimed that there is any express declaration in the Act, forbidding the Court sitting in bankruptcy from giving the same effect to the statutes of limitation of the State in which the Court is held, which it would be bound to give in a litigation between the same parties in any other form, either at law or in equity. Nor, in my judgment, does its language, in any respect, or its necessary construction, as a system of bankruptcy, work such a result. When it employs the terms, debtor and creditor, debt, claim, demand, and other like or kindred terms, as a guide to the Court in the discharge of its duty, within the jurisdiction where it is acting, it uses those terms in their usual accepted sense, and they are to be applied by the Court, within that jurisdiction, and tested there. When the inquiry arises, in the Circuit or District Court of the United

States for the District of Connecticut, whether, between two citizens of that State, the relation of debtor and creditor exists—whether A. B. has a debt against C. D.—it is to be answered by the enquiry—Is C. D. under a legal obligation to pay money to A. B. ?—Has A. B. a claim which the law will recognize as entitling him to recover money from C. D. ? The law of the jurisdiction answers the question.

It is suggested, that, in the Federal Court, the question must be answered by enquiring, whether, in any State of the United States, such claim would be recognized as a debt entitling A. B. to a recovery from C. D., if he were brought within its jurisdiction, and, if yea, then it must be so recognized by the Federal Court for the District of Connecticut, within the jurisdiction of which he is, and in which the question of his liability is to be determined, and, therefore, if it appear that, should C. D. be found in Wisconsin, the Courts of that State would treat him as a debtor, he must be so treated here ; or, in effect, the rights and responsibilities of a resident of Connecticut are to be determined by the laws of Wisconsin, and not by the laws of this State, though the matter arises here. The principle of this argument is nothing short of this—If he would be held a debtor anywhere, he must be held a debtor in the District Court for the District of Connecticut. There is no ground for restricting the meaning of the word “debt” or “debtor” to a liability which would be enforced within the States of this Union. If, for the mere reason that, by the laws of Wisconsin, a resident citizen of Connecticut could be adjudged to pay what is claimed to be a debt, provided he were found there, he must, also, in the District Court for Connecticut, be adjudged a debtor, it must be because, if anywhere such claim would be so enforced, it must be here ; and, in short, whatever, in any place on this globe, could be recovered as a debt, if the parties should be subjected to its jurisdiction, is a debt within the meaning of the bankrupt law, and must be so treated by the Federal Courts, wherever they are exercising their jurisdiction as Courts of bankruptcy.

There is no law of the United States defining a debt or

In re David Cornwall.

describing a creditor, except as one to whom a debt is due. The bankrupt law speaks of debts due and payable either presently or at a future day. An alleged debt is not to be deemed due and payable, if the claimant cannot by law compel its payment. It is conceded, by the argument, that this is true, if, by the law of no State of the United States such payment could be compelled, if the parties were there. No reason can be assigned for this limitation, as already suggested; and, if there is any foundation for the argument, the proposition should be—If payment could be compelled anywhere on the habitable globe, were the parties there, then it must be treated as a debt in this Court and in this District. In my judgment, the District Court for Connecticut had not, nor have I, sitting in this District, anything to do with the question, what are the laws of Wisconsin, or, what are the laws of China, when considering the relation between two resident citizens of Connecticut, growing out of transactions in this State. The parties to this controversy are not and have not been in Wisconsin. The transaction did not arise in Wisconsin. Neither the parties, nor the subject matter, have ever been, and are not, under the jurisdiction of that State, or affected by its laws; and, whether, in the supposed contingency of the respondent's going to that State, and being pursued there by the petitioner, the latter could establish, and recover a sum of money from him as, a debt, seems to me wholly irrelevant to the inquiry before the District Court, and just as irrelevant as the same question would be if applied to China. The respondent is not there; he is in Connecticut; he is pursued in Connecticut; and here he is to be judged, not by the laws of Wisconsin nor the laws of China. It may be, that, in some State of the United States, no statutes of limitation exist, or, at least, for the purpose of testing this question, we may assume that to be possible. If so, then, upon the argument, the legislation of Connecticut, in all respects just, wise, and entitled to favor, exercised for the protection of the citizens of that State, and within its competent power, is to be defeated and rendered wholly inoperative, because some other State has no such enactment. It is using very

moderate terms, to say, that such a view of the subject is unreasonable, and one of which the inhabitants of the several States, within their respective limits, might justly complain.

When the inquiry is permitted—What was the intent of Congress, inferrible from the terms of the Act, or from any other considerations, or what should be deemed the true construction of the Act, when it is open to construction?—it is, as it seems to me, conclusive to observe, that the grounds taken by the counsel for the petitioner inevitably result in this, that Congress, by the bankrupt law, has abrogated wholly all the statutes of limitation of the several States; not, it is true, in very terms, but, in every case, has destroyed their effect, as a protection against stale demands. The enactment of such laws, as statutes of repose, as a protection against unfounded claims and debts presumptively paid, and to stand as a defence, when, presumptively, the evidence is lost which would have availed the defendant if the claim were seasonably prosecuted, is within the unquestionable sphere of State legislation. In regard to its own inhabitants, and to transactions within its own limits, the State may properly insist upon its power in this respect, and the uncontrolled right to exercise it for the benefit of its citizens. If so, the Congress of the United States is not to be deemed to have legislated in contravention of that power, or so as to destroy its efficiency, unless the terms or necessary construction of the Act very clearly import such an intent. Indeed, the question may pertinently be asked,—Has Congress the power to pass an Act which shall work such a result? It has power to enact uniform laws on the subject of bankruptcy throughout the United States. If power to pass such laws necessarily involved the power to abrogate all laws of a State designed for the protection of its inhabitants within its own limits, for the purposes and upon the grounds on which statutes of limitation proceed, if bankrupt laws, as understood and construed when the Constitution was adopted, had the effect, (notwithstanding statutes of limitation,) to let in stale demands, and to permit the claimants to prosecute in

bankruptcy, it might be claimed, at least, that the power was not wanting. But it was conceded, on the argument herein, that the bankrupt laws of England have no such effect, and that the Court of bankruptcy, like Courts of equity, recognizes the statute of limitations as a bar. (See 1 *Archbold's Law of Bankruptcy*, ed. of 1867, p. 533; 2 *Doria & Macrae's Law and Pr. of Bankruptcy*, 787; *Ex parte Dewdney*, 15 *Ves.*, 479, and 2 *Rose*, 59; *Ex parte Roffey*, 19 *Ves.*, 468; *Ex parte Ross*, 2 *Glyn & Jameson*, 46; *Gregory v. Hurrill*, 1 *Bing.*, 324, and 8 *Moore*, 190; *Re Glendinning*, 9 *Irish Chancery R.*, 284; *Ex parte Woodward*, 3 *Deacon*, 294; *Topping, ex parte*, 34 *Law Journal, new series*, pt. 1, *Bankruptcy*, 44; *Kidd, ex parte*, 7 *Jurist, n. s.*, pt. 1, 613.)

The practical consequences of the claim here asserted by the petitioner, also requires us to say, that Congress, in the enactment of the bankrupt law, had no intention to override State statutes of limitation. Examples are numerous, of citizens who have for many years reposed in safety under the protection of those laws, and have been able, from the earnings of careful industry, to save some provision for old age, sickness, or the education of their children, and now, by the warrant of the bankrupt law, stale claims are produced; they are made the basis of prosecution in bankruptcy; acts otherwise wholly just and proper are called fraudulent, and deemed acts of bankruptcy, by reason of such stale claims now elevated to the character of debts; parties who could not in any form maintain a claim, in any Court whatever, having jurisdiction of the parties, become prosecutors; all the legal presumptions of payment, or other defence, or loss of evidence, on which statutes of limitations proceed, are disregarded; and all that the, now indeed, unfortunate respondents have is swept away. Truly, if this be so, Congress has provided a new way to collect old debts. This was not the design or purpose of the law, and I cannot yield my assent to the argument which gives it such an operation. It is true, that the consequences adverted to are not of such force as to control an express constitutional provision of an Act of Con-

gress, but they are of great importance, when an incidental effect is sought to be given to the Act, which is not necessarily involved in its express words.

We are not left to the considerations above suggested, as our sole guide to the determination of this question. The Act itself, so far from declaring that the statutes of limitation shall not affect the prosecutor of the petition, contains a provision which seems very clearly to indicate that such statutes are to be regarded in the Court of bankruptcy, as fully as they have heretofore been recognized in the Federal Courts. It was conceded, by the counsel for the petitioner, that, had the respondent been adjudged a bankrupt, the claim of the petitioner would, nevertheless, be open to contention, and his debt must be established. This concession was clearly correct. The mere fact that he is a petitioner is not conclusive upon other creditors that he is to be allowed, in the distribution of the estate, just what he claims in his petition; nor is it conclusive upon the assignee. If this were not so, collusion between a debtor and a petitioner setting up a pretended but fictitious claim would work the grossest injustice.

In the first instance, the validity of claims, and their title to allowance in the distribution of the estate, are passed upon in the District Court, (§§ 22, 23.) If rejected, an appeal lies to the Circuit Court; and here the claimant must file a statement, setting forth his claim, substantially as in a declaration for the same cause of action at law, and the assignee must plead or answer thereto, *in like manner*, and like proceedings must thereupon be had, in the *pleadings, trial, and determination* of the cause, as in an action at law, commenced and prosecuted in the *usual manner*, in the Courts of the United States, (§ 24.) This section clearly imports, that the assignee may interpose any legal defence whatever, which could be interposed in an ordinary action in the United States Courts, and the issue must, on the trial, be determined, and judgment must be pronounced, as in such an action. It has already been seen, that, in actions at law in those Courts, the

In re David Cornwall.

State statutes of limitation are fully recognized as a defence ; and they must, by the clear language of this section, be, in like manner, available on such an appeal, and the claim of this petitioner, in such case, must be rejected. The bankrupt Act, therefore, not only does not abrogate the State statute of limitations, but here plainly warrants its interposition as a defence, and requires the Court to sustain it. That Act has, doubtless, furnished some new defences, but it has deprived the party of none which were available in an ordinary action at law for the same cause. This is, also, apparent from the provisions of the 21st section, which, although it provides for a temporary stay of pending suits, permits them to proceed to judgment. Clearly, therefore, the defence of the statute of limitations, wherever it has been interposed, must avail in all such suits.

These provisions seem to me to show, conclusively, that nothing is further from the intention and effect of the bankrupt law, than to deprive a party and his estate of the protection of such laws ; nor could language be better adapted to secure their benefit, as a defence against stale claims. And this should be so. No equity pertains to a prosecutor in a Court of bankruptcy, to be allowed to enforce a claim, which, in a Court of law, and in a Court of equity which proceeds in analogy to the statute of limitations, would be rejected. He is in no worse condition than in either of those Courts. All that can be suggested is, that, if Courts of bankruptcy recognize State statutes of limitation, and yet the discharge of a bankrupt operates against claims barred thereby, the claimants lose their chance of finding their alleged debtor in some other State, and compelling payment. So far as this applies to the present petitioner, or any other prosecuting in this District, the answer is easy. If he prosecute the respondent in any other form, the effect is precisely the same. The judgment in an action at law here would forever bar any prosecution of an action in any other State.

The precise question in this case is, whether one who

alleges that he is a creditor by a debt which is, under the State law, barred, can become a prosecutor in the Court of bankruptcy, and demand that, on his petition and proofs, the respondent be adjudged a bankrupt. A conflict of opinion is found in the decisions of some of the District Courts, on the question, whether, after a debtor has been adjudged a bankrupt, a debt, barred by the State statute, should be allowed to share in the distribution of the estate. (*In re Ray*, 2 *Benedict*, 53; *In re Sheppard*, 1 *Bank. Reg.*, 115; *In re Kingsley*, 7 *Am. Law Reg.*, n. s., 423, and 1 *Bank. Reg.*, 52, 66; *In re Harden*, 1 *Bank. Reg.*, 97.) Many of the views above suggested are ably presented in the discussion of that question. Incidentally to that discussion, the question has arisen, whether, if such claims are not allowed, the discharge of the bankrupt would avail as a defence thereto, if he should afterwards be sued in another State. If it can be successfully insisted, that a claimant can be permitted to prove his claim and share in the distribution of the estate, who could not have prosecuted the respondent, and required the Court to adjudge him a bankrupt, then the decision herein determines nothing on the question thus in conflict. It is, however, obvious, that the views here expressed are quite pertinent to that question. It is, therefore, not irrelevant to add; that the apprehended consequence, of leaving the discharged bankrupt exposed to prosecution and judgment for all claims barred by the laws of the State in which the discharge is granted, if he be found in another State, because they are held in the bankrupt Court not to constitute the claimant a creditor, nor to entitle him to share in the distribution of the estate, is not necessarily the result of such a holding. True, it is declared, (§ 34), that a discharge shall "release the bankrupt from all debts, claims," &c., "which were or might have been proved against his estate in bankruptcy;" and, in another form, (§ 32,) the order of the Court must direct a discharge "from all debts and claims which by said Act are made provable against his estate." Whether a claim is provable or not, is to be

determined by its nature, and not by enquiring whether it is possible to establish it. Provision is made, in the Act itself, for the exclusion of many debts and claims which are in their nature provable, but it is not questionable that they are, nevertheless, released by the discharge. Under § 23, one who has accepted a preference contrary to the provisions of the Act, shall not prove his debt or claim, nor receive a dividend, unless he have surrendered to the assignee the property received by him. The right of a mortgagee or pledgee to prove his debt is qualified by section 20. By section 35, one who obtains money or property as an inducement for forbearing to oppose, or for consenting to, the debtor's discharge, is excluded from any share in the estate. A creditor, having reasonable cause to believe his debtor insolvent, &c., who receives a conveyance or payment, as mentioned in the 39th section, is not allowed to prove his debt in bankruptcy. It is not at all doubtful, that the discharge, if granted, is equally effectual, as against such creditors, to release the bankrupt, as it is against any other creditor. This is sufficient to show, that a holding that an alleged debt is, in the Court of bankruptcy, as well as in a Court of law or Court of equity, barred by the statute of limitations, does not necessarily include a holding that the bankrupt cannot successfully plead his discharge as a defence thereto, should an action be afterwards brought against him in this or any other State. The rejection of the claim by the Court of bankruptcy proceeds upon the same grounds as its rejection in a Court of law when there tried, whether in an ordinary action, or on the appeal from its disallowance, (§ 24,) namely, that it has no legal existence, that it is not a debt due and payable; and, therefore, if an action were afterwards brought therefor, it would stand just as a claim would stand, which, on such an appeal and trial, was found usurious, or to have arisen out of an illegal transaction, or to have been released or paid, or to be held by one who was forbidden to prove his debt by section 39. In either case, the claim thus rejected is found not provable against the estate;

and yet, in such subsequent action therefor, the discharge would be a conclusive defence.

For these reasons, I am clearly of opinion, that a petitioner alleging a claim which is barred by the statutes of limitation, cannot maintain a petition, in involuntary bankruptcy, for an adjudication declaring his alleged debtor a bankrupt.

5. The suggestion, that the advance of money made by the petitioner in 1854 is not within the statute of limitations, because it was held as a trust, or because, the promise to repay it being conditional, six years have not elapsed since the cause of action accrued, is not sustained by a just view of the actual transaction. Taking the account of the advance as given by the petitioner himself, (and, therefore, assuming that it was not made and received as a partial return of the money advanced by the father for the education of the son,) there has never been a moment when the son could not have maintained an action of assumpsit, at law, therefor. If treated as a loan, or as payable at all, it was payable whenever the lender saw fit to require it. Depositing it in the savings' bank, to the credit of the son, was a mode suggested, which would have been satisfactory, but the son could have required payment to himself personally at any moment, and the savings' bank was merely constituted the agent to receive it. The statement of the father, in his letter, that he would deposit it as soon as in his power, called out no dissent, but there was no contract binding on the son, which required him to forbear. It was, therefore, payable on demand, and the statute began to run from the time the advance was made. The debt, if any, existed from that time. Where a debt is already barred by the statute of limitations, a promise by the debtor to pay it when he is able, has been regarded as conditional, and not to create an obligation, as a revival of the debt, until ability to pay appears; but, where there is a present debt, a promise to pay it when able does not destroy the right of the creditor to sue, nor postpone such right, and it in no wise hinders or prevents the running of the statute. I am inclined to say, also, that, if the transaction were treated as a contract to pay

Woolcocks v. Many.

when the respondent was able, and was binding, as such, upon both parties, the proofs show no change in the pecuniary condition of the father since that time. He was able, in fact, to repay it when he received it, and ever since. True, he was embarrassed by the debts he incurred in providing for his son's education, and he wished to pay them, and did not wish to sell his farm for the purpose; but he was not insolvent. He wished to retain his property, as a means of support to himself and family; but it is idle to say, that, had his son brought an action of assumpsit, at law, for money lent, the father could have successfully defended on the ground of any inability to pay, shown by the proofs in this cause, or upon any idea of trust, cognizable only in a Court of equity.

The order dismissing the petition herein was in no respect erroneous, and it must be affirmed, with costs.

THOMAS J. WOOLCOCKS*vs.*

FRANCIS MANY AND OTHERS. IN EQUITY.

The first claim of the letters patent granted, May 24th, 1870, to Thomas J. Woolcocks, for an "improvement in speaking-tube whistles," namely, "In combination with the cylindrically formed barrel A, the stem F, having the reacting spring G attached to it, and operating on the outside of the barrel, as hereinbefore described, and for the purposes set forth," is infringed by a combination consisting of the barrel, stem and spring, the spring being attached to the stem, and operating on the outside of the barrel, and the barrel being octagonal instead of cylindrical, the combination being, in all other respects, the same, and the octagonal form possessing all the advantages of, and being the equivalent of, the cylindrical form, as contradistinguished from the previous square form.

(Before BLATCHFORD, J., Southern District of New York, September 20th, 1871.)

BLATCHFORD, J. This suit is founded on letters patent granted to the plaintiff, May 24th, 1870, for an "improvement in speaking-tube whistles." The patentee, in his specification, says: "My invention relates to certain improvements in the manufacture of speaking-tube whistles, for which a patent was granted to myself and partner, May 4th, 1852, and extended for the term of seven years, from and after the 4th of May, 1866. In the invention thus patented, the barrel was made square, and the spring attached to the rod operating the whistle secured to the inside of the barrel, thus making it difficult to get at the whistle to repair, should the spring break, and at the same time requiring a large unsightly barrel, or box, (more properly), to admit of the working of the spring thus arranged within it." He states, that his invention consists, "first, in applying the spring to the rod or stem, for operating the whistle, on the outside of the cylindrical barrel, so as to be accessible at all times for repairing, without taking the whistle barrel to pieces; second, in forming a solid flange or hinge to the edge of the valve or top plate of the whistle, for supporting or holding the spring, rod or stem, when attached thereto, in contradistinction to the old method of making the valve plate of the whistle by soldering an independent flange or hinge thereto." Figures of drawings accompany the specification, and it gives a description of the construction of the parts of the apparatus which embody the improvements. The barrel or box which contains the whistle is stated to be cylindrical in form, in contradistinction to being square. The invention covered by the patent of 1852 is the introduction of an alarm valve or whistle into the speaking tube. This valve closes the mouth of the tube, when the tube is not in use, being held to its place by a spring. There is a mouth piece at each end of the tube. Immediately behind the mouth piece is a chamber containing the valve. The valve is a hollow disc, formed so as to produce a whistling noise by means of an orifice through it, whenever a strong current of air is impelled through. The valve is attached to a spindle, which has a handle worked

from the outside, so as to raise the valve against the action of the spring, when it is desired to use the tube. The person desiring to speak raises the valve, and blows through the tube; and thus sounds the whistle at the other end, and attracts the attention of the person to be spoken to, who, by raising the valve at his end, enables a conversation to be held through the tube. The patent of 1852 represents the barrel or box containing the valve as being square in form, and the spring as being coiled around the spindle inside of the barrel. In the patent of 1870, the upper one of the two concave perforated discs which form the valve-whistle, has around it a marginal flange, which, at one side, is doubled in width, so as to form a solid hinge piece, to which the stem or spindle for operating or raising the valve may be attached. The specification states, that, previously, the hinge piece had been formed separately and soldered to the edge of the flange, and that then the stem or spindle was soldered to the hinge piece. In the patent of 1870, the spring for keeping the valve shut, is a spiral spring, coiled around the stem on the outside of the barrel, and thus accessible at all times for repairs. The claims of the patent of 1870 are as follows: "1. In combination with the cylindrically formed barrel A, the stem F, having the reacting spring G attached to it, and operating on the outside of the barrel, as hereinbefore described and for the purposes set forth. 2. The disc B, having a solid flange D and hinge piece E attached thereto, as hereinbefore described, and for the purposes set forth."

The speaking tube sold by the defendants, and alleged to infringe the patent, has, in combination with a barrel containing the valve, the stem, having attached to it a reacting spring, operating on the outside of the barrel, such combination being, in all respects, the same as that covered by the first claim of the patent, except that, in the defendants' tube, the barrel or box is octagonal, instead of cylindrical. But, in the combination, the octagonal form, as contradistinguished from the previous square form, is the equivalent of the cylindrical form, as contradistinguished from the previous

square form. The evidence shows that the octagonal form possesses all the advantages which the cylindrical form has. There can be no doubt, therefore, that the defendants' tube infringes the first claim of the plaintiff's patent.

The infringement of the second claim is not established. The mode used by the defendants, of attaching the stem to the valve, appears to be a mode that was used for that purpose in making tubes under the patent of 1852, before the plaintiff made his inventions covered by the patent of 1870, and not to be the mode described by the plaintiff in that patent.

The defence that the plaintiff abandoned his inventions is not made out.

There must be a decree for the plaintiff, for a perpetual injunction, and an account of profits, as respects the first claim of the patent.

Charles F. Blake, for the plaintiff.

Jonathan Marshall, for the defendants.

ELLEN M. GAY

vs.

THE UNION MUTUAL LIFE INSURANCE COMPANY.

A policy of insurance on the life of a person contained the condition, that, if he should die by suicide, the policy should be null and void, and the insurers should not be liable for the loss. The subject insured died by an act of self-killing, by himself firing a pistol at his head: *Held*, that, if the subject insured, at the time he fired the pistol, was conscious of the act he was committing, intended to take his own life, and was capable of understanding the nature and consequences of the act, the insurers were not liable; that, if the act was thus committed, it was immaterial whether he was capable of understanding its moral aspects, or of distinguishing between right and wrong; and that, if he was not thus conscious, or had no such capacity, but acted under an insane

Gay v. Union Mutual Life Ins. Co.

delusion, overpowering his understanding and will, or was impelled by an uncontrollable impulse, which neither his understanding nor will could resist, the insurers were liable.

Held, also, that, the fact of self-killing being conceded, it was for the party claiming to recover on the policy, to establish that the subject insured was in the condition, when he committed the act, which left the insurers liable.

The value of the testimony of expert witnesses, considered.

(Before WOODRUFF and SHIFMAN, JJ., Connecticut, September 21st, 1871.)

THIS WAS an action at law, founded on a policy of insurance on the life of Sheridan Gay, for \$5,000, payable, in the event of his death, to his widow, the plaintiff. The policy was dated June 3d, 1863, and Gay, whose life was insured, shot himself, in a passenger train, on the Hartford, Providence and Fishkill railroad, December 10th, 1868. The annual premiums on the policy had been regularly paid. One of its conditions was, that, "in case he shall die by *suicide* * * * this policy shall be null and void, and said company shall not be liable for the loss." The company declining to pay the loss, the plaintiff brought this suit. The defendants pleaded the general issue, and, by way of special plea, averred, that Sheridan Gay, whose life was insured, did commit suicide, and that thereby the policy became void. Issue was joined on these pleas.

On the trial, the plaintiff admitted that Gay's life was terminated by self-killing, but denied that the act was suicide, within the meaning of that word as used in the policy, and contended, that, when he shot himself, he was insane, incapable of distinguishing between right and wrong, and unconscious of the nature and consequences of the act he was committing, and that he was driven to it by a mere blind and irresistible impulse, during a paroxysm of insanity which overwhelmed his reason and will. The defendants, on the contrary, insisted, that the facts clearly proved that Gay, though he might have been under some delusions originating in a painful and guilty secret which he carried in his breast, and which had impaired his health, and, to some extent, unsettled his mind, understood the nature and, at least, the physical consequences of his act, and intended to take his

own life; and that, therefore, his act of self-destruction was suicide, within the meaning of the policy, and rendered the policy void.

John T. Wait and Richard D. Hubbard, for the plaintiff.

Jeremiah Halsey, Henry C. Robinson and Daniel P. Tyler, for the defendants.

WOODRUFF, J., charged the jury as follows: Gentlemen of the jury: The case to which you have listened so patiently during several days is one of no inconsiderable importance. To the plaintiff it involves the question whether she shall recover the provision which was made for her in contemplation of the loss of him to whom she looked for support, maintenance, and protection; and to the defendants, as claimed by them, and as conceded by the plaintiff, it involves not merely the loss of the money that is demanded, but the construction and effect of an important contract in general use, in the meaning and effect of which rests, as the case may be, their responsibility to great numbers who have effected like insurances with them. This special importance is not, perhaps, very material. It is always important, in Courts of justice, that the Court and jury should feel that, whether amounts in controversy are great or small, their duty is single, and is to be performed under a serious sense of responsibility, and with the sole purpose to render justice according to the evidence and according to the law.

The action is brought upon a contract by which these defendants, in general terms, and in their principal assumption, agree to pay to the plaintiff five thousand dollars, on the death of Sheridan Gay, and on due notice and proof thereof, but, nevertheless, with a condition, that, if he die by suicide, the policy shall be void, and the obligation, thus assumed in such general phrase, shall be of no force or effect.

It was entirely competent for the parties to the instrument to make just that agreement. Parties to a contract may con-

Gay v. Union Mutual Life Ins. Co.

sent to any stipulation not in violation of law; and, when they voluntarily enter into an agreement, or when they voluntarily annex to an engagement conditions and limitations, they are entitled to have those conditions and limitations observed, according to their true import and meaning. It is not for the Court, and it is not for you, to pause in your deliberations, to consider whether such conditions, rightly interpreted, are wise—whether their enforcement is humane—whether, under any circumstances, such enforcement may seem harsh or unkind. It is not for you to yield to considerations suggested by the infirmities, or even misfortunes, of our poor human nature. These considerations belong to the parties who enter into the engagement, who, when agreeing together, consent that their contract shall bear its just construction, and shall, if it be enforced, be enforced according to its proper legal effect. Both are bound by it; and I may add to this, that, upon this trial, as it seems to me, both parties come into Court ready and willing to be bound by this instrument, with its conditions. They differ, however, as to its meaning in reference to the facts to which it is to be applied; and, next, they differ as to the facts themselves. The plaintiff claims that, Sheridan Gay having died, the sum insured is due to her; and that the circumstances of his death are not within the condition of the contract relieving the defendants from liability to pay the money to her. The defendants, on the other hand, claim that, although the subject of the insurance, the life of Sheridan Gay, is at an end, and he is dead, nevertheless, his death occurred in a manner which is within the meaning of the term “suicide,” as that is used in the condition annexed to the policy; and that, therefore, the money, the sum named in the policy, is not due. Each party, plaintiff and defendant, is here asking that this case may be decided according to their legal rights, neither asking, nor having any right to ask, anything out of pity for the deceased, sympathy for his widow, or regret that the defendants should be subjected to loss. Each is doubtless sincere in the views presented by the respective counsel. It is right that

the plaintiff should insist upon payment of the sum insured for her benefit, if it is rightly due to her ; and it is right that the defendants, if the money is not payable, should decline to pay it. The officers of the defendants' company would have been derelict in the performance of their duty if they had not resisted the claim of the plaintiff, if they had good reason to believe, and did believe, that the defendants are not liable.

The candor of the counsel, and the distinctness of the uncontradicted evidence, have reduced the subject of examination and decision to two inquiries, one of which is addressed to the Court, and the other to you.

The making of the contract, its terms and conditions, the payment of the premium to the defendants, the death of the person whose life was the subject of insurance, and that his death was caused by the physical act of that person, or, in the language of the concession, by self-killing, the instrument of that killing being a pistol discharged by himself, the ball penetrating his head and causing death, are all conceded. From this point the parties differ. The plaintiff insists that this self-killing was not "suicide," within the meaning of that term, as employed in the policy; but, on the contrary, that, when Sheridan Gay discharged the pistol, he was insane, by reason of disease, and, at the time, was so far unconscious of the nature and the consequences of the act which he was committing, and so beyond the government of his will, by the pressure of delusion and other blind, ungovernable impulse, as to be incapable of legal understanding, and not the subject of legal responsibility, and, therefore, in judgment of law, incapacitated to do any act which could operate to defeat this policy. The defendants, on the other hand, insist, that, when Sheridan Gay killed himself, he had consciousness enough, sufficient power to choose, understanding sufficiently capable of comprehending what he was doing, and the consequences of his act, to make the act suicide, within the condition of the policy. This exhibits the case as I first stated it. The parties differ as to the meaning of the term "suicide," as employed in the policy, and to be applied to the facts which you may find to be established by the evidence; and they differ as to

Gay v. Union Mutual Life Ins. Co.

the actual facts which, in reference to the contract, you ought to find to be established.

The first point of difference, that is to say, the meaning and legal effect of this condition of the policy, is for the Court to determine. In regard to that, the duty and responsibility is upon us, and not upon you. With it you have no concern, except to see to it that you accept the instruction of the Court, and, in good faith, make it your guide in determining the other question, which is, what facts the proofs do establish. This should be so. The question is a grave one, one upon which just and learned men have differed. If we should err in our instructions to you, the matter can be further considered, and even more deliberately than on this occasion, in this, and if need be, in a higher tribunal; while, if you should make a mistake in the matter, it might be impossible, according to our modes of judicial administration, to prevent the injustice. In the discharge of our duty, we shall not attempt to give a definition of the word "suicide," as employed in this and like policies of insurance, which will necessarily be apt to every supposable case, and cover the whole question, as it may arise in other cases. What we say will be with sole reference to what is conceded or uncontroverted, or which may, perhaps, be found by you to be established, in this particular case. We are not called upon to speak of accidental self-killing, when there is not merely no intention to kill, but every instinct and desire to continue in life is in full force; nor of a choice of the mode of death, when death itself is absolutely certain, as if, to escape the torture of death by gradual burning in a burning ship, the sufferer should cast himself, as an act of choice and will, into the water; nor of a case where erroneous opinions and unbelief of a future leads one (as perhaps it has many) to make the question of life or death one of mere choice to endure, or not longer to submit to live; nor of a case where the opinions of the subject are such that the question of life or death has no moral aspects whatsoever. Of these, or like cases, we say nothing. Not, however, to intimate any doubt in relation to them, but to say, that the

rule we give for your guidance is not given to be applied to them. It is enough, if it be a just rule in this case, whatever more restricted or more comprehensive rule might be necessary, if it be possible, by any rule, to reach and cover all cases. Nor are we called upon, nor do we intend to go, beyond the claim which the defendants make in this case. We understand them to concede, that, if Sheridan Gay, when he fired the pistol, was unconscious of the act, did not intend to take his own life, or was incapable of understanding the physical consequences of the act, then the act was not "suicide," within the meaning of the condition of the policy, and the company are liable. But they claim, that, whether he was capable of appreciating the moral consequences of the act, as an act right or wrong, is immaterial; and their claim, therefore, is, that, if the deceased intended to kill himself, and did kill himself, when capable of understanding the physical consequences of the act, irrespective of its moral bearings, as right or wrong, the defendants are not liable. They further claim, that the contract is governed by the law of Massachusetts, or, rather, the exposition of the law, applicable to contracts like this, by her judicial tribunals; and that the rule claimed by them here is in accordance with the decisions of the Courts of that State. This presents the defendants' view of the construction of the contract. The plaintiff, on the other hand, claims a different signification of the term "suicide" in this policy, and denies that this Court is bound to follow the decisions of Massachusetts Courts.

Not deeming it necessary, for the purposes of this trial, to say anything to you upon the subject, we pass the legal question raised by counsel, whether the decisions of the Courts of Massachusetts are controlling upon us, in determining the interpretation or legal effect of this policy. That, if it be a question, is for us and not for you.

We do instruct you, in view of the claims, and of the concessions, expressed or implied, in the positions taken by counsel, that, if Sheridan Gay, at the time he fired the pistol, was conscious of the act he was committing, intended to take his own life, and was capable of understanding the nature and

Gay v. Union Mutual Life Ins. Co.

consequences of the act, the defendants are not liable ; and that, if the act was thus committed, it is immaterial whether he was capable of understanding its moral aspects, or of distinguishing between right and wrong. And, to give you the alternative, if, on the other hand, he was not thus conscious, or had no such capacity, but acted under an insane delusion, overpowering his understanding and will, or was impelled by an uncontrollable impulse, which neither understanding nor will could resist, then the defendants are liable. Under this alternative view of the liability or non-liability of the defendants, you are to determine the question of fact—What was the condition of Sheridan Gay when he fired the pistol? The defendants' counsel rightly claim, that it is for the plaintiff (having conceded the fact of self-killing) to satisfy you that he was in the condition, when he committed the act, which leaves the company liable, as we have stated the rule.

The plaintiff claims, that the proof does establish that state of insanity, or overpowering influence of delusion, or uncontrollable impulse, which rendered him incapable of committing suicide, within the definition given you. In support of that claim the plaintiff, in the testimony elicited on her behalf, points to his overwork in New York ; his failure in health ; his consequent depression of spirits ; the alleged evidence of disease affecting his head—symptoms, as claimed, not then suggesting derangement, but now denoting its incipient stage ; his abandonment of his employment, and subjecting himself to the morbid tendencies of a comparatively idle life ; his exposure and over-tasking himself, on his visit to Rochester, and the consequent pain in his head, and fainting, claimed to indicate a diseased condition, in which the head and brain were involved ; his apparently increased debility and dejection on his return ; the exhibition of reserve, or less freedom in social intercourse ; his more than usual nervous excitement, restlessness, inability to sleep, and alternations of flush and pallor in his countenance ; his groundless suspicion and jealousy of his brother-in-law, Mr. Ames ; towards the last days of his life, his false hearing, freely commented upon

by counsel, and claimed to be the effect of a diseased mind and an unduly excited imagination, suggesting to him what was unreal; his excited sense of hearing, claimed to be shown by his twice hearing, when up stairs, in his room, what was said in an ordinary tone of voice down stairs in the dining room; his restless, wild appearance, starting and looking suddenly, from time to time, as if in expectation or fear of something approaching; his irrational conduct on Friday towards Mrs. Ames and her husband, and especially on Tuesday night; his suspicion of an attempt to poison him, and apprehension of an endeavor to arrest him; his persistent belief that reports were in circulation prejudicial to his character; and, on the last morning, his apparent purpose to ride to Amyville, with his wife to accompany him, causelessly and suddenly abandoned, or, if no such purpose existed, then, his crafty deception practiced on his wife, to elude her, and conceal the purpose or the impulse under which he was acting; his leaving behind him a note intimating that he left from a fear that he should shoot Mr. Ames; his vacillating conduct, in taking the train westward, towards Hartford, leaving the cars at Plainfield; his depressed appearance there; his return towards Moosup without any fixed design, or, at least, expressing a state of indecision; his continuing his journey a little further; the evidence of nervous excitement in the cars; and, finally, his sudden entrance into the ante-room of the car, and the discharge of the pistol at his head.

Although the counsel for the plaintiff insists that there is not any sufficient proof to warrant the submission of the question to you, whether he had been unfaithful to his employers at the time he lived in New York, and had unlawfully taken and appropriated their funds to his own use, the Court is of the opinion that there is evidence on that subject which is proper for your consideration; and the suggestion of counsel is pertinent, that such a fact, if proved, would not weaken the force of the other evidence of his insanity, but rather suggests a cause, or, at least, an aggravation, of his disease, and makes his insanity more probable. A guilty conscience, fear

Gay v. Union Mutual Life Ins. Co.

of detection, and, perhaps, of punishment and disgrace, exciting his nervous system, stimulating his imagination, and thus increasing or co-operating with physical infirmity—all these, and other indications suggested by counsel, are claimed by the plaintiff to be established by the proofs, and to show that Mr. Gay, when he killed himself, was not in a condition in which he did or could commit suicide, within the test which we have given for your guidance, but, on the contrary, that he was under the controlling influence of insane delusion, and overwhelmed by a sudden and violent paroxysm, and acted without consciousness or capacity to understand the consequences, and without an intent to effect the result. Whether these facts, relied upon by the plaintiff, are proved, and whether, if proved, they establish the claim of the plaintiff in this respect, is for you to consider and determine.

On the other hand, the defendants, in their presentation of the evidence for your consideration, admit that the testimony shows that Mr. Gay was under an insane delusion. They say that his health was impaired; that he was conscious of being guilty in his transactions with his employers in New York, and, concealing this secret, was in constant dread of discovery, punishment and disgrace; that his nervous system was affected, his imagination unduly excited, a groundless jealousy and suspicion of his brother-in-law were produced, and a delusion, that, by his (Mr. Ames') agency, discovery and disgrace were impending, possessed his mind to such a degree, that he was, in the language of the defendants' counsel, an insane man. But they claim and urge that this insanity, on the subjects to which it related, however produced, was not such as to deprive him of capacity to know and comprehend what he did, or of actual knowledge and intention to do as he did, with a distinct understanding of the nature and consequence of his acts; that, although his judgment was perverted, he acted intentionally, knowing what he did, and his final act of killing himself was with plan, intention and comprehension, such as made him a suicide, as that term has been defined by the Court; that, when he thought of the deficiency in his accounts,

he understood what were the natural and probable consequences of discovery; that, when, under the influence of his delusion, he thought Mr. and Mrs. Ames were talking upon that subject, and that Mr. Ames had written or was about to write to New York, he understood that discovery would be the result; that, when he meditated or spoke of shooting Mr. Ames, if he had seen him put the letter in the Post Office, he knew the effect of shooting him, either to prevent the discovery, or to revenge it, or, at all events, that shooting him would kill him; that, when he took the pistol, notwithstanding the remonstrances of his wife, he knew and comprehended how to use it, and understood its effects; that, when he heard the steps of his mother-in-law on the stairs, and alarmed his wife by the fear that he was going to shoot her, and gave the explanation, now conceded by the defendants to have been an insane delusion, that some one was coming to arrest him, he, nevertheless, knew the consequences of shooting the person approaching for such a purpose; that, when he assured his mother-in-law that he would not hurt a hair of her head, he comprehended the fear expressed by his wife, and knew what it would be to shoot her mother; that, when, in his letter to Mr. Ames, he declared that Mr. Ames would know why he got away to avoid shooting him, he comprehended both the consequences of shooting Mr. Ames and the consequences of getting away, and that he intended to accomplish the latter and avoid the former; that his taking the can for oil that morning, his purchase of the cigar, and the payment of his fare, indicated knowledge, intention, capacity and understanding; that even the deception practiced upon his wife, if it was a deception, as has been claimed, is to be explained, either by a purpose to conceal his then existing intention, and avoid inquiry, or to spare himself the pain of a conscious final parting; that, under the influence of fear of discovery and disgrace, and acted upon by the insane delusion that his misconduct had been or would be disclosed, he determined to kill himself; that his appearance at Plainfield, and in the cars, indicates comprehension of the act he was then

intending and of its consequences ; that the manner in which the act was committed shows not impulse, but determination and deliberation ; and, finally, that the evidence does not warrant the conclusion, that any sudden outbreak or paroxysm of violence, overpowering reason, memory or will, made him unconscious of the act he was committing, made him incapable of exercising will or volition, or deprived him of capacity to understand the consequences which would result from the act itself. Now, whether all the facts embraced in these claims of the defendants, and others more fully presented by the counsel, are established by the evidence, and, especially, whether the inferences which they deduce therefrom are warranted or not, it is for you to decide ; but, whatever you conclude in that respect, you must bring all the facts, and your inferences, to the test which we have given for your guidance.

Counsel had a right to request us to say, that one who is conscious of the act which he commits, and has capacity to comprehend its nature and consequences, is presumed to intend the results which naturally and ordinarily follow from it ; and counsel had a right to ask the Court to explain the nature, and to remark upon the force, of the testimony of an expert expressing an opinion upon the case presented by other witnesses.

In the departments of science and the arts, there are many facts and many deductions inferrable from facts, which are out of the sphere of the knowledge of men in general. They are not supposed to be understood by the Court or by the jury. Men of study, experience and skill in the particular art or science to which a judicial investigation may relate, are permitted to aid, by giving the light which such study, experience and skill will throw upon the subject. Their opinions are stated as deductions which are proved, in such study and experience, to flow from the facts stated. The confidence placed in such opinions, in ordinary life, illustrates the reason, and, to some extent, the ground, upon which such opinions are permitted to be received and weighed by the jury. If we are ill, we may know how we feel or suffer, and how we have,

felt or suffered, and may know all that are called symptoms, and all the visible physical indications; but we do not know the cause or nature of the illness. Our physician, being consulted, declares his opinion, and, to a greater or less extent, according to the nature of the case, and our confidence in him, and the clearness and distinctness of his opinions, we rely upon it. This illustration shows, to some extent, the ground upon which such testimony is permitted and Courts of justice receive the opinions of those whose study, experience and skill enable them to deduce inferences and express opinions of which Courts and juries are incapable. The value, however, of the opinions of experts differs largely in degree, in different cases. It is of first importance that the facts upon which they are founded be satisfactorily established. In the present case, it does not occur to us that there was any dispute as to the facts in relation to which the expert spoke. It is, next, of importance, that the integrity and skill of the witness be known. I may add here, that no question is made of the competency of the witness who has testified here, or of the confidence due to his integrity. But this is not all. Where the expert states precise facts in science, as ascertained and settled, or states the necessary and invariable conclusion which results from the facts stated, his opinion is entitled to great weight. Where he gives only the probable inference from the facts stated, his opinion is of less importance, because it states only a probability. Where the opinion is speculative, theoretical, and states only the belief of the witness, while yet some other opinion is consistent with the facts stated, it is entitled to but little weight in the minds of the jury.

Testimony of experts of this latter description, and especially where the speculative and theoretical character of the testimony is illustrated by opinions of experts on both sides of the question, is justly the subject of remark, and has often been condemned by judges as of slight value. Like observations apply, in a greater or less degree, to the opinions of witnesses who are employed for a purpose, and paid for their services, who are brought to testify as witnesses for their em-

Gay v. Union Mutual Life Ins. Co.

ployers. This last observation has no pertinency to the present case, and is only made for the purpose of explaining the reason why testimony of this sort has been the subject sometimes of such comments as have been made in your hearing. This condemnation is not always applicable. Often it would be unjust. Where an expert of integrity and skill states conclusions which are the necessary, or even the usual, results of the facts upon which his opinion is based, the evidence should not be lightly esteemed or hastily discredited. But, after all, the question of fact in issue is not for the expert to decide. The question of fact in this case is neither for the expert nor for the Court. It is for you to decide, upon your sound judgment, under the oaths which you have taken, to render a verdict according to the whole of the evidence submitted to you for consideration. I, therefore, repeat the test or rule of law by which you are to be guided in determining this case. If Sheridan Gay, at the time he fired the pistol, was conscious of the act he was committing, intended to take his own life, and was capable of understanding the nature and consequences of the act, the defendants are not liable; and, if the act was thus committed, it is immaterial whether he was capable of understanding its moral aspects, or of distinguishing between right and wrong. If, on the other hand, he was not thus conscious, or had no such capacity, but acted under an insane delusion, overpowering his understanding and will, or was impelled by an uncontrollable impulse, which neither understanding nor will could resist, then the defendants are liable, and your verdict must be for the plaintiff.

If, under these instructions, you find for the plaintiff, your verdict will be for the sum of \$5,000, with interest from the time the sum insured was payable by the policy, which, for the purposes of the verdict, is conceded to be March 17th, 1869.

The jury found a verdict for the plaintiff.

Taylor v. Garretson.

LUKE TAYLOR

vs.

OLIVER S. GARRETSON, JOHN G. GARRETSON, ALBERT GARRETSON AND JOHN D. SHEPARD. IN EQUITY.

The first claim of the reissued letters patent granted to Luke Taylor, October 19th, 1869, for an "improved mop-head," the original letters patent having been granted to him February 15th, 1869, and reissued November 10th, 1868, and again reissued November 24th, 1868, namely, "In a mop-head, in which the cross-head, or stationary jaw, is attached permanently and immovably to the handle, operating the movable jaw or binder by means of a tubular screw or socket, fitted in the handle, and having its screw-thread on its exterior, in combination with a nut encompassing the screw, and connected with the movable jaw, so as to operate substantially as shown and described," is, in substance, a claim for the described devices, arrangement and organization for operating the movable jaw of a mop-head, in which the cross-head or stationary jaw is attached permanently and immovably to the handle, by means of the screw formed on the exterior of the collar described in the specification, so fitted to, and fixed upon, the handle, as to revolve therein without longitudinal motion, in combination with a nut encompassing the screw, and connected with the movable jaw, so as to operate substantially as shown and described in the specification.

The mere substitution of a mechanical equivalent or equivalents for one or more of the elements constituting the combinations and organizations thus claimed, or any merely formal or fraudulently evasive change in the parts or arrangement embraced in the claim, will not relieve a party from liability as an infringer.

The second claim of the said reissued patent, namely, "In a mop-head, in which the movable jaw or binder is operated through the medium of a screw-nut or collar, by means of thumb-ears attached to, or formed with, the said screw-nut or collar, placing the said ears outside the yoke or bow of the movable jaw or binder aforesaid, as herein described, for the purpose set forth," is, in substance, a claim to the invention of the described location and use of the thumb-ears attached to the tubular screw or collar, with a screw on its exterior, constructed and operated substantially as described, in a mop-head in which its movable jaw is operated through the medium of such tubular screw or collar, with screw-threads on its exterior, in connection with a proper nut encompassing and acting with such screw.

Taylor v. Garretson.

A mop-head constructed in accordance with the description contained in letters patent granted to Oliver S. Garretson, August 18th, 1867, for an "improved mop-head," is not an infringement of the said reissued patent to Taylor, as it does not contain Taylor's revolving collar, with a screw-threaded exterior, or any mechanical equivalent therefor.

(Before HALL, J., Northern District of New York, September 28th, 1871.)

HALL, J. This is a suit in equity, for an injunction and account, founded upon reissued letters patent, for an "improved mop-head," dated October 19th, 1869, and which were issued to the plaintiff upon the surrender of reissued letters patent dated November 24th, 1868. The original letters patent were granted to the plaintiff February 15th, 1859, and were surrendered by the plaintiff, and reissued letters patent taken, dated November 10th, 1868. These were afterwards surrendered, and the before-mentioned reissued letters patent of November 24th, 1868, were issued in lieu thereof.

The specification and claim annexed to the reissued letters patent upon which this suit was brought, are as follows: "To all to whom it may concern, be it known, that I, Luke Taylor, of Springfield, in the county of Windsor, and State of Vermont, have invented a new and improved mop-head; and I do hereby declare that the following is a full, clear, and exact description of the same, reference being had to the annexed drawings, making a part of this specification, in which figure 1 is an external view of my invention, figure 2 is a longitudinal section of the same, taken in line X X, fig. 1, similar letters of reference indicating corresponding parts in the two figures. To enable those skilled in the art to fully understand and construct my invention, I will proceed to describe it: *A* represents the handle of the mop-head, said handle being constructed of a tough, elastic wood, and *B* represents the stationary jaw of the head, which is of T form, one portion, *a*, being a socket, which is fitted on the end of the handle *A*, and secured permanently thereto by means of rivets, *d*, one or more. On the handle *A*, below the socket, *a*, and between said socket and a shoulder, *a**, on the handle, a collar, *C*, of cast iron, is placed, and allowed to turn freely

Taylor v. Garretson.

the lower end of said collar having projections, *b*, attached, for the purpose of allowing said collar to be readily turned by the hand or thumb and fingers. On this collar there is cast a screw thread, *c*, on which a nut, *D*, works. The nut, *D*, is provided with projecting ears, *e*, *e*, at opposite sides of it, and to these ears, *e*, *e*, the ends of a jaw, *E*, are attached. The jaw, *E*, is formed of a curved wrought-iron rod, so bent that a portion, *d*, of it will be parallel with the portion, *e*, of the stationary jaw, *B*, and the remaining portions, *f*, *f*, so bent, that they will pass around the ends of the stationary jaw, *B*, fitting in recesses therein, and serving as guides, and their lower parts curved, so as to be attached to the projecting ears, *e*, *e*, of the nut, *D*, as shown clearly in fig. 1. The stationary jaw, *B*, may be of cast iron, malleable, if desired, and the collar, *C*, with its screw, *c*, may be of the same material. From the above description, it will be seen, that, by simply turning the collar, *C*, the jaw, *E*, will be moved in and out from the stationary jaw, *B*, and the cloth or mop firmly secured in the head, or between the two jaws, and also readily released or detached therefrom, when necessary. I am aware that the nut operating the movable jaws or binders of mop-heads have been manipulated by means of a nut, with ears or projections placed between the movable jaws or binders and the cross-head. I am, also, aware that mop-heads have been made with an external screw-thread of wrought iron or wood, cut on the handle or shaft, and working into a wrought-iron nut, or internal screw, cut into the cross-head or yoke of a movable jaw; but the wooden screw, by reason of its swelling and binding, when wet, and the wrought iron screw rusting and binding, and the fineness or closeness of the screw-threads, made the process of tightening and loosening the mop a slow process, and rendering the mop-head, thus constructed, inoperative and of little value. These, therefore, I do not claim, broadly, or in themselves considered; but what I do claim as new, and desire to secure by letters patent, is, (1.) In a mop-head, in which the cross-head, or stationary jaw, is attached permanently and im-

Taylor v. Garretson.

movably to the handle, operating the movable jaw or binder by means of a tubular screw or socket, fitted on the handle, and having its screw thread on its exterior, in combination with a nut encompassing the screw, and connected with the movable jaw, so as to operate substantially as shown and described. (2.) In a mop-head, in which the movable jaw or binder is operated through the medium of a screw-nut or collar, by means of thumb ears attached to, or formed with, the said screw-nut or collar, placing the said ears outside the yoke or bow of the movable jaw or binder aforesaid, as herein described, for the purpose set forth."

From this description of the plaintiff's improved mop-head, any person familiar with the forms of improved mop-heads generally used can, it is believed, obtain a sufficient knowledge of the characteristics and peculiarities of the plaintiff's invention, and of its construction and operation, to understand the questions presented in this case, although the drawings annexed to the specification would, of course, greatly aid one in readily obtaining a full and perfect comprehension of its construction and operation.

The specification and drawings annexed to the original letters patent were, in substance, like those annexed to the last re-issue, except that there was only a single claim, and that of a different character, and that, instead of the two paragraphs which immediately precede the statement of the plaintiff's claims in the foregoing specification, and which relate to prior constructions, the following paragraphs were inserted: "I am aware that a screw has been attached to the handle of a mop-head, and a nut fitted on the screw to actuate the movable jaw; but, as far as I am aware, the handle is turned with the screw in order to actuate the nut. In my invention the screw is fitted loosely to the handle, and turns separately, and the device is thereby rendered more durable, and the movable jaw may be actuated with greater facility than by the plan alluded to. I do not claim separately any of the parts described."

Immediately following these paragraphs is the claim, in these words: "But I do claim as new, and desire to secure by letters patent, as an improved article of manufacture, a mop-head, having a loose collar, *C*, provided with a screw thread, and otherwise made as described."

On the 13th of August, 1867, the defendant Oliver S. Garretson obtained letters patent for an "improved mop-head;" and, in the specification and drawings annexed, he fully described the construction of the mop-head subsequently manufactured and sold by him and by John G. Garretson, and which, it is claimed, was an infringement of the plaintiff's patent. These letters patent were somewhat relied on by the defendants; but, as the only claim made in the specification was, (as will be presently seen,) the "making of the collar of the loose jaw" (or immovable part of the clamp in which the material of the mop is held) "in two parts, so that the nut" (therein referred to as *d d*) "may be placed between them, and, when connected together, the collar surrounds the nut, and retains it in position, for the purpose above set forth," it is not deemed important upon the question of the infringement of the plaintiff's patent. Indeed, its effect as evidence is more favorable to the plaintiff than to the defendants, for it is fairly to be presumed, either that Garretson did not originally claim any device now claimed to be covered by the plaintiff's patent, or else that such claim was disallowed by the Patent Office.

The construction and character of the mop-head alleged to be an infringement of the plaintiff's patent, and the precise invention patented to Oliver S. Garretson, may, perhaps, be best shown by copying the specification and claim annexed to his patent. They are in the following words: "To all whom it may concern, be it known, that I, O. S. Garretson, of the city of Cincinnati, in the county of Hamilton, and State of Ohio, have invented a new and useful improvement in the construction of mop-heads, and I do hereby declare that the following is a full, clear and exact description thereof, reference being had to the accompanying drawings,

making a part of this specification, in which figure 1 is a perspective view of the head, with a part of the handle attached, the parts being put together complete. Figure 2 is an elevation of the same, part of the nut and part of the collar of the loose jaw being removed, to show the manner in which the flange of the nut enters the collar, and, by being rotated, acts on the screw of the shank or handle, and makes the loose jaw recede from or approach the fixed jaw or cross-head; also, the manner of connecting the parts of the loose jaw together. Figure 3 is a perspective view of that part of the loose jaw that forms the collar, broken in two, to show the recess in which the flange of the nut plays, and the recess designed to receive and retain the smaller parts of the same; or that part that may be formed of wire, as here represented, with the holes by which, with rivets, the parts are secured together. Figure 4 is the nut, shown in perspective. Like letters indicate corresponding parts of all the figures. My improvement in mop-heads chiefly consists in constructing that part of the loose jaw that forms the collar in two parts or halves; with the inner surfaces properly grooved to receive and retain the flange or wings of the nut, and to allow it to have a free rotary motion, by which means the parts with the recesses and rivet-holes may be cast complete, requiring no drilling or reaming in putting together. As represented in fig. 1, *a, a*, is the fixed jaw or cross-head, and is cast hollow, to receive the handle, *h*. In fig. 2 the loose jaw is marked *b, b, c, c*; and here one part of it, marked *c, c*, is removed, the better to show the recess in which the flange of the nut, *d, d*, plays. Part of the nut is also removed, to show how the thread of the screw on its inner surface acts on the screw on the shank or handle, *h*, and the flange is retained in the recess in the loose jaw, when, by rotating the nut by the thumb-pieces, *g, g*, fig. 4, the loose jaw, *b, b, c, c*, must recede from or approach the fixed jaw, for the purpose of receiving and retaining the mop. Fig. 4 is the nut, shown in perspective, with one thread of a screw on its inner surface, to match the screw on the shank or handle,

Taylor v. Garretson.

h, with its thumb-pieces, g, g, by which it is rotated. Part of the flange on its outer surface is also lacking, better to adapt it to be moulded and cast without coring. The important advantage gained by my construction of the mop-head is, that, by constructing that part of the loose jaw that forms the collar for the nut in two parts or halves, it, with its recesses and rivet-holes, may be cast complete, and will require no drilling or reaming in putting together, a great saving of labor in constructing, and, when done, forms a neat, compact and durable article. The operation or manner of using it is, to turn the nut by its thumb-pieces, g, g, fig. 4, and the loose jaw recedes from the fixed jaw or cross-head, and the mop may be inserted. Turning the nut in an opposite direction brings the loose jaw and the cross-head near together, and the mop is held firmly in position. What I claim as my invention, and desire to secure by letters patent, is, making the collar of the loose jaw in two parts, so that the nut, d, d, may be placed between them, and, when connected together, the collar surrounds the nut, and retains it in position for the purpose above set forth."

It is the manufacture and sale of the mop-head thus described, which, and which alone, is insisted upon as an infringement of the plaintiff's patent. Such manufacture and sale by the first-named two defendants are admitted, but it is denied that this was an infringement of the plaintiff's rights. The validity of the patent on which the suit is brought is also denied upon the ground of the want of novelty. It was also insisted that both claims of the plaintiff's patent were invalid, (1.) Because they are broader than the alleged invention shown and described in the specification; (2.) Because they each include inoperative devices; (3.) Because they are each ambiguous and uncertain.

It was conceded, at the hearing, that there was no proof that the defendants Albert Garretson and John D. Shepard, or either of them, had infringed the plaintiff's patent, and as to them the plaintiff's bill must, of course, be dismissed.

The question of novelty in the actual invention of the

plaintiff may be summarily disposed of. There can be no doubt, upon the evidence in the case, that the plaintiff was the first to introduce into a mop-head in which the cross-head or stationary jaw was rigidly and permanently attached to the handle, the described and peculiar arrangement and devices for forcing in either direction the movable jaw of such mop-head, and holding it in place when the required degree of pressure upon the material of the mop proper had been attained. Whether the plaintiff's claims are broader than his actual invention must depend upon the construction to be given to the language used by the patentee, and this construction will be presently considered.

The limited character and scope of the plaintiff's claims, the carefully expressed disclaimers contained in his specification, and the evidence given in respect to the devices and organizations which had been used for similar purposes prior to the time of the plaintiff's invention, satisfactorily prove that the plaintiff's invention was simply an improvement upon the previously existing organizations and devices for moving, and holding in position, as might be desired, the movable jaw of a mop-head, by means of a single screw. This must be constantly borne in mind, while considering the scope and character of the plaintiff's actual invention, and the construction proper to be given to the claims contained in his last amended specification, and also in determining the question of infringement. The plaintiff's invention being only an improvement of certain parts of a known machine, he cannot treat another as an infringer because he has improved the previously existing machine or machines, by using a form, construction, device or combination substantially different from that invented and patented by the plaintiff, though performing the same functions. (*McCormick v. Talcott*, 20 *Howard*, 402; *Burr v. Duryee*, 1 *Wallace*, 531, 573, 574); and it may be well, also, to bear this in mind, in considering the question of construction, as it must be borne in mind and regarded in considering the question of infringement.

Ordinarily, the claim of a patentee should be so construed

as to secure to him the exclusive right to control the use of his actual invention, if this can be done without violence to the language of his claims; but this general rule would hardly be acted upon in a case where it was evident that his claims had been expressed in loose, ambiguous or general terms, for the fraudulent purpose of apparently covering subsequent inventions, especially where the objectionable claim had been first introduced in a re-issue, for the purpose of covering the subsequent invention of another. (*Burr v. Duryee*, 1 *Wallace*, 531, 575; *Case v. Brown*, 2 *Wallace*, 320).

Under the general rule last stated, the first claim of the plaintiff's patent is, in substance, a claim for the described devices, arrangement and organization for operating the movable jaw of a mop-head, in which the cross-head or stationary jaw is attached permanently and immovably to the handle, by means of the screw formed on the exterior of the collar described in the plaintiff's specification, so fitted to, and fixed upon, the handle, as to revolve thereon without longitudinal motion, in combination with a nut encompassing the screw, and connected with the movable jaw; so as to operate substantially as shown and described in the plaintiff's specification. Of course, the mere substitution of a mechanical equivalent or equivalents for one or more of the elements constituting the combinations and organizations thus claimed, or any merely formal or fraudulently evasive change in the parts or arrangement embraced in the claim, would not relieve a party from liability as an infringer.

The addition, in this first claim, of the term, "socket," if intended as the alternative of the term, "tubular screw," and to refer to the same thing, was unnecessary, and, perhaps, improper; and it can have no effect, unless it can properly be construed to extend the claim to the socket and screw upon its exterior, found in the Garretson mop-head. If so construed, it would certainly be extended beyond the limits of the plaintiff's actual invention; and, perhaps, it ought to be considered, that the term, "socket" was so inserted, upon the re-issue, for the fraudulent purpose of suppressing Garretson's

Taylor v. Garretson.

subsequent invention. But, as this case will be here determined upon other grounds, this question will not be discussed or decided.

The second claim of the plaintiff, under the general rule before stated, is, in substance, a claim to the invention of the described location and use of the thumb-ears attached to the tubular screw or collar, with a screw on its exterior, constructed and operated substantially as described, in a mop-head in which its movable jaw is operated through the medium of such tubular screw or collar, with screw threads on its exterior, in connection with a proper nut encompassing and acting with such screw. The insertion of the term, "screw-nut," in this claim, was unnecessary and improper, and justifies, at least, a suspicion, that it was inserted for the fraudulent purpose of suppressing the subsequent invention of Garretson.

In confirmation of the view taken of the scope and character of the plaintiff's claims, and of his actual invention, and, also, as preparatory to a discussion of the character, office and operation of the devices and arrangement used in the Garretson mop-head for like purposes, with a view to the proper determination of the question of infringement, it may be well, at this point, to refer to and describe the devices and arrangements adopted for similar purposes in two previously existing organizations. The first of these is the mop-head described in letters patent granted to Alexander Barnes, November 20th, 1855; and the other the mop-head marked "defendants' Exhibit F;" it being satisfactorily proved, that mop-heads of the same character had been in use long prior to the plaintiff's invention. Both of these, in most of the parts not now in controversy, or not presently referred to and described, are quite similar, in their general organization, and in their principles, or modes of operation, to both the Taylor and Garretson mop-heads; and, taken together, they may be properly considered as representing the state of the art at the time of the plaintiff's invention.

In the first, the cross-bar, which forms what is termed, in

Taylor v. Garretson.

the plaintiff's claim, the cross-head or stationary jaw, was so arranged and fixed as to revolve upon the end of an iron rod inserted in the wooden portion of the handle of the mop, and upon which iron rod was cut the operative screw by which the movable jaw of the mop-head was moved and held in place. The movable jaw was similar to that of the Taylor mop-head, with its arms or ends connected together by a short cross-bar, having a female screw in the middle lines of its length and breadth, being, in fact, a nut with ears, like that in the plaintiff's mop-head, except that its screw threads were finer, and that the diameter of the screw required to fit and fill it (the screw being of wrought iron) was not so large. The screw threads on the exterior of the iron rod to which the stationary jaw was so fixed, corresponded and co-operated with those in the short cross-bar or nut with ears, before referred to. The movable jaw in this organization was, therefore, moved and operated by turning the handle and its screw, while the stationary jaw was so held as to prevent its revolution. The construction and arrangement just described were objectionable, because an unequal pressure upon the different arms of the mop-head might give it a revolving motion, in such manner and direction as to open or loosen its jaws, and release their firm hold upon the materials of the mop proper. The fineness of the threads of the screw, and the danger that rust upon its surface might interfere with its uniform and successful operation, may, also, have been slight objections to its general adoption.

In the construction shown by the defendants' Exhibit F, the iron rod and screw of the Barnes mop-head were rigidly and permanently attached to the stationary jaw, as well as to the wooden portion of the handle of the mop, and there was, therefore, no female screw cut in the short cross-bar through which the screw passed, as in the Barnes mop-head; but, the required action of the movable jaw, for the purpose of effectually clamping and holding, or of releasing, the material of the mop, was produced by turning a nut with thumb ears, placed upon the screw between the short cross-bar and the

stationary jaw. This construction was objectionable, because the position of the nut with thumb ears was inside the yoke or bow of the movable jaw, and, therefore, not so easily operated; and the fineness of the screw and the danger of rust, as before stated, in respect to the Barnes mop-head, may, also, have been considered slight objections to its general adoption and use.

As an improvement upon the Barnes mop-head, the plaintiff's invention was, in substance, this: He attached the stationary jaw to the handle in such manner that the handle could not revolve without a corresponding motion of the mop-head; and, in order that the proper motion and action might be given to the movable jaw, by means of a screw on the handle of the mop, working in the eared nut or female screw of the short cross-bar, he cut the proper screw threads upon the exterior of a collar placed and fixed upon the handle, instead of cutting the screw upon the main body of the handle itself. This construction enabled him to place his thumb-ears outside the bow of the stationary jaw, instead of inside of it, as had been done in the mop-head represented by the defendants' Exhibit F, and in the other organizations referred to in the plaintiff's disclaimer. The great and distinguishing feature of his invention was, therefore, the introduction and use of a screw revolving, without longitudinal movement, around the main body of the mop-handle, and operated by the use of thumb-ears outside the bow of the movable jaw.

Considered as an improvement upon mop-heads like those represented by the defendants' Exhibit F, the plaintiff's invention consisted in converting the short cross-bar of the movable jaw into an eared nut, and giving it motion in both directions, and securing it in place, by the introduction and action of the collar and its exterior screw, this collar, with its exterior screw, thus constituting, as before stated, the principal and distinguishing feature of his invention.

Neither of the separate parts of the plaintiff's new arrangement and organization was claimed, or could have been

claimed, as new; for, all of them, including the revolving collar, with the screw upon its exterior, and working in a nut, to produce longitudinal motion, while it was itself so held as to prevent its moving longitudinally, had been before used in other organizations. Such screw collars had been used for an analogous or similar purpose in larger wrenches, a specimen of which was given in evidence.

The Garretson mop-head is an extremely limited, but, doubtless, valuable, improvement upon the mop-head represented by the defendants' Exhibit F. Garretson's improvement consists, mainly, in casting the short cross-bar of the movable jaw in two longitudinal sections or pieces, of such form, that, when united, there shall be a large circular orifice in the middle lines of their united length and breadth, with a channel or recess cast or formed therein, of such form and dimensions as may be required to receive and hold, as against any but a revolving motion, a nut with an exterior flange fitted to, and revolving in, the channel or recess so provided for it in the short cross-bar, thus enabling the operator to move in either direction, and fix in its proper position the movable jaw of the mop-head, by revolving the nut upon the screw cast upon the socket or iron portion of the mop-handle. This having been accomplished, it was obvious, that the thumb ears of the nut should be placed outside the bow of the movable jaw, and this location of the thumb ears of the nut was, accordingly, adopted.

The Garretson device has, perhaps, no advantage over that of the plaintiff, except in cheapness of cost of construction, and, possibly, (judging from the statement in regard to the swelling of wooden screws, in the plaintiff's specification), in avoiding the danger of failure in the proper or easy action of the plaintiff's device, by reason of the swelling of the wooden portion of the mop-handle upon which it is intended to revolve.

The iron rod in the Barnes mop-head and in that represented by the defendants' Exhibit F, on which the screw was cut, and the socket cast upon the stationary jaw of the

Taylor v. Garretson.

Taylor and the Garretson mop-heads, are parts of the mop handles to which the stationary jaws are attached ; and the placing of the screw upon the socket of the Garretson mop-head, and the use of coarser threads in the operating screws, are only differences of degree and in mechanical construction ; and a change from one to the other is not a patentable invention.

The changes in the arrangement, form and construction of the parts concerned in the mechanical movement and retention in place of the movable jaw of the mop-head in use prior to the invention of Taylor, which were made by him and by Garretson, were both meritorious improvements upon such mop-heads, and patentable inventions ; and, in my judgment, the two devices, in construction and arrangement, are substantially and essentially different, and, also, substantially different in their modes of operation. The Garretson mop-head does not contain the revolving collar with a screw-threaded exterior ; and the introduction and use of this collar is the main and most essential feature of the plaintiff's invention. Nor does it contain any mechanical equivalent of such screw-threaded revolving collar, which could have been substituted for it without meritorious and substantial invention. Imparting motion to the movable jaw of a mop-head, by means of a revolving nut, working upon a screw cut upon the socket or handle rigidly attached to the mop-head, and also connected with the short cross-bar of the movable jaw in such manner as to allow it to revolve upon the screw without any other motion separate from that of the cross-bar, required the exercise of the inventive faculty in no small degree ; and it is quite certain that the Garretson device, in its construction and arrangement of parts, and in its principle and mode of operation, is substantially and essentially different from the actual invention of the plaintiff. The two devices are supposed to be equally efficient and useful ; but it was testified by one of the defendants' experts, and not disproved, that the Garretson device was to be

Thayer v. Wales.

preferred, because the cost of its construction was less than the cost of the device invented by the plaintiff.

In short, no infringement of the plaintiff's right has been established, and, for that reason, the plaintiff's bill is dismissed, with costs. The other questions presented by the learned counsel of the respective parties may, therefore, properly be left without further discussion.

George M. Plympton, for the plaintiff.

Sprague & Hyatt, for the defendants.

EDWIN S. THAYER AND OTHERS,

vs.

JOSEPH WALES AND JAMES M. DIETZ. IN EQUITY.

The first claim of the letters patent granted to John Stainthorp, March 6th, 1855, for an "improvement in machines for making candles," namely, "The employment of the pistons, D, D, formed at their upper ends into moulds for the tips of the candles, in combination with stationary candle-moulds, to throw out the candles in a vertical direction, substantially as herein set forth," is infringed by a machine in which the piston has a flat end, and moulds a candle with a flat end, instead of a convex tip, provided the piston is used in combination with the stationary mould, to throw out the candle in a vertical direction, as described in the specification.

The said letters patent are valid.

A preliminary injunction granted against a clear infringement, there having been repeated adjudications sustaining the patent.

An irregularity in the service on a defendant of the subpoena in a suit in equity, affords no reason for withholding an injunction against him, if he has had notice of the motion for the injunction, and appears to oppose it.

(Before BENEDICT, J., Eastern District of New York, October 9th, 1871.)

Thayer v. Wales.

BENEDICT, J. This case comes before me upon a motion, on the part of the complainants, for a preliminary injunction, to restrain the defendants from using a machine, in the making of candles, within this District, upon the ground that it is an infringement upon a patent granted to John Stainthorp, March 6th, 1855, for an "improvement in machines for making candles," and owned by the complainants. The motion is founded upon the bill and affidavits, and is opposed by affidavits on the part of the defendants.

The first issue raised is as to the infringement charged. There appears to be no dispute in regard to the description of machine which the defendants are using, but it is contended that such a machine is not covered by the claim in the Stainthorp patent.

The Stainthorp patent contains two claims, of which the first is the only one in controversy here. That claim is as follows: "What I claim as new, and desire to secure by letters patent, is, (1.) The employment of the pistons, D, D, formed at their upper ends into moulds for the tips of the candles, in combination with stationary candle-moulds, to throw out the candles in a vertical direction, substantially as herein set forth." This claim, the defendants insist, does not cover the defendants' machine, because, in the defendants' machine, the piston is flat, and moulds a candle with a flat end, instead of a convex tip, whereas, as they claim, a tip-mould is a substantial feature in the Stainthorp patent, and a necessary element of the combination secured by that patent. I am unable to sustain this construction of the Stainthorp patent. The object sought to be attained by the Stainthorp invention was the safe removal of the candle from the mould in which it is formed, and, by the same operation, a proper adjustment of the wick for a new candle. This is accomplished by constructing a stationary upright mould, which, instead of having a fixed bottom, has a movable bottom, arranged to work, by means of a piston-rod, as a piston in the mould, and having a centre aperture in the piston, through which the wick can pass, enabling the candle to be forced up by the movable bottom,

and safely delivered from the upper end of the mould, while the wick is, at the same time, drawn through the mould ready for the next candle.

The first claim set forth in the patent is for the employment of the piston in combination with the stationary mould, to throw out the candle in a vertical direction, as described. I find nothing in the specification or claim to warrant the opinion, that the shape of the piston was therein mentioned for the purpose of claiming any particular shape of piston, as part of the invention. The form of piston mentioned is not necessary to accomplish the result sought to be attained; and the mode of operation of the machine remains unchanged, whether the candle be moulded with a concave, or a convex, or a flat end. Candles are made with ends of various forms, and every form of end may be moulded by a piston shaped to such form. The form of the candle was not what the Stainthorp invention looked to. It sought to deliver in a safe and cheap way candles of every form; and, the method having been described in the patent, it required no invention to alter the form of the piston to a plane surface, nor did any change in the principle of the machine follow such alteration. No advantage is shown to have been gained by such alteration, and no reason for it has been suggested. It appears to me to have been made with the expectation of raising a distinction between the machines, which should, in effect, enable the defendants to use the Stainthorp invention without compensation, and for that purpose alone. But the alteration is merely colorable, and creates no substantial change. The defendants' machine must, therefore, be held to be, in substance, similar to the Stainthorp machine, in the features now in question, and its use an infringement of that patent.

It is further contended, that the invention claimed by the Stainthorp patent was previously known and described; and what is known as the Morgan machine is referred to as showing this. But the Stainthorp patent is not recent, and has been repeatedly adjudicated upon and sustained; and, in more than one instance, the Morgan Machine was proved and held

Russell v. Place.

not sufficient to invalidate the patent. (*Stainthorp v. Elkinton*, 1 *Fisher's Patent Cases*, 349; *Stainthorp v. Hamiston*, *Id.*, 475.) Repeated adjudications in favor of this patent entitle the complainants to the relief of a preliminary injunction against what seems to me to be a clear infringement.

Some preliminary objections to this motion were taken on behalf of the defendants, only one of which I think it necessary to mention here. An objection is taken by the defendant Dietz, to the granting of any injunction against him, upon the ground of a supposed irregularity in the service of the subpoena, as to which it appears sufficient to say, that such irregularity, if it exist, affords no reason for withholding an injunction against a defendant who has notice of the motion and appears to oppose it.

Let a preliminary injunction be issued, according to the prayer of the bill, against both of the defendants.

Miles B. Andrus, for the plaintiffs.

Abbett & Fuller, for the defendants.

NATHAN C. RUSSELL

vs.

ISAAC V. PLACE AND OTHERS.

In an action at law for the infringement of letters patent, the jury found a verdict for the plaintiff, for \$700 damages. On a motion by the defendant for a new trial, the Court was of opinion that the evidence, tending to prove actual damages sustained by the plaintiff, did not warrant a verdict for a greater amount than \$562 50:

Held, (1.) The plaintiff might be allowed to remit the excess, instead of being required to submit to a new trial.

(2.) It appearing that the infringement was deliberate and intentional, and the plaintiff asking, under the statute, for an increase of the actual damages found, the Court awarded judgment for \$1,200 and costs.

Russell v. Place.

(8.) The defendant was allowed to require the plaintiff to first remit the amount of the excess of the verdict, or submit to a new trial, the order of the Court thereupon to award the plaintiff judgment as aforesaid.

(Before WOODRUFF, J., Northern District of New York, October 10th, 1871.)

THIS was a motion by the defendants for a new trial, in an action at law, brought for the infringement of letters patent for an invention connected with the treatment of bark-tanned skins, to make them suitable for the manufacture of gloves. At the trial the plaintiff had a verdict for \$700. The plaintiff also moved to increase the amount of the verdict.

Horace E. Smith, for the plaintiff.

Matthew Hale and *James M. Dudley*, for the defendants.

WOODRUFF, J, (after holding, that, on other grounds urged, a new trial ought not to be granted). The proof of damages sustained by the plaintiff did not, I think, justify so large a verdict. Although the action is, in form, tort, the verdict should be for actual damages only. Where the circumstances of the case make it just and proper, the Court are authorized to award, in the judgment, not exceeding three times the actual damages found by the jury; and this furnishes ample opportunity to the plaintiff to obtain whatever greater sum the Court may deem reasonable. But the duty of the jury was to find the actual damages, and the burthen was upon the plaintiff to establish those damages by proof.

Yielding full weight to the presumption, that, in a community where the improved leather was in great use and demand, the plaintiff would have realized the profit of preparing the skins, or an equal number of skins to those, which the infringing defendants prepared by the use of the invention, the case, on the proof, stands thus: Taking the testimony most favorably for the plaintiff, the profit he lost was \$1 87½ on each dozen of skins. The defendants, in their estimate of the quantity they manufactured after the patent was re-issued, made not exceeding three hundred dozen. The plaintiff's

Russell v. Place.

loss, on this most favorable view of the evidence, did not exceed \$562 50.

I apprehend, however, that this does not necessarily require that a new trial should be granted. The plaintiff may, if he sees fit, remit the excess.

Besides this, where the Court has power, and is called upon, to grant treble damages, this excess may be considered, and, in the discretion of the Court, the error be fully corrected by such enhancement of damages as may seem just, to indemnify the plaintiff for the expenses of prosecution, especially where, as in this case, the infringement seems deliberate and intentional, though it may have been done under an erroneous estimate of the plaintiff's rights. The plaintiff seeks a reasonable increase of the sum found by the verdict; and I think it is a proper case for such an allowance. It is not reasonable that an inventor of a useful improvement should be compelled to spend his means in protecting himself without indemnity, and so practically lose the benefit of the invention which the law is designed to secure to him.

I am disposed to award judgment for \$1,200 and costs of suit; but, if the defendants prefer that course, and that the record may conform to my views of the evidence, the plaintiff may first be required to remit the excess before mentioned, or submit to a new trial, and the order of the Court thereupon will award him judgment as just stated.

Daniels v. Tarbox.

SAMUEL R. DANIELS AND SELDEN W. LACKOR

vs.

HENRY F. TARBOX, COLLECTOR, &C.

Under section 22 of the Internal Revenue Act of July 20th, 1868, (15 *U. S. Stat. at Large*, 184), a regular suspension of work by a distiller relieves him from assessment for taxation during the interval between the time he so regularly suspends work, and the time he actually resumes work, whether the resumption is regular, according to that section, or not.

If he resumes work without previously complying with the provisions of that section in regard to resumption, he is liable to the forfeitures and punishment provided by that section; but the regularity of the suspension does not depend upon the regularity of the resumption.

Having mash or wort on the premises during the period of suspension, does not make the distiller liable to assessment for tax during such period.

A notice in writing of an intention to suspend work, under that section, was addressed to the assessor, instead of the assistant assessor, but was written in the office of the assistant assessor, and came to his hands, and contained the information required by the statute, and was acted upon by the assistant assessor: *Held*, that it was no objection to the regularity of the notice that it was addressed to the assessor.

A non-compliance with the statute in regard to one interval of suspension, cannot affect the question of the regularity of another suspension.

Where it was impossible to lock the door of the furnace of the still, and impossible to make a fire in the furnace, and the assistant assessor attended during the interval of suspension, and saw that no work of distilling was done: *Held*, that the right of the distiller to be treated as having duly suspended work, was not affected by the omission of the assistant assessor to comply with the statute by locking the door of the furnace.

Held, also, that such right was not affected by the omission of the assessor to comply with the statute by reporting the suspension, and the action of the assistant assessor thereon, to the Commissioner of Internal Revenue.

(Before WOODRUFF, J., Northern District of New York, October 10th, 1871.)

THIS was an action against a collector of internal revenue, to recover back money paid as an internal revenue tax upon the plaintiffs, as distillers, under the name and firm of S. W. Lackor & Co.

L. F. & G. W. Bowen, for the plaintiffs.

Richard Crowley, (*District Attorney*), for the defendant.

WOODRUFF, J. Several questions were raised on this trial, which, in the view I take of the single question hereafter considered, it will be unnecessary to decide. Whether, under the provisions of Section 20 of the Act of July 20th, 1868, (15 *U. S. Stat. at Large*, 133,) imposing taxes on distilled spirits and tobacco, and for other purposes, distillers are liable to be assessed upon eighty *per cent.* of the producing capacity of their distillery, although the actual production is far less—whether, when distillers make a true return, in the form and containing all the particulars required by law, and have been assessed in due form, and have paid the tax assessed, the United States have any remedy in the nature of an appeal from the act of the assessors—whether, where the assessors are deemed by the Commissioner of Internal Revenue to have erred in the assessments, he can direct a reassessment and the collection of additional taxes, based upon the same facts and no other, or whether the assessor is responsible to the Government for his own failure to assess and collect the just amount due by the distiller upon a true assessment, and, as bearing on this question, whether the 20th section of the Act of June 30th, 1864, as amended by the 9th section of the Act of July 13th, 1866, (14 *U. S. Stat. at Large*, 108,) authorizing a reassessment in certain cases, has any application to a case in which the return of the party to the assessor contains truly every fact which it is his duty to return, or which is material to a correct assessment—it will not be material to discuss. The single question, whether the plaintiffs were liable to be assessed eighty *per cent.* on the capacity of their distillery, during eight days in the months of September and October, 1868, during which their distillery was not run at all, will, if decided in the negative, dispose of this case.

Assuming, therefore, for the purposes of this case, that the assessment, when legally made, should never be for a less quantity of spirits than eighty *per cent. per diem* of the whole capacity of the distillery, the period at which the assessment shall commence, and the time when the estimate may be suspended, and the day on which it shall cease, are vital to the

Daniels v. Tarbox.

ascertainment of the tax to which the distiller is liable. On that subject, section 22 of the Act of July 20th, 1868, above referred to, provides, "that every distiller, at the hour of twelve, meridian, on the third day after that on which his bond shall have been approved by the assessor, shall be deemed to have commenced, and thereafter to be continuously engaged in, the production of distilled spirits in his distillery, except in the intervals when he shall have suspended work, as hereinafter authorized or provided. Any distiller, desiring to suspend work in his distillery, may give notice in writing to the assistant assessor of his division, stating when he will suspend work; and, on the day mentioned in said notice, said assistant assessor shall, at the expense of the distiller, proceed to fasten securely the door of every furnace of every still or boiler in said distillery, by locks and otherwise, and shall adopt such other means as the commissioner of internal revenue shall prescribe, to prevent the lighting of any fire in such furnace, or under such stills or boilers. The locks and seals, and other materials required for such purpose, shall be furnished to the assessor of the district by the commissioner of internal revenue, to be duly accounted for by said assessor. Such notice by any distiller, and the action taken by the assistant assessor in pursuance thereof, shall be immediately reported to the assessor of the district, and by him transmitted to the Commissioner of Internal Revenue. No distiller, after having given such notice, shall, after the time stated therein, carry on the business of a distiller on said premises, until he shall have given another notice in writing to said assessor, stating the time when he will resume work; and, at the time so stated for resuming work, the assistant assessor shall attend at the distillery, to remove said locks and other fastenings; and thereupon, and not before, work may be resumed in said distillery, which fact shall be immediately reported to the assessor of the district, and by him transmitted to the commissioner of internal revenue. Any distiller, after the time fixed in said notice declaring his intention to suspend work, who shall carry on the busi-

Daniels v. Tarbox.

ness of a distillery on said premises, or shall have mash, wort, or beer in his distillery, or on any premises connected therewith, or who shall have in his possession, or under his control, any mash, wort or beer, with intent to distil the same on said premises, shall incur the forfeitures, and be subject to the same punishment as provided for persons who carry on the business of a distiller without having paid the special tax."

The proof shows, that the plaintiffs, after commencing the business of distilling, on four different occasions desired to suspend work, and gave notice of their intention to do so, and actually suspended, in precise accordance with the terms of their notice. The cause of suspension on three of these occasions was the need of repairs or alterations in their fixtures. These suspensions were September 16th, one day; September 22d and 23d, two days; October 1st, one day; and from October 7th to October 12th, (the 11th being Sunday,) four days, these being the eight days for which the tax was nevertheless exacted, to compel the repayment of which this action is brought. The notices of the intended suspension given by the plaintiffs were in form addressed to the assessor of the district. The assistant assessor of the division in which the distillery was included, occupied the same office with the assessor of the district, both he and the assessor being in the same apartment. Such assistant assessor was present when most if not all of the notices were drawn and signed. One of them he himself presented to one of the plaintiffs, and received the signature of the latter thereto, and he had actual knowledge of each of the notices when given. It was the duty of the assistant assessor to be at the distillery every day, and he was there each day of the suspension. On the days during which work was suspended in October, the assistant assessor locked the furnace, as required by the Act. On the three days of the suspension in September, he did not lock the door of the furnace, and the reason for not doing so was, (as he explicitly testifies,) that the plaintiffs were repairing it and it could not be locked. This, certainly, was so on one of those occasions, and the reason it was not locked on the other occasion was,

either that the repairing rendered it impossible, or that it was in such a condition that no fire could be made in it; and nothing was or could be distilled on either day of suspension in September or October, in the then condition of the distillery. It does not appear that any notice of either suspension, or of the action of the assistant assessor thereupon, was reported by the assessor of the district to the Commissioner of Internal Revenue. The plaintiffs gave no subsequent notice in writing to the assessor, stating the time when they would resume work. They embodied in the one notice given in each case, a statement of the number of days which they would suspend and of the day they would resume; but no report of that fact was made by the assessor to the Commissioner of Internal Revenue.

It is proper to say, preliminarily, that this case in no wise depends upon the question whether one notice is sufficient to satisfy all the requirements of the law, so as to justify the plaintiffs in resuming work after a suspension. The section cited is reasonably explicit in requiring "another notice in writing to said assessor." But, whether these notices must be on separate papers, with separate address and signature, or may be embodied in one, is immaterial to the present case, for the reason, that the regularity of the suspension does not at all depend upon the regularity of the resumption. If the law was so far complied with that the plaintiffs were duly in suspension from work, that state of things continued until they resumed. If they resumed without previous compliance with the law relating to resumption, they became liable to the consequences prescribed specifically for that act, namely, they incurred the forfeitures, and became subject to the same punishment, provided for persons distilling without paying the special tax. The law excepts from the assessment for taxation on the production of the distillery, and on its capacity for production, the intervals when the distiller shall have suspended work, as authorized or provided. Whether he ever resumes or not, and whether he resumes lawfully or unlawfully, is immaterial for the purposes of assessment for

Daniels v. Tarbox.

those intervals. There is no connection between the two subjects. A regular suspension relieves him from assessment during the interval. An irregular resumption subjects him to forfeitures and punishment. The same observations are pertinent to the fact proved in this case, that, during the periods of suspension, the plaintiffs had mash or wort on the premises in the distillery, though without any intent to distil it. If they thereby exposed themselves to forfeiture or penalties, be it so. It is no where provided that that fact made them liable to assessment upon the producing capacity of the distillery. I do not intend, by this, to say that a suspension (which may often be the necessary result of causes they cannot control) while they have mash on hand, subjects them to forfeiture or penalty. I mean to say, that the regularity of the suspension does not depend at all on their having or not having it on hand. And yet it appears, by a letter produced on the trial, signed by the deputy commissioner, that the reason why he deemed the plaintiffs were liable to assessment for the eight days of actual suspension was, that the assistant assessor, in his certificate of the suspension, on file in his office, did not certify, that, when he placed the locks on the furnace doors, there was no mash, beer or wort on hand on the premises. This, is I think, a misconstruction of the Act. If the plaintiffs were proceeded against for a forfeiture, or to enforce punishment, as provided in the concluding paragraph of the section, it would be material to consider, what having of mash, or wort, or beer in the distillery makes them liable, and, whether the intent or purpose thereof is material, may be then a very important inquiry. Here, I deem it wholly irrelevant. Again, it is proper to say, that this case does not require any decision of the question, what, as between the Government and its officers, are the consequences of a neglect by the latter to comply with the requirements of the law prescribing their duty. The question, therefore, is reduced to this—Were the plaintiffs liable to assessment for the days of actual suspension, or were those days “intervals” when

they had "suspended work," as in the Act "authorized or provided?"

The Act, in terms, authorizes any distiller desiring to suspend work, to give notice in writing, stating when he will suspend, and provides that, having given such notice, he shall not, after the time stated therein, resume work, until he shall have given another notice in writing, stating the time when he will resume. The other objections claimed, on the trial, to affect the plaintiffs' position in this respect, rest on the sufficiency of their notice of an intention to suspend, the neglect of the assistant assessor to lock the doors of the furnace on the three days of suspension in September, and the want of proof that the assessor immediately reported the suspension, and the action of the assistant assessor thereupon, to the Commissioner of Internal Revenue.

The only suggestion of defect in the notice is, that it contained an address to the assessor of the district. Surely, this objection has no merit. The notices came to the assistant assessor; they are in writing; they were written in his office. He, himself, presented one of them to one of the plaintiffs for signature. They contain, and they actually communicated to the assistant assessor, the precise information necessary to comply with the law. They were in due form to produce the effect designed, and he received them as notices, and acted thereupon; and it is a circumstance showing that no importance belongs to the mere fact that they contained an address to the assessor, that, when the law speaks of the notice of intent to resume, it terms it a notice to the assessor. The purpose and design of the requirement here was fully satisfied, and the objection is untenable.

The neglect of the assistant assessor to place locks on the door of the furnace during the three days of suspension in September, surely did not affect the regularity of the suspension of five days in October. Then the door was locked, so that this objection cannot be urged to defeat the claim of the plaintiffs here as to those five days. These intervals of sus-

pension were distinct, and irregularity in some could not affect others.

But I am, also, of opinion, that there was no fault in the plaintiffs, affecting their liability to assessment, arising from the omission to lock the door of the furnace in September. The Act should receive a sensible construction, if possible. The proof is, that the nature of the repairs rendered it impossible to lock the door, and impossible to make a fire in the furnace; and the assistant assessor attended and saw that no work of distilling was done. The law did not propose an impossibility; or, if it did, it is not the fault of the plaintiffs if the law prescribed to the assistant assessor a precaution impossible of application. It does not appear that the Commissioner has prescribed any "other means" "to prevent the lighting of any fire in such furnace, or under such stills or boilers." When, therefore, the assistant assessor found locking the door impracticable, and the lighting of any fires impossible, and further interposed his personal presence to see to it that no distilling was done, and did see that no distilling was or could be done, I think the law was fully satisfied—certainly, so far as the plaintiffs' right to be treated as having duly suspended work is affected thereby.

If, however, it can be successfully insisted that the assistant assessor ought to have actually devised some means of locking the door, and failed to do his duty in this respect, we are brought to the same question involved in the next objection, namely, that there is no proof that the suspension was reported to the Commissioner; and that question is—Must the plaintiffs pay taxes according to the capacity of their distillery, because the officers of the Government neglect their duty, and so long as such neglect continues? It seems to me that this point requires very little discussion. The duties imposed in this statute on the assessor and assistant assessor are directory merely. For the discharge of their duties they are responsible to the Government. The plaintiffs have no control over them, and ought not to be affected by their acts or omissions, which they can neither guard against nor prevent.

Suppose, for example, a distiller gives the required notice, and actually suspends in accordance with his expressed intention. What more can he do? The assistant assessor may wholly neglect or refuse to secure or lock the door of his furnace; and can it be claimed, that, for that reason, the distiller must continue to pay taxes, as in this case assessed, at over \$300 per day? Such suspension may not always be for a few days only, but may be for a period which, if the neglect of the assistant assessor involved such a consequence, would result in the distiller's utter ruin. No such claim can be reasonably urged on behalf of the Government, and such is not the meaning or effect of the law, neither in regard to the neglect of the assistant assessor, nor to the neglect of the assessor to make due and timely report to his superiors.

For these reasons, I think the tax imposed on the plaintiffs, for eighty *per cent.* of the capacity of their distillery, and the penalty exacted for its non-payment pending their appeal, amounting to \$2,524 $\frac{28}{100}$, were illegally exacted from them by the defendant, as collector of internal revenue, and that they are entitled to recover the same, with interest from December 30th, 1869, when the same appears to have been paid, with costs.

WILLIAM SISSON AND OTHERS

vs.

DAVID GILBERT AND OTHERS. IN EQUITY.

The fact that an invention was in public use and on sale, with the consent and allowance of the inventor, more than two years before his application for a patent, renders the patent invalid, however great the hindrances to the application, and whether caused by the want of pecuniary means, or other misfortune.

The public use, in this case, held not to have been experimental, the inventor having himself manufactured and sold machines containing the invention, through several years, and having allowed such machines to be used thence onward, for six more years, before applying for his patent.

A merely experimental use, made in good faith, and not in such wise as to amount to a fraud upon the public, misleading them into a use, in the belief that it is free, does not destroy the exclusive right of an inventor.

What constitutes an "allowance," by an inventor, of a public use of his invention, although there are no words of consent, his consent and allowance being inferred from acquiescence.

A defence, that the patent was invalid, because of such consent and allowance, being sustained, the bill was dismissed, but, under the circumstances, without costs.

(Before WOODRUFF, J., Northern District of New York, October 10th, 1871.)

THIS was a final hearing, on pleadings and proofs, on a bill to restrain the alleged infringement of letters patent granted September 24th, 1861, to the complainant Sisson, for an "improvement in machine for making staves from bolts," for which application was made in November, 1859, and of which patent the complainants were owners. The bill sought, also, an account and damages.

J. H. Townsend, for the complainants.

F. A. Macomber, for the defendants.

WOODRUFF, J. The claim of the patentee, in his specification, is confined to two particulars: 1st. Certain rib guides, projecting from the guide-bar, against the narrow surfaces of

which the stave bolt rests, arranged in combination with the vibratory bed, in form and position concentric therewith, through the open spaces between which ribs the chips and splinters, cut off by the knife, fall, without clogging the machine; 2d. The employment of a strip of wood with the ends of the grain upwards, inserted in a groove in the bed, along the line where the bed comes in contact with the edge of the knife, and having, at the bottom of the groove, a supporting plate, or bar of iron, or other strong material, made adjustable by means of set screws, or equivalent means, to sustain it firmly along its entire length, to raise or lower the supporting bar, by which, when the surface end of the strip of wood is cut away, it may be raised in the groove, pared off, and so present an unimpaired surface to the knife. Nothing else described in the specification of the patentee is secured to him by the patent.

As to both of these devices, I am constrained to say, that, in my judgment, the proof shows, that both were in public use and on sale, with the consent and allowance of the patentee, more than two years before his application for a patent. If this be so, then, however great the hindrances to such application, and whether caused by the want of pecuniary means, or other misfortune, the right to the future exclusive use was lost. This may be a great hardship, and so may properly induce a Court to require very clear proof, and dispose them to give full weight to the *prima facie* evidence which the granting of the patent itself imports, in support of the patentee's title; but, if such use and sale be, nevertheless, established, there is no alternative—the Court has no discretion. The right claimed depends upon express statute, and exists only by its force and according to its terms; and, by that statute, such sale and use are a full defence to the inventor's claim. (*Act of July 4th, 1836, §§ 6, 15, 5 U. S. Stat. at Large, 119, 123; Act of March 3d, 1839, § 7, Id., 354.*)

My conclusion rests mainly upon the testimony of Sisson, the patentee, himself, and of the witnesses called by the complainants, from which, I think, it appears, that, in 1845, Sis-

son was employed by Crossett, the patentee of a stave machine, to do work for him, in the manufacture of his machines, at Fulton, N. Y., and that Sisson then suggested to Crossett's partner the improvement first claimed in the above named specification, and then placed rib-guides or projections upon the wooden guide by them theretofore used, and, soon after, and in the same year, replaced the wooden guide or gauge with an iron one, and "manufactured the stave machine after that with those improvements;" and that, after Crossett left Fulton, in August, 1845, the present patentee continued to manufacture and sell to parties who held town rights under Crossett's patent. He varied the extent of the projection, and varied the number of such projecting rib guides, from three to four, and finally to five, which last number, he says, he settled upon, although his model, deposited in the Patent Office, by which, if the number constitutes a material part of his invention, he is bound, contains but four. He thinks he made these ribs substantially as they are now prior to May 1st, 1853, and the last machine he made he made in April, 1853, and he made them for the parties who owned territorial rights to Crossett's patent.

There seems to me little room to say, upon this evidence—without recurring to the testimony of other witnesses, or to the testimony of the making and sale by others of machines having such ribs, of which he had knowledge—that this improvement was not on sale or in use with the consent and allowance of the inventor.

In like manner, he made an improvement, in 1845, in Crossett's machine, by a groove in the bed, and the insertion of wood having the grain endwise, to receive the blow of the knife when it struck through the bolt; and this he, thereafter, used and sold in the machines made by him, down to and including the last machine made, as he says, in April, 1853. He does not give the precise date when the bar in the grooves, with set screws to raise the strips of wood, when partially cut away by the knife, was introduced; but the complainants' witness, who worked for the patentee as millwright and pat-

tern maker, testifies, distinctly, that it was 'put in many machines before 1851.

True, the patentee says, in his testimony, that the last machine which he made was the only one that had the complete improvement; but, on examination of his own evidence, it appears that no changes were made, except the variation in the number and extent of projections of the guide bars, and in the thickness or weight of the bar placed in the groove. These were not of the substance of the invention. The patentee would hardly claim that any third party may use six guide bars instead of four, or a bar in the groove half an inch thick instead of a quarter, and not infringe his patent. All this was done before the 1st of May, 1853, and the machines had gone into the use for which this patentee made them.

It seems to me that this is, as matter of law, within the statute, and a defence. The patentee calls this seven years, making and selling machines with the improvements, experimental, for the purpose of ascertaining and developing their utility; and he estimates the number of machines that he made between 1845 and 1853, as not more than twelve. It is settled, that a merely experimental use, made in good faith, and not in such wise as to amount to a fraud upon the public, misleading them into a use, in the belief that it is free, does not destroy the exclusive right of an inventor; but, in the face of the evidence of continued manufacture and sale through several years, and the allowance of such use thence onward, for six more years, before the patent was applied for, I think that statement will not avail the complainants.

It is, also, difficult to say, that the information which the inventor had of the manufacture and sale of machines with his improvements by Dutton & Co., within three hundred yards of his shop, of their surreptitious procurement of his patterns to be copied for the purpose, and his information of the manufacture and sale of his improvements at Rochester, not followed up or even investigated by him, the former, especially, continuing for eight or ten years before the application for the patent was made, were not such a permitting

Verselius v. Verselius.

of the public use and sale of the improvements, as constitutes an allowance thereof, within the meaning of the law, although there were no words of consent. Consent and allowance may be inferred from acquiescence.

It is not without regret that I am compelled to conclude, that, either through ignorance of the law, or want of means or aid in procuring the patent for a meritorious invention, the patentee placed himself in a situation in which this action cannot be sustained.

The bill must, therefore, be dismissed, but, under the circumstances, without costs.

GEORGE W. VERSELIUS, ASSIGNEE IN BANKRUPTCY OF WILLIAM S. VERSELIUS

vs.

WILLIAM S. VERSELIUS AND GEORGE A. VERSELIUS.
IN EQUITY.

A bill in equity was filed by an assignee in bankruptcy against the bankrupt and another, to set aside a conveyance of property made by the bankrupt to the other defendant, and to compel an account of the same, and payment to the plaintiff, and for a discovery. The bankrupt demurred to the bill for want of equity :

Held, (1.) The jurisdiction to entertain such a bill is clear. Independent of the question, whether the assignee may not always, if he sees fit, seek the aid of a Court of Chancery, to set aside a fraudulent conveyance or illegal transfer, instead of proceeding by various actions at law, the right to call for an account is not questionable.

(2.) Although the charge, in the bill, of fraud and illegality, is in the alternative, either ground is sufficient.

(3.) The assignee has the right, as ancillary to the principal relief, to have a discovery from the defendants ; and the need of such discovery also excuses the want, in the bill, of a more precise specification of the particular fraud alleged.

(4.) The bankrupt is a proper party to the bill.

(Before WOODBURY, J., Northern District of New York, October 10th, 1871.)

Verselius v. Verselius.

THIS was a bill in equity, to set aside a conveyance of real estate and personal property, book accounts, choses in action, &c., and to compel an account of the same, and the proceeds thereof, and payment to the complainant, and for a discovery, &c. There was a demurrer to the bill, by the bankrupt, William S. Verselius, for want of equity.

C. W. Smith, for the plaintiff.

Q. Van Voorhis, for the defendants.

WOODRUFF, J. This demurrer is submitted to me for decision upon the brief of the counsel for the defendant only. I have considered the objections, and am of opinion :

(1.) The jurisdiction to entertain such a bill is clear. Independent of the question, whether the assignee may not always, if he sees fit, seek the aid of a Court of Chancery, to set aside a fraudulent conveyance or illegal transfer, instead of proceeding by various actions at law, the right to call for an account is not questionable.

(2.) Although the charge of fraud and illegality is in the alternative, either ground is sufficient. The transaction is alleged to have taken place in November, 1869. That is less than four months before the adjudication which declared the demurrant a bankrupt, namely, February 1st, 1870.

(3.) The assignee has the right, as ancillary to the principal relief, to have a discovery from the defendants, and he properly seeks it, to supply the deficiency in his own knowledge; and his ignorance of the particulars sought not only entitles him to the discovery, but excuses the want of more precise specification of the particular fraud alleged.

(4.) The bankrupt has a direct interest in the question whether the property shall be taken from the other defendant, and is, therefore, a proper party.

The demurrer is overruled, with costs, and the demurrant has leave to answer, on payment of the costs of the demurrer, and of the proceedings thereon.

In re The Troy Woolen Company, Bankrupts.

In re THE TROY WOOLEN COMPANY, BANKRUPTS.

A claim proved in the District Court against the estate of a bankrupt was contested by the assignee and a creditor, and was allowed by that Court. The objecting creditor then petitioned this Court, under the 2d section of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 518,) to review the decision of the District Court allowing the claim, and to disallow the claim: *Held*, that the petition must be dismissed; that the 2d section of the Act confers jurisdiction on this Court to review, in the manner prescribed by such section, the decisions of the District Court, only in cases where special provision is not otherwise made by the Act for the review of such decisions; that the 8th section of the Act makes provision for a review of the decision of the District Court allowing the claim of a creditor, by authorizing an appeal to this Court, by the assignee, from such decision; and that, although the 22d section gives to a creditor the right to institute an investigation into the validity of the claim of another creditor, yet, when an investigation has been had, and a decision as to the validity of the claim has been made by the District Court, the right of the objecting creditor to contest the claim ceases, and any further proceeding to review the decision must be taken by the assignee, by appeal, under the 8th section.

(Before Woodruff, J., Northern District of New York, October 11th, 1871.)

In this case, the firm of Cooper, Vail & Co. proved against the estate of the bankrupts, in the District Court, a claim amounting to \$67,252 22, for a balance due on account of advances made by them to the bankrupts, on consignment of manufactured goods. This claim was contested by the assignee and by an objecting creditor. On a reference to ascertain its validity, the referee reported in favor of it. The assignee and the objecting creditor filed joint exceptions to the report, and the District Court overruled the exceptions, and confirmed the report. The objecting creditor then petitioned this Court, under the 2d section of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 518,) to review the decision of the District Court allowing the claim, and to disallow the claim. Cooper, Vail & Co. now moved to dismiss such petition.

William E. Curtis and James S. Stearns, for the motion.

Amasa J. Parker and Edward F. Bullard, opposed.

The Court, (WOODRUFF, J.,) held, that the petition must be dismissed; that the 2d section of the Act confers jurisdiction on the Circuit Court to review, in the manner prescribed in such section, the decisions of the District Court, only in cases where special provision is not otherwise made by the Act for the review of such decisions; that the 8th section of the Act makes provision for a review of the decision of the District Court allowing the claim of a creditor, by allowing an appeal to the Circuit Court, by the assignee, from such decision; and that, although the 22d section gives to a creditor the right to institute an investigation into the validity of the claim of another creditor, yet, when an investigation has been had, and a decision as to the validity of the claim has been made by the District Court, the right of the objecting creditor to contest the claim ceases, and any further proceeding to review the decision must be taken by the assignee, by appeal, under the 8th section.

Warren v. Tenth National Bank.

RICHARD WARREN AND EDWARD ROWE, ASSIGNEES IN BANKRUPTCY, &C.

vs.

THE TENTH NATIONAL BANK AND OTHERS. IN EQUITY.

Even if this Court can, in a suit in equity, brought in the District Court by an assignee in bankruptcy, to set aside an alleged preference averred to have been obtained in violation of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 517,) review, before a final decree is made in the cause by the District Court, an interlocutory order made by that Court therein, such review can be had only by means of an appeal, under the 8th section of the Act, and cannot be had by means of a petition of review under the 2d section of the Act.

(Before WOODRUFF, J., Southern District of New York, October 19th, 1871.)

THIS was a suit in equity, brought in the District Court, to set aside an alleged preference, which it was averred had been obtained by the defendants the Tenth National Bank, in violation of the bankruptcy Act, by means of a judgment and an execution against the bankrupts. The defendants moved, in the District Court, for an order directing a trial by a jury of issues to be framed in the suit. That Court denied the motion. The defendants then petitioned this Court, before a final hearing of the cause in the District Court, for a review by this Court, and a reversal, of the order of the District Court denying the motion for a trial of issues by a jury, claiming the exercise of such power of review under the 2d section of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 518.)

Alexander Blumenstiel, for the plaintiffs.

H. E. Tremain, for the defendants.

Peek v. Frame.

The Court, (WOODRUFF, J.,) dismissed the petition, on the ground that, even if this Court could review, before a final decree had been made in the cause by the District Court, an interlocutory order made by that Court therein, the review could be had only by means of an appeal, under the 8th section of the bankruptcy Act, and could not be had by means of a petition of review under the 2d section of said Act.

EBEN PECK AND GILBERT J. BOGERT

vs.

JOHN FRAME AND OTHERS.

In this case, which was an action at law, for the infringement of letters patent, the plaintiff having had, at the trial, a verdict for \$5,000, the Court, regarding the conduct of the defendant as peculiarly aggravated, increased the damages to \$7,500, as being a sum sufficient to cover the expenses of the trial, and something more, for the time and trouble of the plaintiff.

(Before WOODRUFF, J., Southern District of New York, October 26th, 1871.)

THIS was an action at law for the infringement of letters patent, granted to John Myers and Robert G. Eunson, May 23d, 1854, and extended May 23d, 1868, for an "improved machine for sawing thin boards, &c." The plaintiffs were the owners of the patent for that part of the city of New York lying west of Broadway and the Eighth avenue. At the trial, (before WOODRUFF, J.,) the plaintiffs had a verdict for \$5,000. They now made a motion for judgment in their favor, for such sum as should be proper, above the amount found by the verdict, not exceeding three times the amount thereof.

Peek v. Frame.

The motion was founded upon an affidavit, made by one of the plaintiffs, setting forth the following facts: The plaintiffs bought their interest in the patent in 1864, and paid therefor a considerable sum of money for the original term, and afterwards for the extended term. The machine described in the patent is one of very great speed and efficiency, and two or three of the machines are capable of doing the whole resawing business of the west half of the city of New York. At the time the plaintiffs purchased such interest, the defendants Nichols and Robbins owned a right to use one of the machines in said district, and the plaintiffs, in order to render their interest in the patent profitable, purchased from those defendants, in January, 1865, all their interest under the patent, paying a considerable sum of money therefor. In December, 1866, those defendants made an arrangement with the defendant Frame, to put into operation, in their place of business, which was directly opposite the place of business of the plaintiffs, a machine substantially like the patented machine. Frame set up the machine, and the other defendants furnished him with power to run it, and the profits of running it were divided between them. The defendants also cut down the price of resawing from \$4 00 per thousand feet, to \$2 50 per thousand feet, and diverted many customers from the plaintiffs' establishment to their own. The plaintiffs were obliged to reduce the price of their resawing to \$3 00 per thousand feet. The defendants were, at the very commencement, notified by the plaintiffs not to use the infringing machine, and threatened with a suit. After fruitless negotiations for an arrangement, this suit was brought. It was defended by a combination of infringers, formed by the defendants, who made up a common purse to resist the rights of the plaintiffs, and of other owners of rights under the patent. The trial of the suit was delayed by the defendants. At the trial, the plaintiffs proved, that the defendants had diverted from them, up to December, 1868, a large specified quantity of lumber, on which the plaintiffs lost a profit of \$2 00 per thousand feet; that, by reason of the reduction, by the plaintiffs, of the

Clark v. Iselin.

price of resawing, caused by the infringement, the plaintiffs had lost the sum of \$1 00 upon every thousand feet of a specified quantity of lumber, which they had themselves sawed; and that such damages in all amounted to over \$8,000. Large amounts of business had been diverted by the defendants from the plaintiffs, of which the plaintiffs could not prove the particulars, because they were known only to the defendants. The plaintiffs incurred an expense, in conducting this suit, of upwards of \$1,500. Since the trial in this suit, the patent had been sustained, on final hearing, in a suit in equity, in this Court, against these defendants, (8 *Blatchf. C. C. R.*, 446,) at a further expense to the plaintiffs of \$800.

Frederic H. Betts, for the plaintiffs.

Keller & Blake, for the defendants.

WOODRUFF, J. I regarded the conduct of the defendants, as disclosed on the trial, as peculiarly aggravated, and find no reason for changing my opinion. The damages ought to be increased by a sum sufficient to cover the expenses of the trial, and something more, for the time and trouble of the plaintiffs. Let the damages be increased to \$7,500.

JAMES R. CLARK, JR., ASSIGNEE IN BANKRUPTCY, &C.,

vs.

ADRIAN ISELIN AND ISAAC ISELIN. IN EQUITY.

Where a suit in equity is brought in the District Court, under the jurisdiction conferred on that Court by the 2d section of the Bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 518,) by an assignee in bankruptcy, against a person claiming an adverse interest, touching property vested in the assignee, no appeal can, before a final decree in the suit, be taken to this Court,

Clark v. Iselin.

by the defendants therein, from an interlocutory decree made by the District Court.

(Before WOODRUFF, J., Southern District of New York, October 26th, 1871.)

WOODRUFF, J. It is conceded that this is a suit in equity in due form, commenced by bill, and proceeding, by answer, replication and formal proofs, to a hearing and decree, upon pleadings and proofs, in the District Court. The suit is brought to set aside certain transfers of securities and a payment of money, alleged to have been made by a bankrupt to the defendants, in fraud of the bankrupt law, and to compel the defendants to account therefor, and for an account of certain securities previously held by the defendants, as security for certain indebtedness by the bankrupt to them, and of the moneys collected thereon. The decree in the District Court adjudged the invalidity of the first named transfers, and directed an accounting by the defendants, referring the case to a master to take the account, with special directions in relation thereto, and ordered a recovery upon the coming in and confirmation of the report of the master. It is conceded, that this decree is interlocutory, and not a final decree. From such decree the defendants appealed to this Court; and the complainant now moves to dismiss the appeal, on the ground that no appeal can regularly be brought until final decree is entered in the District Court.

The jurisdiction in virtue whereof this suit was brought in the District Court was conferred by the second section of the bankrupt law of March 2d, 1867, (14 *U. S. Stat. at Large*, 518), wherein it is declared, that the Circuit Courts "shall have concurrent jurisdiction with the District Courts of the same district, of all suits at law or in equity which may or shall be brought by the assignee in bankruptcy against any person claiming an adverse interest * * * touching any property or rights of property of said bankrupt transferable to or vested in such assignee." Without this provision no such suit could have been brought in that Court, and it is, therefore, true, that no provision of any prior statute regula-

Clark v. Isetlin.

ting appeals had specific or express application to such a suit in the District Court. Section eight of the bankrupt law, however, provides, that "appeals may be taken from the District to the Circuit Courts in all cases in equity, * * * under the jurisdiction created by this Act, when the debt or damages claimed amount to more than five hundred dollars;" and the section, after providing, also, for an appeal from a "decision" of the District Court, allowing or rejecting a claim made by a supposed creditor, requires notice of the appeal to be given "within ten days after the entry of the decree or decision appealed from."

It is claimed, that there is no statute restriction which prohibits an appeal to the Circuit Court from an interlocutory decree made in the District Court, and that, therefore, the practice of the High Court of Chancery in England, in this respect, like the practice in the late Court of Chancery in New York, permitting appeals from such decrees, ought to govern this question. (*Act of September 29th, 1789, § 2, 1 U. S. Stat. at Large, 93; Act of May 8th, 1792, § 2, Id., 276; Hinde v. Vattier, 5 Pet., 398; Rule 90 of the Rules of the Circuit Courts, in Equity.*) It is also claimed, that the language of the eighth section, requiring that the appeal shall be taken within ten days after the entry of the "decree or decision," imports that such appeal may be taken without awaiting a final decree. There is no force in this last suggestion. The section provides for an appeal in two classes of cases, namely, in "cases in equity," and on a "decision" allowing or rejecting a claim. It was, therefore, appropriate to use the expression, "decree or decision appealed from." That language refers to, and is apt to describe, each class, and only indicates, that, in cases in equity, a decree may be the subject of appeal, and that, where a claim is allowed or rejected, the appeal is to be taken within ten days after the "decision," referring to the immediately preceding language, giving an appeal "from the decision" of the District Court allowing or rejecting such claim.

I am of opinion, that the appeal, in cases in equity, must

be from the final decree, and from that only. The language last referred to plainly indicates that it is to be from a decree, and not from any and every order in the progress of the cause; and yet appeals might, in England and in the State of New York, have been taken from orders in the progress of the cause, antecedent to even an interlocutory decree. The policy indicated in the legislation of Congress, on the subject of appeals, as well as writs of error, in all other statutes, whether taken from the District Court to the Circuit Court, or from the Circuit Court to the Supreme Court, is uniform, in confining the review, in the appellate tribunal, to final judgments and decrees. The Judiciary Act of September 24th, 1789, gave an appeal to the Circuit Court in causes of admiralty and maritime jurisdiction, from final decrees only. (1 *U. S. Stat. at Large*, 83, § 21.) The review in the Circuit Court, provided for by the 22d section of that Act, was only of final decrees and judgments. So, also, under the same Act, and under the Act of March 3d, 1803, (2 *U. S. Stat. at Large*, 244), the appeal from the Circuit Court to the Supreme Court is given from final decrees only. Under the statutes giving such appeals, provision is made for the giving of a bond by the appellant, which has been uniformly held to require, if a supersedeas of execution was sought, that such bond be sufficient to secure the whole judgment or decree; and the provisions in respect to the operation of such an appeal, or writ of error, as a supersedeas of execution, if such bond be given, indicate that none other than judgments or decrees ripe for execution are contemplated. In this respect, section 8 of the bankrupt law, now under consideration, implies the same, in the provision, that "no appeal shall be allowed unless the appellant, at the time of claiming the same, shall give bond in manner now required by law in cases of such appeals." The whole policy of the statutes has been to allow but one appeal, and that from the final decree; and no reason exists for allowing appeals from other orders or decrees, in a suit in equity brought by or against an assignee in bankruptcy, which would not have equal force in any other cause. It is true, that, if the interlocutory decree should be reversed,

Clark v. Iselin.

the labor and expense of the proceedings before the master may be lost; but that is equally true of causes in admiralty, and equally true of all appeals from the Circuit Court to the Supreme Court; and it is, moreover, true, that the proceedings before the master may not be wholly lost, even if, in some respect, the interlocutory decree be deemed erroneous. It may be modified. It may be even adapted to the facts which shall be reported by the master. Even the District Court has power, on the coming in of the master's report, to conform the final decree to all the proofs in the cause. It is, at least, doubtful, whether to permit appeals from any other than final decrees does not, as the general rule, tend to prolong litigation and increase expense, without corresponding benefit; and it may well be, that Congress did not, in this particular, regard the possible delays and protracted duration of Chancery suits in England as desirable.

If, notwithstanding these suggestions, the question under the Act was deemed doubtful, the authority given to the Supreme Court, by section ten of the bankrupt law, to frame general orders "for regulating the practice and procedure upon appeals," followed by general order No. 26, in which the Supreme Court declare, that, "appeals in equity from the District to the Circuit Court, and from the Circuit to the Supreme Court of the United States, shall be regulated by the rules governing appeals in equity in the Courts of the United States," ought to be regarded as conclusive, at least as an opinion of the Supreme Court, that appeals under section eight are to be made from final decrees only, if not a binding regulation upon the subject.

The appeal must be dismissed; but, as the question was deemed doubtful, and the appeal was taken out of abundant caution, and lest it should be urged, on appeal from the final decree, that the decision embodied in the interlocutory decree could not be reviewed, no costs should be allowed on this motion.

Charles H. Smith, for the plaintiff.

Henry W. Clark, for the defendants.

Folsom v. Mercantile Mutual Insurance Company.

BENJAMIN F. FOLSOM

vs.

THE MERCANTILE MUTUAL INSURANCE COMPANY.

In an action at law on a time policy of marine insurance on a vessel, tried before the Court, without a jury, after the plaintiff had rested his case at the trial, the defendants offered in evidence a paper purporting to be an application presented to the defendants, requesting them to effect the insurance covered by the policy. The Court excluded the paper, on the ground that the application was merged in the policy, and that there was no plea in the case that the policy was obtained by any fraud or by any misrepresentation, and that the offer of the paper was not preceded, or accompanied, or followed, by any offer to put in evidence, or by any putting in evidence of, any such misrepresentation: *Held*, that the exclusion was proper.

Held, also, that the absence from the application of any statement as to where the vessel was when the application was made, or as to the port from which she had sailed, or as to the voyage on which she was bound, or as to who was her master, had no tendency to show that the plaintiff did not, when he made the application, communicate to the defendants the facts referred to, or answer truly all questions put to him in regard thereto.

Where this Court, after the waiver of a trial by jury, tries a case without a jury, it is not required to make a special finding upon the facts.

(Before BLATCHFORD, J., Southern District of New York, November 9th, 1871.)

BLATCHFORD, J. This is an action on a time policy of marine insurance, on a vessel, tried before the Court, without a jury. After the plaintiff had rested his case, at the trial, the defendants offered in evidence a paper purporting to be an application presented to the defendants, requesting them to effect the insurance covered by the policy. The plaintiff objected to the introduction in evidence of the paper, on the ground that the application was merged in the policy, and that there was no plea in the case that the policy was obtained by any fraud, or by any misrepresentation. The Court rejected

Folsom v. Mercantile Mutual Insurance Company.

the paper, on the ground that the evidence was inadmissible at that stage of the case. The defendants excepted to the ruling. At the close of the testimony on the part of the defendants, they renewed their offer to put the application in evidence. The objection on the part of the plaintiff to its introduction was renewed, and the Court rejected it as inadmissible, and the defendants excepted. They now move for a new trial, on the ground of an alleged error committed by the Court, in excluding the application as evidence.

It is urged, for the defendants, that the application was the written contract, by which the defendants agreed to issue, for a certain premium, and the plaintiff agreed to take, a policy of insurance, on the terms and conditions agreed upon therein. Such contract, however, must be evidenced by the policy itself. The policy must control, in this action, in case of any difference between its provisions and those of the application. In point of fact, however, a comparison of the application with the policy shows that the provisions of the two do not differ. As to any terms or conditions contained in the application, which might be in the nature of warranties or representations, it is not contended, on the part of the defendants, that there was any misrepresentation, on the part of the plaintiff, by setting out untruly any fact contained in the application. The offer of the application in evidence was not preceded, or accompanied, or followed, by any offer to put in evidence, or by any putting in evidence of, any such misrepresentation.

It is further urged, that the application was admissible, because it did not show, on its face, where the vessel was when the application was made, or from what port she had sailed, or on what voyage she was bound, or who was her master. But the policy itself contains none of these things. The absence of them from the application has no tendency to show that the plaintiff did not, when he made the application, communicate to the defendants the facts referred to, or answer truly a ll questions put to him in regard thereto. As I held, in my opinion deciding the cause, (8 *Blatchf. C. C. R.*, 170,) it was for the

Folsom v. Mercantile Mutual Insurance Company.

defendants to show, affirmatively, that the facts referred to were concealed by the plaintiff, and were material to the risk; and they gave no such proof. Moreover, the application, which was in form one for a time policy, contains no blanks for any information as to the voyage of the vessel, or her whereabouts at the time of the application. It contains, as does the policy, a blank, not filled, for the name of her master, but it appeared, on the trial, that the defendants knew the name of her master at the time the application was made. Moreover, the policy, being a time policy, contains, as does the application, a warranty as to the ports and places the vessel should not visit or use. It was not claimed that she was lost while in a forbidden place, or on a forbidden voyage; and, therefore, any statement of her voyage or whereabouts was immaterial.

I am satisfied, for these reasons, that the application was properly excluded, as being entirely irrelevant to the case.

It is also urged, as a ground for a new trial, that it appeared that, in fact, the plaintiff concealed from the defendants, when he applied for the insurance, and at all times before the policy was issued, facts known to him, which were material to the risk; and that the Court erred in refusing to rule, as requested by the defendants, in accordance with certain propositions of law made to the Court by the defendants. In regard to the question of concealment, and the requests to rule, proposed by the defendants, I carefully considered the views urged on the part of the defendants, in giving my decision in the case, after it was tried, (8 *Blatchf. C. C. R.*, 170,) and no new views on the subject are now presented. The conclusions I arrived at are fully stated, with the reasons therefor, in such decision, and I have not been able to satisfy myself that they are erroneous.

A new trial is also asked for, on the ground that the Court erred in refusing to make, on the request of the defendants, a special finding of facts in the case. The reasons which governed the Court, in so refusing, were those which are set forth in the opinion in the case of *Clement v. The Phoenix Ins. Co.*, (7 *Blatchf. C. C. R.*, 51). I understand the views

Folsom v. Mercantile Mutual Insurance Company.

which I there took of the effect of the provisions of the 4th section of the Act of March 3d, 1865, (13 *U. S. Stat. at Large*, 501,) to be sustained by the Supreme Court, in the case of *Norris v. Jackson*, (9 *Wallace*, 125). The Court which, after the waiver of a trial by jury, tries a case without a jury, is not required to make a special finding upon the facts. It may make a general finding, and it may rightfully decline to make a special finding. There is nothing in the case of *Genereux v. Campbell*, (11 *Wallace*, 193,) or in any other decision of the Supreme Court, inconsistent with this view. In this case, I think it was a proper exercise of the discretion of the Court, not to make a special finding, and that a new trial ought not to be granted because of the refusal of the Court to make a special finding.

In regard to the objection, that the policy does not contain the words "lost or not lost," and that the vessel had, in fact, been lost before the policy was issued, I fully considered the question, in my opinion given on deciding the cause, and adhere to the views then expressed.

The motion for a new trial is denied.

Charles M. Da Costa, for the plaintiff.

Townsend Scudder, for the defendants.

JOHN M. KNOX

vs.

TERANCE J. MURTHA AND RICHARD P. CHARLES. IN EQUITY.

The third claim of the reissued letters patent, No. 3,794, granted to Daniel Shaw, January 11th, 1870, for an improved smut-mill and separator, (the original patent having been granted to him April 6th, 1852, and reissued November 3d, 1863, and extended April 6th, 1866,) namely, "In combination with a smutter or scourer, and a suction fan, both arranged on and driven by the same shaft, and an air-trunk for directing the course of the blast, a regulator, for changing the force or volume of the current of air, without changing the speed or motion of the smutting or scouring cylinder, substantially as described," is limited to a combination in which a tight smutter or scourer is employed, and does not cover a combination in which an open scourer is employed.

The general words of the claim are to be construed as limited by any particular description found in the specification.

Reasons stated why such third claim is, probably, invalid.

The fifth claim of the patent, namely, "The arranging of the smutter or scourer and the suction separating fan within or between the legs of the blast or air-trunk, in which the entire separation is made, and which passes over or around them, for the purpose of economizing space, and cheapening the construction of the machine, substantially as described," is void, as covering no patentable invention.

(Before BENEDICT, J., Eastern District of New York, November 26th, 1871.)

BENEDICT, J. This is a suit in equity brought by John M. Knox, the assignee of a patent for an improved smut mill and separator, reissued to one Daniel Shaw, on the 11th of January, 1870, to obtain a decree for an injunction and account against Terance J. Murtha and Richard P. Charles, because of an alleged infringement of said patent in the use of a grain scourer and separator manufactured by Howes, Babcock & Co., of Silver Creek, in this State. The defend-

ants deny the infringement and also deny the validity of the Shaw patent as reissued.

I shall first consider the question of infringement. There is no dispute as to the description of machine which the defendants use; and whether they infringe or not depends upon the construction given to the Shaw patent.

This patent was originally issued to Daniel Shaw on the 6th of April, 1852, and reissued on the 3d of November, 1863. On the 6th of April, 1866, an extension of the patent was granted for seven years, and the patent was again reissued to Shaw, on the 11th of January, 1870. It is designated in this case as the Shaw reissue No. 3,794. It contains five claims; but, since the commencement of this suit, a disclaimer has been made of the first, second and fourth claims, leaving only the third and fifth claims to be considered here.

The third claim is as follows: "In combination with a smutter or scourer, and a suction fan; both arranged on and driven by the same shaft, and an air trunk for directing the course of the blast, a regulator for changing the force or volume of the current of air, without changing the speed or motion of the smutting or scouring cylinder, substantially as described." This is a claim for a combination only; and one of the questions raised is, whether the combination secured by it is limited to the use of a tight smutter or scourer, or whether it covers the use of any form of smutter or scourer in combination with the other elements described. If, as the defendants insist, it be construed so as to confine the patent to a combination in which one element is a tight smutter or scourer, this action must fail; for, the combination employed in the machine used by the defendants contains an open scourer, and does not contain a tight smutter or scourer. Much importance has been attached to this question by the counsel, and I have considered it with care. My conclusion is, that the construction contended for by the defendants is the true construction to be placed upon the third claim.

An examination of the patent will, as I think, render apparent the correctness of this conclusion. In the claim itself,

which designates the combination sought to be secured, no description is given of the scourer which is stated to be an element of the combination sought to be secured. The words are, "in combination with a smutter or scourer;" and these words, it is said, are sufficient to include any form of scourer then known. But, effect must be given to the words, "substantially as described," which are used in the claim, and their effect is to refer to the specification for the description of the elements of the combination which is wanting in the claim. The general words of the claim in respect to the scourer are, therefore, to be construed as limited by any particular description found in the specification. The specification first recites, that, "previous to the invention of Shaw, smutting and scouring of grain were done in one machine; and the separating of the grain into qualities, according to its specific gravity, and further separating of grain from the scorings or lighter impurities, and from the dust and chaff, were done in another machine, thus requiring two machines, two handles and two operators." The specification then declares: "I lay no claim to any such separated machines or operations, nor do I claim any machine where a separation is attempted through the smutting cylinder, or wherein less than three distinct and separate divisions of the material, according to their values and specific gravities, are made, and separately deposited in separate places." The specification further states, that "the invention consists in the combination of a smutter or scourer with a suction separating fan-blast or current of air, so that a separation of the dust, chaff, and other impurities from the grain shall take place after the grain has been scoured, and after leaving the scouring cylinder;" and, again, that "the invention further consists of a combination of a smutter or scourer, and a suction separating fan, with a wind or air tank common to both the smutter and the fan-blast, and so that the contents of the smutter may pass into the column of air that rushes through the tank to the fan, and be separated therein;" and, again, that "the grain, with all the impurities mixed with it, as it comes from

Knox v. Murtha.

the thresher, or in a partially screened state, is thrown into the smutter, through an opening at its top, where the smut balls are broken or loosed, and the grain scoured by attrition and by the beater arms throwing it against the enclosing case or shell. No separation takes place in the smutter, as there is no operative blast within the outer case. The whole contents of the smutter, including the dirt shovelled in with the grain, and every thing loosened from the grain, pass from the smutter or scourer into the wind trunk, and, from the moment they enter the wind trunk, then the separation begins, the heavy wheat, by its specific gravity, dropping down, and out of the wind trunk, while all the lighter particles are carried up and over to the final separation." This description of the invention cannot be misunderstood, when taken in connection with the state of the art at the time. At the time of the invention of Shaw, two forms of machines called smutters or scourers were well known. The form called here a tight scourer has a tight cylinder or enclosing case, within which the grain, as it comes from the thresher, is beaten about by arms and scoured, and then the mass discharged, to be thereafter separated by a separator. The other form, here called an open scourer, has, instead of a tight cylinder, an enclosing case with numerous perforations in it, through which dust and dirt can be driven by the blast caused by the beaters, or by an operative blast introduced from a fan. The difference between these two machines is radical. If grain, as it comes from the thresher, be submitted to the action of a tight scourer, while useless portions are loosed from the kernels of grain and the kernels scoured, they are, by the same operation, smeared with any smut or adhesive dirt set free by the action of the beaters, and this to an extent, as the evidence shows, which renders the machine comparatively valueless where smutty wheat is present. But, if an open scourer, with an operative blast, be used, the smut, and a large portion of the dirt and dust, as fast as loosed, are driven through the perforations in the enclosing case, and thus an important separation is effected,

Knox v. Murtha.

simultaneously with the loosening of the particles and by the same operation. The one form of machine loosens and separates; the other loosens and combines. Of these two forms, only the tight scourer will answer to construct the machine or combination described in the Shaw patent; and by the use of that form of scourer alone can the result be obtained which the patent declares to be the result sought by the invention, namely, the accomplishment of the entire separation in the air trunk.

The specification of the Shaw patent, although it does not, in so many words, say that the smutter or scourer used is a tight scourer, does state that no claim is made to a machine wherein a separation is attempted through the smutting cylinder. This is equivalent to describing the smutter or scourer as tight, and without an operative blast; and, accordingly, the specification must be understood as excluding from the combination an open scourer with an operative blast.

There was a reason for thus limiting the claim of the patent. At that time, there were in use three combined separating machines, which made three separations, or, more properly, delivered their contents in three divisions, and used open scourers, wherein a part of the separation was accomplished, namely, Torrey's, Ashley's and Johnston's; and there is no evidence of the prior existence of any machine making three separations which used a tight scourer. Shaw, therefore, would naturally be expected to limit his claim to a combination in which a tight scourer formed one of the elements, as he has done by the reissue in question.

I have not overlooked the suggestion, that the use of an open scourer, instead of a tight scourer, is but adapting an improvement to the combination claimed by Shaw. The answer is, that an open scourer is not an improved tight scourer, but a different device, producing a different result, as is shown by the fact, that the defendants' machine will clean and separate smutty wheat, which the Shaw machine will not do. Shaw's patent is for a combination of elements acknowledged to be old, which are arranged in a certain way, in

order to accomplish a stated result, namely, the separation of the threshed grain into three divisions in the air-trunk alone. One of these elements he has, by his claim, taken in connection with his specification, described as a tight scourer. The defendants do not infringe upon his patent, because their machine does not contain any tight scourer, or its equivalent, but does contain another element, having a different function, and producing, in combination, a different result. Even if the result attained by the defendants' machine be considered as similar to that sought to be accomplished by the Shaw machine, because, in addition to the separation effected by the open scourer, it also effects three separations of the remainder in the air-trunk, still, the defendants cannot be held to be infringers on the Shaw patent, for, the combination which they use is not Shaw's combination. It discards one of Shaw's elements, as he has described them, and includes a device not found in Shaw's combination, which performs, in the defendants' machine, a function not performed by any device in Shaw's machine, whereby the material to be separated in the air-trunk is changed in character, being free from smut, and having a different proportion of dust; and, in such added device, as the evidence shows, nearly three-quarters of the separation takes place. I am, therefore, of the opinion, that the plaintiff has failed to prove the infringement charged.

There is another aspect of this case, which I will also notice. The defendants have put in evidence a grain separator, well known, and in use prior to the date of the Shaw invention, which had been invented by one Sanders, and is known as Sanders' separator. This machine consists of an air-trunk, through which an air current is created by a suction fan, and the same regulated by a regulator. In this trunk, the current first ascends through an ascending leg. At the top of the ascending leg, the air-trunk turns at right angles, and gives to the air current a horizontal direction. This horizontal portion of the air-trunk is enlarged, and its lower surface given the form of a capacious hopper, with a slide-valve at the bottom. After passing the hopper, the air-trunk turns

Knox v. Murtha.

down again, and into the eye of the fan. In this machine, material coming from a scourer is spouted into the ascending leg, where the heavy grain is separated from the rest of the mass by gravity, precisely as in the Shaw machine. This separation effected, the remainder of the mass passes into the horizontal part of the air-trunk, where the current is weakened by the enlargement of the trunk, and, by means of the depression of the bottom of the air-trunk, to form the deep hopper, the force of gravity is again rendered effective. Here, therefore, while the dirt, dust and chaff are carried on, by the air current, to the eye of the fan, the screenings are carried, by their gravity, out of the air current, to the bottom of the hopper, and thence removed by the slide-valve. The dust and dirt, thus separated from the screenings, pass out of the machine through the fan. The Shaw machine, according to the testimony of Mr. Renwick, an expert called by the plaintiff, differs from the Sanders machine only in that it contains a separator combined with a scourer driven by the same shaft. If this opinion be correct, the Shaw patent must fail, so far as the third claim is concerned, for want of novelty, because, it has been proved, that the combination of a scourer and a separator driven upon the same shaft, was in use before the Shaw invention. It would, also, be open to the objection, that no invention was required to attach a scourer to the shaft of Sanders' separator. But this conclusion of the expert is not agreed to by the plaintiff, who insists that another and a material difference exists between Sanders' separator and Shaw's machine. At first, it was said, that, in the Sanders machine, the screenings fall into the hopper simply by reason of the enlargement of the air-trunk, which reduces the speed of the current, and then nothing but the dust passes with the air current, in the descending leg, to the eye of the fan, while, in the Shaw machine, the screenings, as well as the dust, pass into the descending leg, and there, while the screenings are descending by the force of gravity, as well as by the force of the current of air, the current of air is forced to take a lateral direction away from the force of gravity, and

Knox v. Murtha. /

is aided by an ancillary upward current of air, admitted through the spout F, the place of exit for the screenings, which operates against the descending force of the screenings, and thus the separation is completed. But, it is manifestly no substantial change in the air-trunk, to place the enlargement on the descending leg, instead of on the horizontal portion, as in Sanders' separator. In both cases, the air current is weakened by an enlargement of the trunk, and, in both cases, the separation is effected by the air current being forced to take a lateral direction, away from the force of gravity. If there be any difference, then, between the two machines, sufficient to support the patent, it must arise solely from the existence, in the Shaw machine, of an ancillary current, admitted through the spout F. This was finally conceded on the argument, and the opening at the spout F, for the incoming of the opposite current of air, was pointed out as constituting the only substantial difference between the two air-trunks. But no such feature as an ancillary current admitted into the air-trunk at the spout F, is alluded to in the Shaw patent. It does not appear either in the original patent, or in either of the reissues, and it seems impossible to say that these descriptions convey the idea that an ancillary upward current of air, admitted through the spout F, is an element in the machine. In the third claim of the reissue, the air-trunk is described simply as "an air-trunk for directing the course of the blast." But this description, to render it effective for any purpose, must be held to be qualified by the description given in the specification; and there, while the spout F is mentioned, it is only spoken of as used for receiving and carrying out the scourings from the air-trunk. It is true, that, in the drawings, the spout F is open, and it is spoken of in the description as an opening, but no one could gather, from either the description or the drawings, that the machine was to be so constructed, and the size of the opening at the spout F so proportioned, that, while the scourings should there pass out, an ancillary current of air was, at the same time, to be there admitted, to perform a characteristic part in effecting the sep-

Knox v. Murtha.

aration within the air-trunk. No witness is called to show that such an idea would be conveyed by the specification and drawings, and the contrary seems proved by the fact, that no such idea was conveyed to Mr. Renwick, the plaintiff's expert, who has made this patent a study. My conclusion upon this branch of the case, therefore, is, that, if the only difference between Shaw's machine and Sanders' separator is that stated by the plaintiff's expert, the Shaw patent must fail, so far as the third claim is concerned, for want of novelty, and, also, of invention; and that, if there exists the further difference claimed by the plaintiff, that an ancillary current of air is admitted to the air-trunk through the spout F—a position not easy to maintain upon the evidence—then the Shaw patent must fail, so far as the third claim is concerned, because it does not contain a sufficient description of the invention sought to be secured.

Entertaining these views in respect to the third claim of the Shaw patent, it is unnecessary for me to express an opinion upon the other grounds of objection to this claim taken by the defendants, and I pass to a consideration of the fifth claim of the Shaw reissue, upon which, also, the plaintiff bases a right to maintain this action. The fifth claim is as follows: "The arranging of the smutter or scourer, and the suction separating fan, within or between the legs of the blast or air-trunk, in which the entire separation is made, and which passes over or around them, for the purpose of economizing space, and cheapening the construction of the machine, substantially as described." The idea here expressed, which the patentee has embodied in his machine, and claims to secure as his own, is, that, in a machine having a scourer and fan connected by an air-trunk, as described, economy of space and cheapness of construction would be gained by placing the smutter or scourer between the legs of the air-trunk, instead of elsewhere. Certainly, no invention was required to reach such a result. It would rather require invention to find any reasonably convenient place to locate a fan and scourer so connected, other than the one chosen by the pat-

Kittle v. Frost.

entee. No advantage, or change in the operation of the machine, is claimed for the arrangement, but simply economy of space and cheapness in the construction. That this would be gained by such an arrangement as the patentee claims, could not fail to occur to the mind of any intelligent person seeking to combine a scourer and fan with an air-trunk, as described. A similar arrangement of materials, for the same reason, is to be seen everywhere. I am, therefore, of the opinion, that the fifth claim of the Shaw reissue is invalid, because of insufficiency of invention.

The decree must accordingly be, that the bill be dismissed, with costs.

Keller & Blake, for the plaintiff.

Sprague & Hyatt, for the defendants.

SAMUEL P. KITTLE AND FREDERICK C. PAYNE

vs.

RICHARD W. FROST, JAMES BLACK AND GEORGE SNYDER.
IN EQUITY.

The first claim of the re-issued letters patent granted to Samuel P. Kittle, October 17th, 1865, for a "spring mattress," (the original patent having been granted to him November 8th, 1864,) namely, "The combination of the two parts, A and A', and an intervening portion of the sides of the box of a box-spring mattress, having the cases containing the stuffing attached to the said sides, the said parts A, A', and the intervening portion, being connected to each other by hinges, the joints of which are located twice the distance apart of the thickness of the stuffing, substantially as herein above set forth," is infringed by a mattress in which the sides of the box are divided into five parts.

Kittle v. Frost.

in such manner that the mattress contains the combination covered by said third claim, introduced twice, once at each end of the mattress.

The said patent is valid.

K., the inventor, in April, 1863, after making the invention, agreed in writing with F., to assign to F. an undivided one-half interest under the patent when it should be issued, in and to certain specified territory, on condition that F. should perform all of the covenants on his part in the agreement, which were numerous, and concerned principally the making and selling of mattresses. Among them were, however, covenants, that F. should pay "all necessary expenses of procuring a patent" for the invention, advancing the same as it should be required, \$30 of it to be advanced before May 30th, 1863, and that F. should "be at the risk of all the expenses arising in the prosecution of the case for a patent" on the invention. In June, 1864, when the application for the patent was ready to be filed, F., at the request of K., paid to K. \$15, as the fee to be paid at the Patent Office on filing the application. It was filed. Subsequently, K. notified F. of his, F.'s, failure to perform many of his covenants, and demanded a compliance with all of them. Two days after the patent was granted, K. notified F. that all his rights under the agreement were forfeited, and that he must not make any mattresses under the patent. The parties then met, and K. renewed the notice, and F., with a view to a settlement of his pecuniary transactions with K., under the agreement, presented to K. a bill, which contained, as a debit against K., the said item of \$15, as "advanced on patent:" *Held*, that this was an abandonment by F. to K., with the acquiescence of K., of all rights of F., under the agreement, to an interest in the patent.

(Before BLATCHFORD, J., Southern District of New York, December 15th, 1871.)

BLATCHFORD, J. This suit is founded on re-issued letters patent of the United States, granted to Samuel P. Kittle, one of the plaintiffs, October 17th, 1865, for a "spring mattress," on the surrender of original letters patent granted to him November 8th, 1864. The re-issued patent contains seven claims, but only the first two claims are alleged to have been infringed by the defendants. The subjects of these two several claims are defined by the specification in the following language: "The first part of my invention relates to the division of the sides of the box which contains the springs on which the hair mattress or other stuffing is supported, at two points, and connecting the said parts by hinges, in such a manner that the joints thereof shall be, at two points, distant from each other twice the thickness of the stuffing, and so arranged that the head or foot portion of the bed can be folded

Kittle v. Frost.

over so as to bring the principal parts of the box parallel with each other, the stuffing being between them, as hereinafter more fully set forth. The second part of my invention relates to so constructing that portion of the box which forms the short section between the hinges or joints, as to make it capable of supporting a portion of the springs, while at the same time it is of such length as to allow the parts upon each side of it to be hinged to it, and connected to each other at two points on each side, at the distance apart of twice the thickness of the stuffing, as hereinafter more fully set forth." The first and second claims of the patent are as follows: "First. The combination of the two parts, A and A', and an intervening portion of the sides of the box of a box-spring mattress, having the cases containing the stuffing attached to the said sides, the said parts, A, A', and the intervening portion, being connected to each other by hinges, the joints of which are located twice the distance apart of the thickness of the stuffing, substantially as herein above set forth. Second. The combination of the two parts, A, A', hinged at two points the distance apart of twice the thickness of the stuffing, the intervening part, A", and a series of springs supported upon slats, attached to the said intervening portion, A", the whole being constructed and operating substantially as herein above set forth."

The object of the improvement covered by the first claim is to enable a box-spring mattress to be folded flatwise without material injury to the stuffing, which is mounted upon and connected with the box bottom containing the springs. The improvement consists in combining two parts of the sides of the box of the mattress with an intervening portion of such sides, by connecting them together by means of hinges, the joints of which are located twice the distance apart of the thickness of the stuffing, the cases containing the stuffing being attached as well to such two parts as to such intervening portion. The specification describes a division of the sides of the box at two points on each side.

The object of the improvement covered by the second

Kittle v. Frost.

claim is to make such intervening portion capable of supporting a portion of the springs, while, at the same time, it is of such length as to allow the parts upon each side of it to be hinged to it, and connected to each other at two points, on each side of the box, at the distance apart of twice the thickness of the stuffing. The improvement consists in combining such two parts of the box, hinged at two points the distance apart of twice the thickness of the stuffing, with such intervening part, and with a series of springs supported upon slats attached to such intervening part. This construction enables the parts of the box on each side of the intervening part to be folded over so as to become parallel with each other, the spring-box and the mattress mounted on the springs being folded over by the same movement.

There can be no doubt that the defendants have infringed both of these claims. Their mattresses are of a like construction in principle to the mattress of Kittle, differing only formally in this, that the defendants' box has each of its sides divided into five parts instead of three, each of the sides being divided at four points instead of two. The result is, that the defendants' mattress has, in the middle of each side of the box, a long portion, on each side of such long portion, a very short part, corresponding with the intervening part in Kittle's mattress, and, at each end of the length of each side, another part. These end parts can be folded over so as to become parallel with the middle part of the box, and to be in the same plane with each other. When so folded, the defendants' mattress is, in effect, two of Kittle's mattresses combined into one. It embodies each one of the two improvements of Kittle covered by his first and second claims, and embodies each one twice, each of the improvements being applied at each end of the mattress. If cut into two, through the space between the end parts when folded, and through the centre of the middle one of the five parts, two of Kittle's mattresses would be produced. There are the two outer parts, the intervening part, the box, the box spring mattress, the cases containing the stuffing attached to the three parts, the three

parts connected to each other by hinges, the joints of the hinges located twice the distance apart of the thickness of the stuffing, and the series of springs supported upon slats attached to the intervening part, and all this in duplicate in each mattress, one of such arrangements at each end. The same result is attained by the arrangements, and in the same way, as in the patent. In such mattresses of the defendants as contain the arrangements above mentioned, except in not having the cases containing the stuffing attached to the parts forming the sides of the box, the second claim of Kittle's patent is infringed. It may be that the defendants' mattresses contain a useful improvement beyond what is found in Kittle's patent. Whether they do or not is of no consequence here. They certainly embody what is patented by Kittle.

In addition to the defence of non-infringement, urged at the hearing, but not set up in the answer, the allegation of infringement made in the bill not being denied by the answer, the defendants attack the patent for want of novelty, various specifications in that regard being contained in the answer. Without going into a detailed discussion of the prior inventions set up, it is sufficient to say, that none of them embody what is covered by either the first or the second claim of the Kittle patent. The three principally relied upon are what are known as the "Putnam bed," the "Colton folding bedstead and mattress," and the "Cincinnati bed." These are effectually disposed of by the testimony of the expert on the part of the plaintiffs, and there is no testimony in contradiction.

The defence really relied on, and which has caused the proofs in this case to be swollen to the bulk of some seven hundred printed pages, is a claim, on the part of the defendants, that what they have done in respect of their mattresses has been done under a right or license granted by Kittle under the inventions covered by the patent. The answer sets up, that, by a written instrument executed by Kittle and one Alexander D. Farrell, on the 11th of April, 1863, Farrell became interested in Kittle's invention, and in and to the

Kittle v. Frost

patent subsequently issued for it, to the extent of one undivided half interest in and to all the counties in the State of New York, except those lying on, or west of, the Genesee river; that Farrell duly complied with all the conditions contained in said instrument requisite or necessary for the proper vesting of said interest in Farrell; that the defendants are selling folding-bed bottoms, and all of them are made by Farrell; and that, if they contain any thing covered by Kittle's patent, they have been made and sold to the defendants under such license to Farrell, and Farrell has, by virtue of the interest referred to, such rights under Kittle's patent, that the defendants are justified in selling such bed bottoms, without thereby infringing Kittle's rights.

The instrument referred to bears date the 1st of January, 1863, but was signed the 11th of April, 1863. It recites, that Kittle obtained a patent for a "rollable spring mattress," August 28th, 1860; that he has recently invented a "folding-box spring mattress," for which he is about to apply for a patent; and that Farrell is desirous of manufacturing the said mattresses in the city of New York, and of acquiring an interest in the last-named invention in the State of New York, when the same shall be patented. Then Kittle, "in consideration of the covenants and agreements" by Farrell, therein-after contained, "and of and during the true and faithful performance of each and every of them," grants permission to Farrell "to manufacture and sell the said rollable and folding spring mattresses in his factory in New York city, for the term of two years" from the date of the instrument, and agrees to pay Farrell "four dollars per month for the privilege of selling the said mattresses from samples of the different grades" described in the instrument, (which Farrell is to expose for such purpose in his salesroom,) and also for the attention of Farrell to making sales, taking orders, delivering goods, and collecting bills, during the absence of Kittle. Then Kittle "agrees further to assign an undivided one half interest in and to all the counties in the State of New York, (except those lying on, or west of, the Genesee river,) for and

Kittle v. Frost.

to the right in the folding mattress, when the patent for the same shall be granted by the United States" to Kittle; and Kittle further agrees to pay to Farrell the price thereafter specified, as regards the grades and the time of payment; and Farrell, "in consideration of said license or permission and agreements, covenants and agrees, on his part, (1.) "To proceed without delay to manufacture the above mattresses according to the patent improvements, plans and directions" of Kittle, thereafter specified. (2.) "To expose the several grades of mattresses" thereafter specified, "for the inspection of the public, in a convenient store or show room, where he is to advertise the same by personal effort, by cards, circulars, and through the newspapers, always representing the rollable mattress as the most economical and best mattress or bed that can be procured." (3.) To furnish Kittle "office and desk room in his store or show room, above specified, and, for the monthly payment of four dollars, to allow the customers" of Kittle "to examine the different grades of beds at all regular business hours, and, in the absence" of Kittle, "to attend to them as he would to his own customers, take their orders, and supply them promptly with any mattresses they may order, and make out and collect the bills, and keep an accurate account of the same" for Kittle. (4.) "To keep an order book, in which every order, as soon as received, shall be legibly entered, and the actual number of each mattress, as soon as finished, shall be regularly entered, and, when sold to whom and where sold, and see that a corresponding number be entered on the label or patent mark which shall be permanently affixed to each mattress when finished." (5.) To pay Kittle "one dollar each for every rollable spring mattress he shall manufacture on his own account and not" for Kittle "or his customers, (every person who shall inquire" for Kittle, "or who may have previously negotiated for or bought mattresses of him,) and to pay all necessary expenses of procuring a patent for the folding spring mattress, advancing the same as it shall be required in the progress of the case, thirty dollars of which is to be advanced before the thir-

Kittle v. Frost.

tieth of May, 1863." (6.) "To promptly supply all the orders of Kittle" and his customers, at actual cost of the material and labor, and twelve per cent. profit, and three per cent national tax added thereto, cartage and packing or boxing (if such there be) to be done at actual cost" for Kittle. "If the delivery is direct from the cart or store to the customer, payment is to be made within three days after delivery, but, if out of town, or by second conveyance, then in ten days." (7.) To allow Kittle, "or his known agent, free access to the aforesaid order book and all its entries, as well as unobstructed access to all parts of the manufactory at all regular business hours." (8.) "To make a full, accurate and minute statement every week of all the mattresses manufactured during the week then ending, their kind and the actual number of each, to whom and where sold and delivered, such statement, together with all moneys due or belonging" to Kittle, and in the possession of Farrell, to be delivered to Kittle, and, in case he is out of town, to his wife, at his residence." (9.) "To make all mattresses strictly in pursuance" of a schedule hereinafter contained, "unless it shall be clearly impossible to retain custom or make the sale without deviation, and then to deviate no further in degree or number than is absolutely necessary for such case, and no such deviation is to be made as a rule in any case or to any customer, except in case of special written directions by letter, which shall fully state the deviation and its extent, and and to whom it applies," from Kittle. (10.) The schedule referred to, covering rollable mattresses, and folding spring mattresses, of various grades and sizes. (11.) "To see to have the work done by the piece and as advantageously as possible, and, if it is found that the cost therein can be reduced," Kittle "is to have the full benefit thereof on all made for him or his customers." (12.) "In case the cash value of the material entering into the above mattresses shall rise or fall in the market, wholesale cash price, then such addition or reduction shall, in all cases, be made in making up the price" to Kittle, "for his and his customers' orders, before adding the provided per cent." to Farrell.

Lastly. "Not to sell any of the above grades of mattresses at lower prices" than Kittle "shall be in the habit of selling, nor to charge exorbitantly high prices for the rollable mattress above specified, but, in general, to conform, as near as possible, to the established or general prices" of Kittle "and to seek uniformity of prices in the sale and introduction of said mattresses. Finally. Farrell "is to be at the risk of all the expenses arising in the prosecution of the case for a patent on the folding spring mattresses aforesaid," and Kittle "is to use all diligence to hasten the issue of the same."

The defence set up under this agreement is not claimed under the provision thereof whereby Kittle, for the consideration specified, grants permission to Farrell to manufacture and sell the folding spring mattresses for the term of two years from the date of the agreement. That term expired before the 17th of October, 1865, the date of the reissued patent. The defence alleged is, that Farrell became, under the agreement, entitled to an undivided one-half interest in the patent for the folding mattress, for the territory in that respect specified in the agreement, which embraces the territory within which the infringement by the defendants is alleged by the bill to have taken place.

A voluminous mass of testimony has been taken on both sides, in regard to points of compliance and non-compliance by Farrell with the covenants and agreements specified in the contract, as to be each of them truly and faithfully performed by him, as the consideration of the agreement by Kittle to assign to him the specified interest in the invention and patent. But I shall not examine these in detail, as there is one view of the case which seems to me controlling in favor of the plaintiffs and against Farrell. The defendants have no greater rights than Farrell has. They justify under and through him. Consequently, if Farrell deliberately abandoned his rights under the agreement, so far, at least, as a claim to an interest in the folding mattress patent was concerned, and made that abandonment directly to Kittle, with the acquiescence of Kittle, the defendants are without justification.

Kittle v. Frost.

It was one of the stipulations on the part of Farrell, in the agreement, that he would pay all necessary expenses of procuring a patent for the folding spring mattress, advancing the same as it should be required in the progress of the case, and, again, that he would be at the risk of all the expenses arising in the prosecution of the case for a patent on such mattress. The application for the patent appears to have been in readiness to be sent to the Patent Office on the 9th of June, 1864. On that day, Kittle applied to Farrell to furnish him with the sum of \$15, as the fee to be paid at the Patent Office on filing the application. That amount was paid by Farrell to Kittle, for such purpose, on the 10th of June, and the application was filed. On the 22d of August, Kittle wrote to Farrell a letter complaining that Farrell neglected to perform any of his obligations set forth in the contract, and specifying some particulars. On the 27th of September, Kittle wrote to Farrell another letter, saying that he had not received for many weeks any of the benefits contemplated in the contract, that he had called upon Farrell frequently to perform his obligations as specified in the contract, that he had written to him in August calling his attention to his overcharges and other violations of the contract, and that Farrell had since then repeatedly refused him his rights and privileges under the contract, and demanding of him immediate payment of a bill therewith presented, and an immediate statement in writing of all rollable and folding spring mattresses included in the contract, and manufactured by Farrell since the last bill rendered to Kittle, and the payment of all moneys in Farrell's hands belonging to Kittle, which Farrell had collected on beds sold or delivered to customers of Kittle's, and access to the order books, for examination; and, as he alleged he had been refused access to the shop or manufactory, the removal of all restrictions to free access thereto, and a full, faithful, and immediate compliance on the part of Farrell with all provisions of the contract. The bill accompanying the letter contained various items of charges against Farrell, and, among others, one of \$15 for the first

Kittle v. Frost.

patent fee, under date of June 11th, and a credit, under date of June 10th, of \$15, as furnished by Farrell on Kittle's order, leaving the amount of the bill at \$180 31. The letters and the bill were presented to Farrell. The patent was granted on the 8th of November, 1864. On the 10th of November, the attorney for Kittle sent a letter to Farrell, advising him of the issuing of the patent, and notifying him that all privileges claimed by him under the agreement were forfeited by reason of the violation by him of the provisions of the agreement, and that he must not manufacture or sell any mattresses involving any invention for which Kittle held a patent, and demanding an immediate adjustment of the claim of Kittle for the previous use of his inventions. On the 2d of December, the attorney for Kittle wrote again to Farrell, requesting him to call upon the attorney in regard to the unsettled matters between him and Kittle. In pursuance of this request, Farrell had an interview with Kittle and the attorney, at which Kittle informed Farrell that he had forfeited his rights under the contract, by a failure to perform the contract on his part, and that he was infringing the folding box spring mattress patent, and must cease to manufacture folding box spring mattresses. At the same interview, Farrell produced and presented to Kittle, as a bill of the amount due by Kittle to Farrell at the time, a statement of items of debits and credits, in which statement there is charged by Farrell against Kittle, as an item of debit, \$15, as "advanced on patent." The amount claimed by Farrell, after deducting the items of credit to Kittle, was \$125 01. This item of \$15 was the sum of \$15 advanced by Farrell in June, 1864, for the fee on the patent. It is quite apparent, from what transpired between the parties, that both of them, in December, 1864, regarded the unsettled matters between them as consisting solely of their pecuniary transactions under the contract, and considered the contract at an end so far as any further action under it was concerned, except by way of remedy for the past, and understood that Farrell had acquired no right to any interest under the folding box spring

Kittle v. Frost.

mattress patent to Kittle. The charging in account, by Farrell to Kittle, of the \$15, which he had previously advanced to Kittle towards the patent fee on the patent, and which sum it was for Farrell to pay absolutely, and not charge to Kittle, if Farrell was to acquire any interest under the patent, and the doing this after he knew that the patent had been issued, and after he had been informed by Kittle that he had forfeited all his rights under the agreement by having violated its provisions, and was infringing the patent, and must desist from its infringement, must be regarded as an acquiescence by him in the position taken by Kittle, and an abandonment of his claim to an interest in the patent, leaving him to his right of action against Kittle for any amount due to him on transactions under the agreement. Farrell had, in fact, as the evidence shows, failed, in many particulars, to perform his stipulations in the agreement, so as to entitle himself to the interest in the patent. He was conscious of this, and hence this clear act of acquiescence in the views of Kittle, and this waiver of a claim to such interest. In the mass of testimony given by Farrell, covering one hundred and eighty printed pages, and eight hundred and seventy-six questions and answers, no explanation is attempted to be made by him as to what he intended by making this charge against Kittle, other than a waiver of his claim to an interest in the patent, nor was any satisfactory view on the subject, founded on the evidence, suggested by the counsel for the defendants on the hearing. Indeed, the proof shows, that, from a period as early, at least, as the date of the patent, the parties, by their mutual acts, regarded the agreement as at an end, at least so far as it could operate to vest in Farrell an interest in the patent.

There must be a decree for the plaintiffs for a perpetual injunction and an account of profits, with costs.

George Gifford and Stephen D. Law, for the plaintiffs.

Andrew J. Todd, for the defendants.

THE ERIE RAILWAY COMPANY AND OTHERS

vs.

ROBERT A. HEATH AND OTHERS. IN EQUITY.

This Court having in its hands certificates for 60,056 shares of the capital stock of a corporation, one of the plaintiffs, and having made an order for the delivery of those certificates to the defendants, one G. petitioned to have so many of such certificates as would represent 12,785 of such shares delivered to him, as the owner thereof. Certificates of shares, far exceeding in number 60,056 shares, had been put into the hands of the defendants, by various persons, with power to the defendants to transfer them, on the books of the corporation, from the names of such persons to their own names. The defendants gave to such persons receipts stating the number of certificates and the number of shares, and that the certificates were to be registered in the names of the defendants. G. became the owner of 124 of such receipts, representing 12,785 shares. The 60,056 shares, and no more, had been transferred to the names of the defendants, and the certificates therefor, in the hands of the Court, were in their names. G. could not identify any of the receipts he held as having been given for any particular certificates represented by any of the certificates in the hands of the Court: *Held*, that any person who could identify any certificate he deposited with the defendants, could call upon them to respond in respect thereof; and that, as G. did not show that any person under whom he claimed title to the receipts, deposited any of the certificates representing the 60,056 shares in the hands of the Court, or that such certificates were not all of them deposited by persons to whom the receipts which he claimed to own were not issued, the prayer of this petition must be denied.

(Before BLATCHFORD, J., Southern District of New York, December 19th, 1871.)

BLATCHFORD, J. The substance of the allegations of the petition of Jay Gould, now presented to the Court, is, that there were put into the hands of the defendants Heath and Raphael, by the owners thereof, certificates for and representing shares of stock in the Erie Railway Company amounting to over 300,000 shares; that such certificates, when so put into their hands, were each of them accompanied by a power

The Erie Railway Co. v. Heath.

of attorney to transfer the same, signed in blank by the holder on the back of the certificate, with permission to such defendants to stamp their names in such blank power of attorney, thereby conferring upon them power to cause the shares represented by each certificate to be transferred on the books of the corporation to the name of them, thus giving them full power and authority over the stock to the same extent as though they were *bona fide* owners and holders thereof; that thereupon the defendants caused their names to be stamped in the blank powers of attorney, so executed, authorizing them to cause the stock to be transferred on the transfer books of the company, to the names of them or their nominees; that, for the stock so received, the defendants caused to be delivered to the shareholders, in exchange for each certificate of stock received, a receipt in substance as follows: "No. —. Received of _____, _____ certificates for _____ shares in the Erie Railway Company, to be forwarded to America for registration in the names of Messrs. Robert Amadeus Heath and Henry Lewis Raphael;" that all of the stock so received was stamped with the names of the said Heath and Raphael, in the power of attorney so signed in blank, thereby empowering them to cause said stock to be transferred upon the books of the corporation to their own names; that such receipts do not represent, and were not intended to represent, any particular certificates of stock, or class of such certificates, and do not designate any of such certificates to which the holders of such certificates are entitled, but, on the contrary, entitle the holders thereof to demand any portion of the certificates held by the defendants, without any discrimination; that the petitioner is the holder and owner of 12,735 shares of the stock of the company, the certificates or evidence whereof, issued by the company, have been so delivered to the defendants, with a blank power of attorney, for a transfer thereof, signed on the back thereof, with the names of the said Heath and Raphael stamped thereon; that the only evidence the petitioner has of his ownership of such certificates is a quantity of such receipts in said form,

The Erie Railway Co v. Heath.

the number of each receipt and the quantity of shares represented by it being set forth, the receipts being 124 in number; that 60,000 shares or over of the stock of the company, with said blank powers of attorney endorsed thereon, and with the names of Heath and Raphael stamped thereon, have been presented at the office of the company, with the request that the same be transferred to the names of the said Heath and Raphael, and the company, under the orders of this Court herein, has, to a great extent, caused such shares to be put in condition to be transferred to the names of said Heath and Raphael, and is diligently engaged in completing such transfer; that the certificates representing the shares of the stock of the company owned by the petitioner, and represented by such receipts now held by him, are a part of and among such certificates so delivered to Heath and Raphael, with such blank powers of attorney endorsed thereon, and which have been stamped with the stamp of Heath and Raphael in the blank power of attorney, and are either a part of such 60,000 shares or of the residue not embraced therein; that the petitioner has no means of identifying such certificates, his only evidence of ownership thereof being the receipts he holds for the same, in the form before mentioned; that the petitioner is unwilling that the stock owned by him, or the certificates representing the same, should be held by or in the names of said Heath and Raphael, or any of their nominees; that said Heath and Raphael acquired no title to or interest in said stock, by virtue of said receipts, or any right to hold the same; and that no trust was created for any purpose by which said stock can be held by said Heath and Raphael as against the owners thereof, nor were such receipts intended by such owners to create in said Heath and Raphael any right, title, or interest therein, either in trust or otherwise.

The prayer of the petition is, that this Court will cause proof to be taken of the title of the petitioner to the said shares of stock and certificates, and that the same, to the extent of the receipts held by him, may be delivered to him,

The Erie Railway Co. v. Heath.

and that, in the meantime, the delivery of such shares and certificates to said Heath and Raphael, or any other person, to the extent above claimed by the petitioner, may be suspended, until the title of the petitioner thereto shall be adjudged by this Court.

In answer to this petition, it is shown, by affidavit, that the receipts referred to in the petition are not specially for parts of the 60,056 shares of stock involved in this suit, but are for portions of a much larger quantity of stock delivered over to said Heath and Raphael for registration in their names, the 60,056 shares forming part of the entire larger quantity; that the transfer to said Heath and Raphael, or registration in their names, of the said stock other than said 60,056 shares, has been hitherto prevented by the refusal of the company to permit such transfers; that, at present, any attempt of said Heath and Raphael to effect such transfer is practically enjoined by an order of receivership granted by the Supreme Court of New York, by the terms of which any such stock, upon being presented for transfer or registration, is to be forthwith taken into the possession of a receiver; that, by the terms of the arrangement by which the stock was delivered by its owners to Heath and Raphael for registration, and such receipts were issued therefor, the delivery of the new stock certificates to the owners, after the making of such transfer and registration in the names of Heath and Raphael, was to be made not in this country, but in London; that information has been received from the person who signed the receipts, that there is reason to believe that spurious and forged documents, purporting to be such receipts for shares delivered for registration, have been put in circulation, and are outstanding; that, if this Court should undertake to entertain jurisdiction in respect of the obligations of Heath and Raphael under such receipts, and to compel delivery of the stock called for by the receipts to be made in this country to the holders of the receipts, instead of requiring it to be done in London, according to the arrangement under which the stock was received for registration, there is not believed to be

The Erie Railway Co. v. Heath.

any safe basis here upon which the agents or attorneys of Heath and Raphael can know or decide as to whether receipts which may be presented here are genuine or not, nor as to the genuineness or validity of the title, by endorsement or otherwise, under which the parties now holding such receipts may claim to have become assignees of the rights of the persons to whom the receipts were originally given; that the said stock, other than the 60,056 shares, the transfer of which to the names of Heath and Raphael has been and is thus prevented, is very large in amount, embracing many thousands of shares, a large amount of such stock having been sent back to England after the seizure of the 60,056 shares; and that the practical negotiability of the stock certificates therefor has been destroyed, because of the fact, that, when such stock was sent to the United States for transfer and registration, the names of Heath and Raphael were inserted as transferees, in the powers of attorney endorsed on the certificates, so that delivery of such stock can no longer be made to a purchaser by giving to him the certificate with a blank power of attorney for transfer.

In July last, when this suit was before me in one of its phases, the question was discussed as to the propriety of allowing the real owner of stock represented by Heath and Raphael to claim it at the hands of this Court while it is in the custody of this Court. I then remarked, (8 *Blatchf. C. C. R.*, 538): "When such stock shall have been placed in proper condition for its restoration to Heath and Raphael, if, then, any person claiming any of the stock through evidence of title issued by Heath and Raphael, shall apply to this Court to have his rights in the premises awarded to him out of the *res* in Court, the application will be considered and disposed of."

It is quite apparent, that the claim of the petitioner to have delivered to him certificates of stock to the extent of 12,735 shares out of the entire 60,056 shares, but no particular 12,735 shares, cannot be allowed. By the transaction of putting the certificates for the shares into the hands of Heath and Raphael, the owners thereof merely appointed Heath and

The Erie Railway Co. v. Heath.

Raphael their agents to have such stock transferred to and registered in the names of such agents. Such agency was not a power coupled with an interest, but was a power revocable at the will of its grantor. The petitioner, claiming to stand in the place of original grantors of such powers, (for he does not allege that he was an original depositor of certificates,) claims to revoke such powers. But he can revoke them only in respect to the identical certificates which such original grantors put into the hands of Heath and Raphael, or in respect to certificates representing, in direct replacement and succession, such original certificates, and not in respect to certificates which were not put into the hands of Heath and Raphael by grantors of powers to whom receipts were issued which the petitioner claims to own. He explicitly states, in his petition, that the certificates represented by the receipts which he owns are either a part of the 60,056 shares, or are a part of the remainder not included in the 60,056 shares, and that he has no means of identifying such certificates. It is true, that the petition states, that such receipts do not represent, and were not intended to represent, any particular certificates of stock, and do not designate any of such certificates to which the holders thereof are entitled, but entitle the holders to demand and receive any portion of the certificates of stock held by Heath and Raphael, without discrimination. The receipts do not specify or identify, by numbers or otherwise, the particular certificates received, and do not, on their faces, represent any particular certificates, or designate the certificates received as being the certificates to which the holders of the receipts are entitled. But it by no means follows that the receipts do not in fact represent any particular certificates, or that they entitle the holders thereof to demand and receive any portion of the certificates held by Heath and Raphael, without discrimination. Each receipt bears a number. It is to be supposed that, by such numbers, or otherwise, the particular certificates which each grantor of a power placed in the hands of Heath and Raphael can be identified. Whether this be so or not, any person who can identify the certificates he

The Erie Railway Co. v. Heath.

deposited, is entitled to call upon Heath and Raphael to respond in respect of such particular certificates, and to claim that no one else shall call upon them to respond in respect of the same certificates. This view becomes important in connection with the fact that Heath and Raphael hold, under like powers, certificates for a very large number of shares besides the 60,056 shares. Such other shares have not yet been transferred to, or registered in, the names of Heath and Raphael. This has happened, as appears, through no fault of Heath and Raphael. There is no justice in allowing the petitioner to claim and receive the 12,735 shares in preference to other depositors who are not parties in Court. For aught that appears, it may very well be, that such other depositors deposited all the certificates representing the particular 60,056 shares now in the hands of this Court. The petitioner does not assert that any person under whom he claims title to the receipts, deposited any of such certificates, nor does he assert that such certificates were not, all of them, deposited by persons to whom the receipts which he claims to own were not issued.

This Court can, out of the 60,056 shares which are in its custody, deliver certificates for shares to no other person than Heath and Raphael, on a petition of this character, in this suit, unless such person shows himself affirmatively to be the depositor, or the assignee of the depositor, of particular certificates which have been replaced by, and are directly represented by, particular certificates forming part of such 60,056 shares.

I do not dwell upon any of the other views taken in the affidavit presented in opposition to the petition, or urged on the hearing, or express any opinion in regard to them, as the grounds on which I have above put my decision are sufficient to dispose of the present application.

In connection with the suggestion as to spurious receipts, I observe, in the list of the receipts furnished by the petitioner, as owned by him, there are, of receipts numbered 15, 18, 59, 191, 329, 438, 460, 812 and 906, two each; of receipts

The Erie Railway Co. v. Heath.

numbered 381, 428 and 475, three each; and of receipt numbered 349, four. These thirty-one receipts cover 3,700 shares. In the cases of numbers 15, 329, 460 and 812, the same number of shares is represented by each of the two receipts of the same number. In the cases of numbers 18, 59, 191, 438 and 906, a different number of shares is represented by each of the two receipts of the same number. In the cases of numbers 428 and 475, the same number of shares is represented by each of two of the three receipts of the same number, and a different number of shares is represented by the remaining one of the three. In the case of number 381, a different number of shares is represented by each of the three receipts of the same number. In the case of number 349, the same number of shares is represented by each of two of the four receipts of the same number, and a different number of shares is represented by each of the other two of such four receipts, each of such latter two representing, also, a different number of shares from the other one of such latter two. I allude to these circumstances only for the purpose of saying, that the field of inquiry which they indicate as a necessary one, is one which ought not to be entered upon by a tribunal which has before it only a portion of the entire number of shares covered by the transactions with Heath and Raphael, and only a controversy respecting a portion of such entire number, and which has no jurisdiction in this suit to affect the rights of those who are not before it.

The prayer of the petition is denied, and the order for the suspension of the delivery to Heath and Raphael of the 12,735 shares is vacated.

David Dudley Field and *William A. Beach*, for the petitioner.

William M. Evarts and *Charles F. Southmayd*, for Heath and Raphael.

Hamilton v. The Mutual Life Insurance Company of New York.

PETER HAMILTON, AS SOLE ACTING EXECUTOR OF, &C., OF
DUKE W. GOODMAN, DECEASED,

vs.

THE MUTUAL LIFE INSURANCE COMPANY OF NEW YORK.
IN EQUITY.

In March, 1858, a mutual life insurance company of New York issued to G. a written policy on his life. G. was, at the time, a citizen of, and a resident in, Alabama, and continued to be such until his death in June, 1866. The policy was for life, subject to the payment of an annual premium on or before a specified day, and contained a provision, that, in case G. should not punctually pay such premium, the policy should cease and determine, and all previous payments made thereon should be forfeited to the company. In due season, in March, 1859, 1860 and 1861, G. paid to M., an agent of the company at Mobile, Alabama, the accruing premiums, and they were received by the company at New York. Afterwards, and in March, 1861, the company withdrew all their agencies from Alabama, and had no agent in that State until 1869. G., after 1861, paid no further premiums on the policy. He was always ready to pay, but did not pay because of the revocation of the agencies, and because the insurrection against the government of the United States prevented lawful intercourse between Mobile and New York. The restrictions against intercourse continued until May, 1865. Afterwards, and before March, 1866, G. applied to the company at New York, to receive the premiums in arrear, with interest. It refused to do so or to recognize the policy as subsisting. The plaintiff, as executor of G., renewed the application, but it was refused, on the ground that the policy was forfeited. He then filed this bill, praying for a decree declaring the policy to be subsisting and not forfeited, and directing the payment of the amount insured by it, less the unpaid premiums and interest thereon: *Held*, That the plaintiff was entitled to such decree.

An executory contract of continuing performance, made before the breaking out of a war, with an alien enemy, if it cannot be performed except in the way of commercial intercourse with the enemy, is *ipso facto* dissolved by the declaration of war, which operates, for that purpose, with a force equivalent to that of an Act of Congress.

Where a contract is of such a character that its continued existence is not dependent upon any further intercourse between the parties, the only effect of

Hamilton v. The Mutual Life Insurance Company of New York.

the war is to suspend its operation, and, on the return of peace, the rights of the parties under it may be enforced.

The policy of life insurance, in this case, was suspended, but not dissolved, during the continuance of the war between the United States and the insurrectionary States, of which latter Alabama was one, and New York was not one, in so far as G. could not pay the accruing annual premiums without commercial intercourse between Alabama and New York.

The contract was not one of continuing performance, in the sense of the rule before stated, so as to be dissolved by the war.

The policy was not unlawful, as continuing to insure the life of G., although he was an alien enemy, it appearing that he was a neutral, passive, non-combatant enemy, who remained such in fact.

On the facts of this case, it was a part of the contract of the company, that G. should have the right to pay the annual premiums to an agent of the company in Alabama, and the company was bound to provide in Alabama, during the continuance of the risk on the policy, an agent to receive such premiums, appointed and qualified in compliance with the statute law of Alabama on the subject, and G. was not bound to pay such premiums elsewhere than to such agent.

As the absence of such agent was all that prevented the payment of the premiums by G., the company cannot set up, as a defence, the non-payment of the premiums at the stipulated times.

The agency of M., having been created before the war, would not have been revoked by the war, at least so far as the right to receive payment of annual premiums was concerned.

Payment of the premiums by G. to the agent, would not have violated any law of war, or any duty of G.'s.

The refusal of the company, when applied to by G., to recognize the policy or receive the premiums, made it unnecessary for him to pay the premium due in March, 1866.

It is of the essence of every contract, that, if one party to it prevents its performance by the other party, the former cannot be allowed to reap any benefit from the fact of such non-performance.

The inability of the company to receive the premiums, because of the unlawfulness of commercial intercourse, was equivalent to a tender of the premiums and a refusal to receive them, or to a waiver of their punctual payment.

There is a sound distinction between cases in which the impediment to the performance of a precedent condition, on which, by contract, money is to be paid, exists solely on the part of him who is to be the actor in performance, and cases in which the impediment exists either solely on the part of him who is to be the recipient of performance, or is an impediment affecting both parties jointly, and equally in extent.

Although the company was a mutual company, the policy was not dissolved by the war, as a contract of partnership between enemies.

(Before BLATCHFORD, J., Southern District of New York, December 22d, 1871.)

Hamilton v. The Mutual Life Insurance Company of New York

BLATCHFORD, J. The plaintiff is a citizen of Alabama, his testator was, during all the period covered by the transactions in this case, a citizen of Alabama, residing and domiciled therein, and the defendants are a corporation created by the State of New York.

The defendants, by their proper officers, made a written contract with Duke W. Goodman, the plaintiff's testator, dated March 24th, 1858. The contract was what is commonly known as a policy of life insurance. It was signed by the officers of the corporation, and made in its name, and was not signed by Goodman, but was delivered to and accepted by him. The material provisions of the policy are these: "This policy of insurance witnesseth, that the Mutual Life Insurance Company of New York, in consideration of the representation made to them in the application for this policy, and of the sum of one hundred and seventy-seven dollars and fifty cents to them in hand paid by Duke W. Goodman, and of the annual premium of one hundred and seventy-seven dollars and fifty cents, to be paid on or before the second day of March in every year during the continuance of this policy, do assure the life of the said Duke W. Goodman, of Mobile, in the County of Mobile, State of Alabama, in the amount of five thousand dollars, for the term of his natural life." There is then a stipulation on the part of the company to pay the sum insured to the assured, his executors, administrators or assigns, in sixty days after due notice and proof of interest (if assigned or held as security) and of the death of the assured. There is then a declaration that the policy is accepted by the assured on certain express conditions, that, in case the assured shall, without the consent of the company, previously obtained and endorsed on the policy, pass beyond certain specified limits, or visit certain specified parts of the United States, or be or reside in certain specified places, or do certain specified things, or die from certain specified causes, the policy shall be null, void and of no effect. Then follows this provision: "It is also understood and agreed, by the within assured, to be the true intent and

Hamilton v. The Mutual Life Insurance Company of New York.

meaning hereof, that, * * * in case the said Duke W. Goodman shall not pay the said annual premium on or before the day hereinbefore mentioned for the payment thereof, then, and in every such case, the said company shall not be liable for the payment of the sum assured, or any part thereof, and this policy shall cease and determine; and it is further agreed by the within assured, that, in every case where this policy shall cease, or become or be null or void, all previous payments made thereon shall be forfeited to the said company." At the foot of the policy, on its face, were these words, in print: "Agents of the company are authorized to receive premiums when due, but not to make, alter or discharge contracts, or waive forfeitures." On the back of the policy were these words, in print: "Receipts heretofore by the company of premiums after the day on which they fell due, were by the assured and the company considered acts of grace or courtesy, and as forming no precedent in regard to future payments of premiums on the policy; and all future receipts of the company of premiums after due, are viewed and understood by the parties in interest, as acts of courtesy of the company, and in no case to be considered a precedent, or a waiver of the forfeiture of the policy, according to the condition expressed therein, if any future payment of premiums be omitted on the day it falls due."

The defendants had, on the 2d of March, 1849, issued to the wife of the said Duke W. Goodman, a policy for \$5,000 on the life of her husband, subject to the annual premium of \$177 50, on an application made February 28th, 1849, when Mr. Goodman was 37 years of age. The defendants are organized on the mutual plan, and made, under their charter, a dividend on the 1st of February, 1853, whereby there was added to the policy in favor of Mrs. Goodman, the sum of \$415 37 at that date, as a principal sum in which Mr. Goodman's life was insured, subject to all the terms of the policy, in addition to, and in like manner as, the \$5,000, but without any addition of premium to be paid. On the 1st of February, 1858, a like dividend was made, whereby the further sum

Hamilton v. The Mutual Life Insurance Company of New York.

of \$567 68, was added to the same policy, as a like principal sum. These dividends were sums of money representing excesses of premium paid by Mrs. Goodman beyond what was found to be necessary to be retained by the company in respect of its risk on the policy, and were applied by the company, on behalf of Mrs. Goodman, to the purchase for her, of paid up insurances with the company, on the same life, in the principal sums so added to the policy. But, although no increased premium beyond the \$177 50 was payable in respect of these additions, or in respect of the policy by reason of these additions, such premium of \$177 50 was annually payable in respect of the whole policy, embracing the \$5,000 and the additions, the additions being placed upon the same footing with the \$5,000, in respect to all the stipulations of the policy, in like manner as if they had been part of a sum in which the life insured was insured at the inception of the policy, at the annual premium of \$177 50. These added sums were at the risk of the policy, with the \$5,000, and recoverable from and payable by the company, at the death of Mr. Goodman, only if the \$5,000 was recoverable and payable. Under this state of facts, the policy in favor of Mrs. Goodman was surrendered to the defendants, and they accepted its surrender, and, in place of it, issued the policy of the 24th of March, 1858. It bore the same number as the policy of March 2d, 1849, and appears to have been regarded as a continuation of it, with only the change as to the recipient of the sum insured at the death of Duke W. Goodman, for the defendants transferred to it, and endorsed upon it, as sums insured by it, the said several sums of \$415 37 and \$567 68, which had been so added to the policy of 1849.

On the 2d of March, in each of the years 1859, 1860, and 1861, Mr. Goodman paid to Thomas W. McCoy, the agent of the defendants at Mobile, the sum of \$177 50, as the annual premium mentioned in the policy. For the payments of 1859 and 1860, he was furnished, on each occasion, with a receipt signed, on behalf of the company, by its secretary, dated at the office of the company in New York, and coun-

Hamilton v. The Mutual Life Insurance Company of New York.

tersigned by McCoy, as agent. The receipt of 1859 specifies the sum paid as renewing the policy "from the 2d day of March, 1859, to the 2d day of March, 1860." The receipt of 1860 specifies the sum paid as renewing the policy "from the 2d day of March, 1860, to the 2d day of March, 1861." On the margin of each one of the receipts of 1859 and 1860, were these words, in print: "N. B. The agreement is mutual (see application and policy), that, unless the premium is paid on or before the day it becomes due, the policy is forfeited and void." For the payment of 1861, Mr. Goodman received a receipt signed by McCoy, as agent of the company, and dated Mobile, March 2d, 1861, specifying the sum paid as the renewal premium on the policy "from date unto 2d day of March, 1862." The payment of March 2d, 1861, was remitted by McCoy to the defendants at New York, and was received by them there by March 26th, 1861. Afterwards, and on that day, the defendants, by their President, addressed a letter from New York, to McCoy at Mobile, in which they said: "On full examination of the Alabama law of 24th February, 1860, we come to the conclusion that we cannot comply with its provisions, and therefore feel obliged to withdraw all our agencies from the State. We write to each policy holder to remit premiums directly to us in future. Will you be kind enough to address them for us, as we cannot tell where the parties now live. Our assured are not covered against actual warfare of any description, whether it be by collision with the Northern States or any other power. This does not apply to non-combatants." McCoy was the principal agent of the company in Alabama. They had other agents in that State. After sending such letter of March 26th, 1861, the company had no agent in Alabama until some time in the year 1869. Mr. Goodman died at Mobile, June 6th, 1866. He had not made any payment of the annual premium on the policy after the payment made March 2d, 1861.

Under these circumstances, the bill in this case is filed, setting forth, that, on the 2d of March, 1862, and on every 2d

Hamilton v. The Mutual Life Insurance Company of New York.

of March thereafter during his lifetime, Mr. Goodman "was ready and willing to pay the several annual premiums, as the same respectively became payable," "but that he did not, on or after the 2d of March, 1862, pay said annual premiums or any or either of them, because the agency of the said McCoy, as the said Goodman was informed and believed, had been theretofore revoked, and no one else had been substituted as such agent in his place and stead, and because the then existing insurrection and rebellion against the Government of the United States had interrupted and prevented all lawful intercourse, by mail or otherwise, between the city of Mobile, where the said Duke W. Goodman resided and then was, and the city of New York, where the said company resided and had its office and place of business;" that, on the 16th of August, 1861, under the authority of the Act of Congress of July 13th, 1861, the President of the United States, by proclamation, declared that the inhabitants of the State of Alabama were in a state of insurrection against the United States; that all commercial intercourse between the State of Alabama and the inhabitants thereof, and the citizens of other States, was, and would remain, unlawful, until such insurrection should have ceased or been suppressed, and that all goods, chattels, wares and merchandise coming from the said State of Alabama into other parts of the United States, without the special license and permission of the President, would be forfeited to the United States; that such restrictions and prohibitions and liabilities to forfeiture continued until May 22d, 1865, and that, until the proclamation of the President, issued on the 2d of April, 1866, the inhabitants of the State of Alabama could have had no standing in this Court; that, immediately after the removal of the prohibition of intercourse, Mr. Goodman applied to the company at New York, to receive from him whatever of such annual premiums might be found in arrear, together with interest thereon, and offered to do whatever he was bound to do for the preservation or restitution of his rights under the policy, but the defendants refused to entertain such proposal and

Hamilton v. The Mutual Life Insurance Company of New York.

denied that Goodman had any rights in the premises; that, after such refusal, Goodman died; that the plaintiff, immediately after his appointment as executor, caused application to be made to the company, at New York, to receive from him whatever of the annual premiums might have been in arrear at the time of the death of Goodman, together with interest thereon, and offered to pay the same, or to abate the same from the amount of the policy, and to do whatever else he was required to do, and gave notice, and offered to make due proof, of the death of Goodman, but the company refused to receive said premiums, or to accept such proof, or to pay said policy, or the additions thereto, or any part thereof; that the company pretends that the policy was forfeited by the non-payment of premium; that any other compliance than as aforesaid with the terms and conditions of the policy, was, without any act or default of Goodman, suspended and prohibited, and rendered impossible; and that it is contrary to equity and good conscience that a forfeiture of his valuable rights should be worked thereby. The prayer of the bill is, that the rights of Goodman, and of the plaintiff, as his executor, under the policy, may be decreed to be valid and subsisting, and not to have been lost by forfeiture or otherwise, the plaintiff being ready and willing, and offering, to pay to the company, all such sums of money, together with interest thereon, as may appear to the Court to be justly and equitably due for premiums on the policy; that the company may be enjoined from asserting any forfeiture of the policy or of the rights of the assured, or of the plaintiff, under the same; and that the defendants may be decreed to pay to the plaintiff the amount thereby assured, with such additions thereto as have accrued and been made or credited to Goodman under the same.

The answer avers, that, if Goodman had been ready and willing to pay the annual premiums falling due March 2d, 1862, and thereafter, it would have been unlawful for him to have made such payments, and equally unlawful for the defendants, after the 16th of August, 1861, to have received

Hamilton v. The Mutual Life Insurance Company of New York.

such payments and continued the policy in force; that no payment has been made on the policy, to the defendants, since the 2d of March, 1861; that none was offered or tendered to be made until after June, 1865; that the policy expired and ceased to exist, by its terms, on the 3d of March, 1862; that, at the time the policy was issued to Goodman, Thomas W. McCoy was the agent of the defendants at Mobile, in and for the State of Alabama; that the appointment of McCoy as such agent, in and for said State, was revoked by the defendants in March, 1861; that Goodman had notice thereof; that since that time the defendants have not had any agent in and for the State of Alabama; that the citizens of the State of Alabama, and that State, on the 12th of April, 1861, rebelled against, and instituted a civil war against, the Government of the United States, and organized a government in hostility thereto; that thereupon all the citizens and inhabitants of that State, and the said Goodman, a citizen and resident thereof, became and were from thenceforth alien enemies, and so continued to be up to and until the cessation of said hostilities, in May, 1865; that the restrictions and prohibitions and liabilities to forfeiture declared by the proclamation of August 16th, 1861, continued until the 22d of May, 1865; that, after the 16th of August, 1861, and before the 22d of May, 1865, it was unlawful for the defendants to insure the life of Goodman, or to receive from him, or credit him with, any premium on the policy; and that such state of insurrection and war, of itself, terminated the policy, and all the rights and interests of Goodman or his assigns therein, and also terminated his membership of said company, and all his rights and privileges as a member thereof, and all right thereafter to participate in the investments, earnings and profits thereof.

The third section of the Act incorporating the defendants provides, that "all persons who shall hereinafter insure with the said corporation, and also their heirs, executors, administrators and assigns, continuing to be insured in said corporation, as hereinafter provided, shall thereby become members

Hamilton v. The Mutual Life Insurance Company of New York.

thereof, during the period they shall remain insured by said corporation, and no longer." The thirteenth section of the same Act provides, that "any member of the company who would be entitled to share in the profits, who shall have omitted to pay any premium, or any periodical payment, due from him to the company, may be prohibited by the trustees from sharing in the profits of the company, and all such previous payments made by him shall go to the benefit of the company." On the 22d of February, 1848, a resolution was adopted by the board of trustees of the company, providing, "that any member of the company who would be entitled to share in the profits, who shall have omitted to pay any premium or periodical payment due from him to the company, shall not share in the profits of the company, and all previous payments made by him or her shall enure to the benefit of the company."

The principle of law on which the defendants contend that the war terminated the existence of the policy, is the familiar one, that an executory contract of continuing performance, made before the breaking out of a war, with an alien enemy, if it cannot be performed except in the way of commercial intercourse with the enemy, is, *ipso facto*, dissolved by the declaration of war, which operates, for that purpose, with a force equivalent to that of an Act of Congress. (*The William Bagaley*, 5 Wallace, 377, 407; *Hanger v. Abbott*, 6 Wallace, 532, 536; *Esposito v. Bowden*, 4 Ellis & Blackburn, 963, and 7 *Id.*, 763; *Reid v. Hoskins*, 4 Ellis & Blackburn, 979.) Assuming that Goodman could not pay the annual premiums on the policy without commercial intercourse with the defendants at New York, he being a resident citizen of Alabama, the argument is, that the policy was executory; that the vital principle of the contract is the payment of the annual premium by Goodman, and the sequent liability of the company to pay the amount insured, in case of the death of Goodman during the period covered by the payment of premium; that the continued existence of the policy depended on the punctual payment of the premium, every year, by Goodman; that, by the express terms of the policy, the

Hamilton v. The Mutual Life Insurance Company of New York.

non-payment of the premium relieved the defendants from liability; that, in this respect, the contract was executory, and its continued existence absolutely demanded continued intercourse and dealings between the parties; and that the contract is, therefore, brought within the very definition of the authorities, as an executory contract, of continuing performance.

Where a contract is of such a character that its continued existence is not dependent upon any further intercourse between the parties, the only effect of the war is to suspend its operation, and, on the return of peace, the rights of the parties under it may be enforced. In the case of *Manhattan Life Ins. Co. v. Warwick*, (20 *Grattan*, 614,) in March, 1871, the Court of Appeals of Virginia, by a majority of three judges against two, held, that a policy of life insurance, in a like situation with the one at bar, in the particulars involved in the question now under consideration, was suspended, but not dissolved, during the continuance of the late civil war. The view taken by the majority of the Court was, that the contract was altogether executory on the part of the company, in the sense that they had done nothing yet towards the performance of it on their part; that it had, however, been largely executed on the part of the assured, creating a right which could be defeated only by a default on his part; that this right was a right to the insurance, not merely for one year, but for the life of the assured; that a new contract every year was not necessary to give the right, but only the annual payment of the premium was necessary to prevent the divesting of the right; that the principle, that war dissolves the contract, had not been applied in a single instance to a contract made before the war, and executed by one of the parties, in part, before the war, and where the execution of the contract on his part was to be completed before he was entitled to any performance by the other party, or where the dissolution of a contract made before the war would work a forfeiture; that such an application of the rule would be arbitrary, unreasonable and immoral; that, when the contract

Hamilton v. The Mutual Life Insurance Company of New York.

is made before the war, but not executed by either party, and the carrying it into execution will involve a violation of the duty of the parties respectively to their countries, in the new relations which the war has created, in that case, its execution not having been entered upon, and it being uncertain how long the war may last, and prevent the execution of the contract, it may be dissolved, and this not to the prejudice of the parties, or either of them, but for their presumed convenience and benefit, to be absolved from the obligation of a contract, which, in the changed relations of their countries, cannot be carried into execution; that, on the other hand, if the contract is partly executed, and rights under it have vested, and it cannot be dissolved without loss or forfeiture to one of the parties, and it cannot be carried into execution consistently with the duty of the parties to their countries respectively, while the war lasts, in such case, it should not be dissolved, but only suspended; and that, if it can be carried into execution, notwithstanding the war, without conflicting with the obligation of allegiance of either party, it will be neither dissolved nor suspended.

In respect to a policy of life insurance in like situation, the Court of Appeals of Kentucky, in the case of *New York Life Ins. Co. v. Clopton*, (7 Bush, 179,) in August, 1870, adopted the view, that the policy of the law does not avoid, because of the intervention of war, a pre-existing valid contract, which a single act, such as the payment of a debt, can perform; that, in such cases, a suspension of remedy during the war is the only effect of the war; that both principle and policy dissolve a contract made before the war for continuing performance, such as partnership, or affreightment; that the policy of interdicting the payment of a debt is, that it may aid the enemy in the prosecution of hostilities; that, consequently, suspension of performance until the restoration of peace, effectuates the whole aim of the law, without dissolving the contract, which may be ultimately enforced in perfect consistency with the principle of the temporary interdict; that, in that class of cases, it is the contract, and not the per-

Hamilton v. The Mutual Life Insurance Company of New York.

formance, that is continuing, and a suspension of the remedy, and not a dissolution of the contract, is all that is necessary, befitting or just; that, in such cases as partnership and affreightment, the performance is continuous and unremitting, until the end of the contract shall have been consummated; that, therefore, as supervening war between the parties disables them from performing any of the incumbent duties, and defeats the object, of the contract, a dissolution of the contract is the natural and legal effect of the war; that the reason for dissolution in these two classes of cases is inapplicable to contracts which may be performed by a single act, or by periodical acts, between which there is nothing to perform, and, consequently, no continuity of performance; that, between a single act and such periodical acts, there is no apparent difference, in reason or principle; that, therefore, the law, which only suspends the remedy in the one case, cannot consistently dissolve the contract in the other; that, according to this definition, the ordinary contract of insurance does not seem to belong to the class of contracts of continuing performance, so as to be dissoluble because of an intervening war; that, in the case then before the Court, the insurance was an executed entirety for the prescribed term, and the only performance which could devolve on the insurer was to pay the stipulated amount, in the event of loss insured against, fulfilment of which was not a continuing act, but a single act of a continuing contract; that the consideration, though payable in annual instalments, was, also, an entirety, and full performance was not of the kind technically styled continuing; and that, consequently, the war did not dissolve the contract on any such ground as that on which it would have dissolved a contract of partnership or affreightment.

I have dwelt somewhat at length on the views taken by the Virginia and Kentucky Courts, in the cases referred to, because they are the only cases on the question of the effect of the late war in respect to the dissolution or non-dissolution of a contract of life insurance, where it is assumed that the payment of the annual premiums required intercourse with

Hamilton v. The Mutual Life Insurance Company of New York.

the enemy, which have met my notice. I have no hesitation in saying, that I concur fully in the conclusions of those Courts on the question, and in the views, above set forth, on which those conclusions are founded. Even if the policy be regarded, for the purposes of this question, as containing a contract on the part of the assured to pay the annual premiums, though a contract not enforceable by a suit to be brought by the insurer, but enforceable only through the pressure of the stipulation for forfeiture in case of the non-payment of such premiums at the specified times, and even though, to pay such premiums, requires intercourse with the enemy, yet the case is one where a suspension of performance on the part of the assured will effectuate, as respects the belligerent governments, the whole aim of the law, without dissolving the contract. As regards the obligation of the insurer, the contract was not one at all of continuing performance, although it was a continuing contract. All that the insurer had to do under it was to pay the sum insured, in case a loss insured against should occur, and the annual premiums had been duly paid, and the proper proofs of such loss were furnished.

There would seem to be no principle on which it could be held, that, in this case, the war dissolved and abrogated this policy, which would not require the Court to hold equally, that the policy would have been abrogated by the war, if Goodman had died after the 16th of August, 1861, and before the 2d of March, 1862.. In such case, Goodman having been alive on the 16th of August, 1861, the Court would be asked to hold that the rights of the parties were to be determined according to their *status* at the time the proclamation of that date was issued, and that, although Goodman had punctually paid all previously accruing premiums, and had died without making default, yet, the contract being one contracting for continuing performance by him in paying premiums annually, it was abrogated by the war on the 16th of August, 1861, so that the insurer was released from liability on it. A decision to that effect would shock every sense of justice. Yet it can make no difference that Goodman did not happen to die be-

fore the 2d of March, 1862. If the principle is to be applied to this policy at all, it must be applied as of the 16th of August, 1861. If it is not applied as of that date, it cannot be applied as of any other date. Its applicability cannot be made to depend on the question whether, in fact, Goodman survived, after the 16th of August, 1861, until after it became necessary for him to do an act of performance under the contract.

There is another suggestion which seems to me of great force. In all the cases, so far as I have observed, where the doctrine of abrogation has been applied to a contract of continuing performance, requiring, for such performance, intercourse with the enemy, the question arose on ground taken by the defendant in the suit, when sued for the breach of, or to enforce, some stipulation of the contract, which could be enforced against him by suit, that he was absolved from such stipulation by the dissolution of the contract through the operation of a war. The present case is not such a one. The defendants cannot, in respect of their obligation under the policy, set up, as a defence against the payment of the sum insured, the dissolution of such obligation by the war, any more than the maker of a promissory note, given before the war, could set up, after the end of the war, that his obligation to pay the note was abrogated by the war. In respect of the stipulation in regard to the payment of annual premiums, this is not a suit to enforce such stipulation or any liability under it, and the party who was, by the contract, to make such payments, does not set up, as a defence against an obligation to make them, a dissolution of the contract by the war.

It is further insisted, on the part of the defendants, that, if it is unlawful to insure the property of an alien enemy, it is, *a fortiori*, unlawful to insure the life of an alien enemy; that such an insurance could not lawfully be made during the existence of a war; that the acceptance of a renewal premium is virtually a new insurance, the obligation of the insurer lasting only for the period for which the premium is paid; that it matters not whether the alien enemy bears arms in

Hamilton v. The Mutual Life Insurance Company of New York.

the contest, or is merely a member of the hostile community ; that the insurance of the life of an alien enemy gives aid and comfort to the enemy ; and that, if it were to be held that the life of the plaintiff's testator, and the lives of many others similarly situated, continued to be insured after the breaking out of the war, under policies made before it broke out, then, if the persons insured had died during the war, the amounts or values of the policies would have been property capable of being used by the enemy of the United States in aid of the war against it, because certain to be realized and made available after the termination of the war.

It is not to be conceded, that, under the policy in this case, the acceptance of a renewal premium would have been a new insurance. But, an examination of the cases and text books on the subject of the dissolution by war of contracts of insurance made before the war, shows, that the principle on which the rule rests does not extend to avoiding policies insuring property which is exempted by the laws of war from liability to be seized by the Government of the insurer's country. While the rule would avoid a policy insuring the life of one who should become an actual and active enemy of such Government, it thus acquiring the right to destroy his life, it would not affect the validity of an insurance on the life of a neutral, passive, non-combatant enemy, who remained such in fact, and over whose life there is no belligerent power, on the part of the Government of the insurer. Though, by his domicile, he is a technical enemy, so that his property may be lawfully captured as enemy property, yet, as such nominal hostility does not subject his life, like his property, to peril, no belligerent right is affected by continuing the validity of the insurance. "Consequently, in such a case," as is said in *New York Life Ins. Co. v. Clopton*, (*before cited*.) "neither authority nor principle would avoid the policy, any more than if it had insured the life of a child in the cradle, or insured property exempt from capture or confiscation." Nor is it perceived how the amount or value of a policy on the life of an alien enemy who dies during the war, can be availed of,

Hamilton v. The Mutual Life Insurance Company of New York.

to aid the war, by the Government of the country of the assured, in any way or to any extent in or to which the amount or value of a promissory note made before the war, and falling due during the war, cannot be availed of, to aid the war, by the Government of the country of its holder, while its maker continues to be an alien enemy. Yet it was never heard that the obligation to pay a note was, under such circumstances, or for such reasons, abrogated by a war.

The bill alleges that Goodman was not concerned, directly or indirectly, in bringing on the insurrection and rebellion mentioned in the bill; and that he did not bear arms against the United States during the continuance of such insurrection and rebellion, nor in any way, directly or indirectly, aid or abet the enemies of the United States. The evidence is, that Goodman did not favor secession as a measure of redress for alleged wrongs; that he did not bear arms against the United States; that he was enrolled among the citizens of Mobile for home defence, but was not called into service; that he paid the taxes and assessments which were levied upon him and his property by the power which ruled the State of Alabama; that he contributed to the relief of sick and wounded soldiers, and of the families of absent soldiers; that he held no office, during the war, under any Government; that he was over the age for field service in the army, or was otherwise exempted from such service, and was not conscripted, and furnished no substitute for the army; and that he pursued the occupations of civil life during the war. On these facts, it cannot be held that any rule of law requires that the policy on the life of Goodman should be regarded as having been dissolved and abrogated by the war.

I have assumed, in the discussion hitherto, that Goodman could not, after the 16th of August, 1861, have paid to the defendants the annual premiums which accrued before the 22d of May, 1865, without direct intercourse with them. The fact is so. The bill alleges that Goodman failed to pay such premiums on or after the 2d of March, 1862, "because the agency of the said McCoy, as the said Goodman was informed

Hamilton v. The Mutual Life Insurance Company of New York.

and believed, had been theretofore revoked, and no one else had been substituted as such agent in his place and stead." The answer alleges, that the appointment of McCoy, as the agent of the defendants at Mobile, in and for the State of Alabama, was revoked by the defendants on or about the 26th of March, 1861, and Goodman had notice thereof, and since that time the defendants have not had any agent in and for the State of Alabama. The statements of the bill and the evidence show that these allegations of the answer are true, and that the defendants had no agent in Alabama from March, 1861, up to January, 1869. In the absence, therefore, of any agent of the defendants in Alabama, it was impossible for Goodman to pay his annual premiums without direct intercourse with the defendants at New York.

The defence is also set up, that, the policy, by its terms, ceased to exist by reason of the non-payment of the annual premium that was due and payable on the 2d of March, 1862, and that thereby, also, all previous payments made by Goodman became forfeited to the defendants. It is replied, on the part of the plaintiff, to this defence, that the defendants, by the act of withdrawing all their agencies from the State of Alabama in March, 1861, prevented the payment by Goodman of his annual premiums, and thereby waived such payments, all of which became due after the 16th of August, 1861, the act of the defendants having prevented the payments in Alabama, and the effect of the war being to make such payments at New York, by Goodman, unlawful.

If it was a part of the contract entered into by the defendants, or of their obligations to Goodman under it, that Goodman should have the right to pay his annual premiums to an agent of the defendants in Alabama, and if the defendants were bound to provide in Alabama, during the continuance of the risk on the policy, an agent to receive such premiums then Goodman was not bound to seek any other recipient of such payments than such agent, and was not bound, for want of any such agent, to pay the premiums directly to the defendants at New York. In the application made in Febru-

Hamilton v. The Mutual Life Insurance Company of New York.

ary, 1849, for the policy issued to Mrs. Goodman in March, 1849, Goodman is described as residing in Mobile, Alabama, and as being a wharfinger there. In his application of March, 1858, for the policy of 1858, and in that policy, he is described as of Mobile, in the State of Alabama. All the premiums that he paid were, with the knowledge of the defendants, paid at Mobile, to McCoy, their agent there, and were received by the defendants through and from McCoy. Goodman resided in Mobile from 1835 up to his death, and died at Mobile. In the absence of any notice to the contrary, the defendants must be held to have continued to understand that he continued to reside in Mobile. His application for the policy of 1858 was made through McCoy, at Mobile, the policy was delivered to him through the hands of McCoy, at Mobile, and bears McCoy's signature, as agent at Mobile, the three payments of premiums in 1859, 1860 and 1861, were made through McCoy, at Mobile, and the receipts therefor bear the signature of McCoy as the defendants' agent. The policy contains on its face the words: "Agents of the company are authorized to receive premiums when due, but not to make, alter, or discharge contracts, or waive forfeitures." It is contended by the defendants that there was no obligation on them to keep an agent at Mobile or in Alabama. Considering the character of the contract, the circumstances under which it was entered into, the fact that Goodman was, with the knowledge of the defendants, a resident citizen of Alabama at all times, the fact that the contract must be regarded as having been entered into, and continued in operation by the defendants, at least as long as they themselves recognized its continuance, that is, until March 2d, 1862, with reference to, and in subordination, on their part, to such statute law of the State of Alabama as should be enacted on the subject of their keeping agents in that State, and the fact that the agency of McCoy, having been continued during the life of the policy up to March, 1861, was then withdrawn, it must, I think, be held, that the defendants were bound to keep in Alabama an agent to whom Goodman could pay his

Hamilton v. The Mutual Life Insurance Company of New York.

annual premiums, or could, at least, offer or tender payment, such agent to be appointed in conformity with such statute law, and that, if the absence of such agent was all that prevented the payment of such premiums by Goodman, the defendants are estopped from setting up the non-payment of such premiums at the times stipulated therefor as a defence to this suit.

The Alabama statute on the subject of foreign insurance companies, enacted February 24th, 1860, is in evidence in this case. Its provisions are applied, (§ 1190,) to life insurance companies not incorporated by the laws of the State of Alabama, whether such companies are or are not organized on the mutual plan. It provides, (§ 1180,) that no agent of any such company shall take any risk or transact any business of insurance in Alabama, without first procuring a certificate of authority from the comptroller of the State; that, before obtaining such certificate, such agent must furnish to the comptroller a sworn statement showing the name and locality of the company, the amount of its capital stock, the amount of capital stock paid in, and the act incorporating it, and an instrument authorizing such agent to acknowledge service of process for and in behalf of the company, and consenting that service on such agent shall be taken to be service on the company; that no company incorporated by any other State, or any agent of it, shall transact any business of insurance, unless the company is possessed of at least \$100,000 of actual capital invested in stock of at least par value, or in bond and mortgage on real estate worth double the amount for which the same is mortgaged; and that, on a compliance with these provisions, the comptroller shall issue a certificate thereof, with the authority to transact the business of insurance, to the agent applying for the same. It also provides, (§ 1182,) that the agent, before taking any risks or transacting any business of insurance in the State, shall file in the office of the Judge of Probate of the county in which he may desire to establish an agency for the company, copies of the statement and instrument aforesaid. It also provides (§ 1183) for the renewal

Hamilton v. The Mutual Life Insurance Company of New York.

annually of these proceedings. It also provides, (§ 1185,) that every agent must annually deposit with the assessor of the county in which the agency is established, a sworn statement of the gross premiums received for insurance by the company at the agency during the preceding year. It also provides, (§ 1186,) that such agent, before taking any risk or transacting any business of insurance, must pay certain local fees annually so long as the agency is continued. It also imposes (§ 1188) a penalty of fine and imprisonment for the violation of the provisions of the law. It also provides, (§ 1191,) that the provisions of the law shall apply when the risk is taken or any insurance business is transacted in Alabama by the agent of any company, whether the policies are signed by the officers of the company in or out of Alabama.

There can be no doubt that the passage of such a statute as this, was within the competence of Alabama. That State had a right to impose such terms and conditions as it chose, in granting its assent to the recognition of the defendants in Alabama, and of their rights under policies to be issued in Alabama to citizens and residents of Alabama, and to exact, in its discretion, such security as it thought proper, for the performance of the contracts of the defendants under such policies. It also had a like right to regulate the business of agencies of the defendants in Alabama, with reference to future payments to become due on existing policies issued in Alabama to citizens and residents of Alabama. (*Paul v. Virginia*, 8 *Wallace*, 168, 181). The policy in question was in fact issued in Alabama by the defendants, to a citizen and resident of Alabama, although it professes to have been delivered as well as signed by the president and secretary of the company. The receipt, by McCoy, of the premium paid at Mobile March 2d, 1861, such premium having been received by McCoy as agent, under the authority to that effect on the face of the policy, made the contract of insurance, as respected the period to elapse before March 2d, 1862, (even if, as contended by the defendants, such payment of premium created a new contract of insurance for a year,) an Alabama

Hamilton v. The Mutual Life Insurance Company of New York.

contract, to be governed by the statute law of Alabama. Such receipt of such premium by McCoy was ratified by the defendants. I think the proper construction of the policy, as such policy stood when the payment to be made March 2d, 1862, became due, is, that, inasmuch as Goodman was then living, and the obligation of the defendants under the policy was outstanding, the defendants were bound to furnish Goodman with an opportunity, on the 2d of March, 1862, and on every recurrence of the day of annual payment, to pay the premium to an agent of theirs in Alabama. As such payment to the agent would have been the transaction of insurance business in Alabama, the statute of that State required that the agency should conform to the statute. The defendants were bound to be ready to receive performance of the contract by Goodman through an agent in Alabama, such agent to be appointed in accordance with the Alabama statute. McCoy's agency in this case existed after that statute was passed. Such agency was withdrawn in March, 1861. Having been created before the war, it would not have been revoked by the war, at least so far as the right to receive payments of annual premiums was concerned. Payment of the premiums by Goodman to the agent would not have violated any law of war or any duty of Goodman's. (*Ward v. Smith*, 7 Wallace, 447, 453; *Conn v. Penn*, 1 Peters' C. C. R., 496, 524, 525; *United States v. Grossmayer*, 9 Wallace, 72, 75.)

The evidence shows pecuniary ability and willingness on the part of Goodman to pay the premiums at Mobile, and that the reason why he did not pay them there was the absence of any agent there of the defendants. I see no legal objection to the evidence on this subject, either as competent, or as sufficient to prove the facts. If the defendants were entitled to the punctual payment of the premiums, as a condition precedent to their continuing liability from year to year, their prevention of such payment, by the withdrawal of McCoy's agency, and of all other agencies in Alabama, excused Goodman from making the payments punctually, and debars the

Hamilton v. The Mutual Life Insurance Company of New York.

defendants from setting up such want of punctuality as a defence in this suit. (*Williams v. Bank of the United States*, 2 *Peters*, 94, 102; *Van Buren v. Digges*, 11 *Howard*, 461, 479.)

There is no force in the objection, that the defendants could not, during the war, have received from their agent in Alabama any moneys paid to him there as premiums, or that such moneys would have been confiscated in the hands of such agent, if paid to him. If the agent had been provided, Goodman could have tendered the premium, and the agent could have refused to receive it, because he could not remit it, and because it would be confiscated. The rights of Goodman would thus have been preserved, according to the tenor of the contract. The loss, if any, which would have ensued to the defendants, was a loss incident to the war, and with which Goodman had no concern, and the apprehension or certainty of which could not affect his rights. The unlawfulness of any receipt by the defendants at New York, from Goodman, or any other person in Alabama, during the war, of any moneys paid as premiums, cannot affect any rights of Goodman in respect of having the opportunity of paying such premiums in Alabama, or be set up by the defendants as a ground of forfeiture of the policy in respect of such rights.

Under these views, the contract was only suspended during the war. After the end of the war, the right of Goodman to pay the premiums which he had been prevented from paying by the action of the defendants, continued, in all respects, as if the 2d of March, 1862, had not passed. Within a reasonable time after the close of the war, that is, in January or February, 1866, and before the coming around of any 2d of March after the close of the war, an application on behalf of Goodman was made to the defendants at New York, requesting them to recognize the policy, on terms to be arranged. The reply of the defendants was, that they did not recognize the policy as valid, because it had been forfeited by the non-payment of premiums, and they refused to receive payment of the premiums in arrear. What thus transpired

Hamilton v. The Mutual Life Insurance Company of New York.

made it unnecessary for Goodman to tender the premium due March 2d, 1866. In December, 1867, after Goodman's death, an agent of the plaintiff presented to the defendants his claim on the policy, and tendered to them proofs of Goodman's death, and offered to pay any premiums that were in arrear. The reply of the defendants was, that the policy was forfeited, and they would recognize no liability upon it, and would not receive any premiums, or pay any loss upon it, but that they would, as a gratuity, pay what was the surrender value of the policy on the 2d of March, 1862.

The withdrawal of the agency of McCoy, and of the other agencies in Alabama, made it unnecessary for Goodman to seek out McCoy or some other person who had been an agent of the defendants in Alabama, and tender the premiums, as due, to him, even though, as would appear from the evidence, McCoy remained in Alabama, accessible, during a part, at least, of the war. Especially is this so, in view of the fact that Goodman had notice of the revocation of McCoy's agency.

On all these considerations, I am of opinion that the defendants must be regarded as having prevented Goodman from paying his premiums, as due, in Alabama, where he had a right by the contract to pay them, and, therefore, as having waived such punctual payment; that the policy was not and is not forfeited by reason of the non-payment of premiums; that it is a valid and subsisting policy against the defendants; and that the plaintiff was, when he brought this suit, in a position to ask the relief prayed for by the bill.

These views recognize fully all the terms of the policy, and do not interpolate in the contract of the parties any provision, by way of excuse for the non-payment, on the stipulated day, of any premium, which is not within the terms of the contract. It is of the essence of every contract, that, if one party to it prevents its performance by the other party, the former cannot be allowed to reap any benefit from the fact of such non-performance. In this case, the prevention by the defendants of performance by Goodman was equivalent

to actual performance by Goodman, or to a waiver by the defendants of such performance.

But, it is urged by the defendants, that Goodman could have paid his premiums at New York; that, if he elected to remain in Alabama, where he could not or would not make payment of the premiums, it was his own fault; and that the existence of the war and the prohibition of commercial intercourse between the State of Alabama and the city of New York furnishes no legal excuse for the non-compliance by Goodman with his agreement to pay the premiums on the designated days. Yet, the defendants insist, in the answer, that it was unlawful for them, between August 16th, 1861, and May 22d, 1865, to receive from Goodman any premium on the policy; and, on the argument, their counsel insisted, that, if Goodman had, after the 16th of August, 1861, offered to pay the premiums, as they fell due, it would have been unlawful for the defendants to receive such premiums. It was further insisted, that, notwithstanding this, the policy terminated because of such non-payment, for the reason that the intervention of the war, as an excuse for non-payment, was not provided for by the policy. But these arguments are without avail to support the defendants' case. Their inability to receive the premiums, when due, in 1862, 1863, 1864 and 1865, amounted to the same thing as if such premiums had been actually tendered, and the defendants had refused to receive them. Such inability to receive was a dispensing by the defendants with the punctual payment of the premiums, and with their payment during the continuance of such inability, even if such payment be, under the terms of the policy, regarded as a condition precedent to the existence of the risk. Such inability was a default on the part of the defendants, preventing Goodman, a citizen and resident of Alabama, from paying the premiums to the defendants at New York, and, therefore, dispensing with the payment of them, as performance by Goodman. The case is not one where the excuse set up is merely inability or impossibility of performance on the part of him who is to perform. It is

Hamilton v. The Mutual Life Insurance Company of New York.

one where inability on the part of the party to whom performance was due, to receive such performance—an inability notorious and known to the party owing performance—existed, and is set up by the party to whom performance was due, as a ground for forfeiting the rights of the other party under the contract, because he did not pay what it was impossible and unlawful for his obligee to receive. The cases in the books, which were cited on the part of the defendants, as enforcing strictly the rule that a precedent condition on which, by contract, money is to be paid, must be absolutely complied with, were cases in which the impediment to performance existed solely on the part of him who was to be the actor in performance, and were not cases in which the impediment existed either solely on the part of him who was to be the recipient of performance, or was an impediment affecting both parties jointly, and equally in extent. The distinction is a sound one; and it would be gross injustice to apply to this case a rule the reason of which has no application to it. The defendants, in effect, say to Goodman: "It was unlawful for us to receive from you your premiums for 1862, 1863, 1864, and 1865, as they became due; it would have been idle for you to have tendered them to us; yet, as the contract was that you should pay them at specified times, and you did not pay or tender them at those times, the contract is forfeited, our liability to pay you the \$5,983 05 is at an end, and, besides that, the \$2,307 50 paid to us as premiums on the policies of 1849 and 1858 is forfeited to us." I do not believe a defence of that kind to a policy of life insurance situated like the present one, was ever allowed by any Court of justice in any civilized community. I certainly shall not be the first judge to set a precedent of the kind. Indeed, it has often been held, that the intervention of the law will excuse non-performance of a contract, where the operation of the intervention was solely on the party who was to perform, and not at all on the party who was to receive performance. (*Wolfe v. Howes*, 20 *New York*, 197, 201; *Jones v. Judd*, 4 *Comstock*, 411, 413; *The People v. Tibbs*, 37 *New York*, 586, 588.)

Hamilton v. The Mutual Life Insurance Company of New York.

The views I have endeavored to maintain are concisely stated by the Court in *Manhattan Life Ins. Co. v. Warwick*, (*before cited*). In speaking of the obligation of the insurer, under the policy, to pay the sum insured, the Court say: "The company could not relieve itself from this obligation, or subject the other party to a forfeiture, by refusing to receive payment of a premium, or by hindering or preventing the other party from paying it, or by any disability on its part to receive it, and which prevented the payment, which was not provided for in the contract." In the present case, the defendants are setting up their own disability to receive payment, as a ground of forfeiture. In *New York Life Ins. Co. v. Clopton*, (*before cited*), the Court say: "To subject to forfeiture all the premiums paid, as well as the five thousand dollars for the loss of life, would be harshly and unreasonably penal, for no better cause than the inevitable non-precise payment of another instalment of premium, which the law prevented the appellant from a right to receive. None of the parties can be presumed to have contemplated such disabling war, or to have intended, by the condition of avoidance, more than voluntary failure to pay, when there was legal ability to receive the premiums."

There was, therefore, no forfeiture in this case. Goodman continued to be insured in the defendants' company until his death, and was a member of the company at the time of his death. He was entitled, under the policy, at the time of his death, to all the rights, in respect of the sums insured by the policy, and of all proper increase of such sums insured, as the result of dividends made to members, up to the time of his death, which he could have been entitled to, if the defendants had received and accepted all the annual premiums specified in the policy. The resolution of February 22d, 1848, cannot be interpreted as applying, or having been intended to apply, to a case like the present one. Goodman did not "omit" to pay any premium, in the proper sense of that word. His failure to pay was wholly inactive and involuntary, and was no default on his part, but was,

Hamilton v. The Mutual Life Insurance Company of New York.

as between him and the defendants, the default of the defendants.

Nor is there any force in the view, that, Goodman being a partner with the other persons insured in the defendants' company, the partnership was dissolved by the war. The relation between him and such other persons, assuming that they were domiciled in New York during the war, because the company is a New York corporation, was not such a relation of partnership as requires the application to it of the rule that a war dissolves a contract of commercial partnership between enemies. The views before stated in regard to the effect of the war on the policy, as a contract between enemies, apply to it equally in its aspect as a policy issued by a company doing business on the mutual plan. The relations of Goodman to the partnership and to his partners, and his duty to it and them, as a member, were created and are to be measured wholly by the terms of the policy, and no different rule can be applied to the policy, because it was issued by a mutual company, than would have been applied to it if it had been issued by a company of which the insured did not, by the insurance, become a member.

I have carefully considered all the views urged by the defendants, and am entirely satisfied that the plaintiff is entitled to a decree, with costs. There must be a reference to a master to take and state an account of the amount due on the policy, with interest, such amount to be computed on the basis before stated, and the defendants to be allowed credit for the unpaid annual premiums.

Charles F. Sanford, for the plaintiff.

Henry E. Davies, for the defendants.

Doughty v. Day.

SAMUEL H. DOUGHTY

vs.

THEODORE D. DAY AND GILBERT HORTON. IN EQUITY.

●
The letters patent granted to L. A. Osborn and I. J. Vincent, as assignees of Robert J. Mann, the inventor, June 22d, 1858, for an "improvement in skirt hoops," are valid, so far as the second claim is concerned, namely, "Securing the hoop, *d*, to the perpendicular straps, by means of small clamps, constructed as herein described."

Although the specification states that the nature of the improvement which is the subject-matter of the second claim consists in the peculiar manner of fastening the hoops "to the perpendicular straps by means of a small clamp, the said clamp being made with teeth, or otherwise," yet, taking the drawings and the description together, no one would, from them, use clamps without teeth, to fasten the hoops to the perpendicular straps.

Increasing the number of teeth, and adding another feature to the clamp, while it still has teeth which, after passing through the strap, are clinched, and embrace the hoop, is, nevertheless, an infringement of the said second claim.

(Before BLATCHFORD, J., Southern District of New York, December 26th, 1871.)

BLATCHFORD, J. This suit is brought on letters patent granted to L. A. Osborn and I. J. Vincent, as assignees of Robert J. Mann, the inventor, June 22d, 1858, for an "improvement in skirt hoops." The plaintiff is the owner of the patent, by assignment, for all of the United States, except the State of Rhode Island.

Only the second claim of the patent is involved in this suit, there being three claims in all. In regard to the subject-matter of the second claim, the specification says, that the nature of the improvement consists in the peculiar manner of fastening the hoops of ladies' skirts "to the perpendicular straps, by means of a small clamp, the said clamp being made with teeth, or otherwise." It also says, that, having made fast the perpendicular straps to the waistband, by means of eyelets or sewing, and the hoops being stretched over a frame

Doughty v. Day.

similar in shape to the skirt, when the straps and waistband are put on the frame, the straps being brought down over the hoops, it is only necessary to press the teeth of the clamp through the strap, and clinch the same on the inside, to secure the hoop firmly in its place; and that, by this manner of fastening the hoop, half the time is saved that would be occupied in sewing the hoops to the straps. There are nine figures of drawings. Figure 2 is a perspective view of a section of the hoop, *d*, and perpendicular supporting strap, *b*, and also showing the manner in which the said hoop is made fast to the strap, *b*. That manner, as the specification states, and as is shown in figure 3 of the drawings, is by means of a clamp with teeth, which pass through the strap, and are clinched on the inside, so as to embrace the hoop. The second claim is in these words: "Securing the hoop, *d*, to the perpendicular straps, by means of small clamps, constructed as herein described."

Criticism is made by the defendants on the fact that the specification, in stating the nature of the improvement, says, that the clamp which fastens the hoops to the perpendicular straps, is to be made with teeth, or otherwise; and that it is impossible to so fasten them unless the clamps have teeth. But, the drawings and description must all be taken together, and, so viewing them, it is apparent that no person would or could, from them, use clamps without teeth to fasten the hoops to the perpendicular straps. A clamp is shown without teeth, also one with teeth on one side of it, and another with teeth on both sides of it. The clamp with teeth on one side of it is manifestly for use on the lower hoop of the skirt, where the perpendicular straps terminate, and where teeth are necessary only on the upper side of that hoop, there being no strap below that hoop for any teeth to penetrate. The clamp with teeth on both sides of it is for use at the junction of the other hoops with the straps, where the straps extend both above and below the hoop. The clamp without teeth is stated to be for the purpose of fastening extra hoops to the two upper circular hoops on the back of the skirt, so as to

form a corrugated bustle. There is no difficulty in construing the second claim in accordance with what appears to have been the actual invention, that is, securing the hoops to the perpendicular straps, by means of small clamps, constructed with teeth on both sides or on one side, accordingly as the clamps are used on the lower hoop or on the other hoops, as shown in the description and drawings, the teeth passing through the strap and being clinched on the inside so as to embrace the hoop.

The drawings of the plaintiff's patent show clamps which, where the teeth are on each side, have two teeth on each side, and, where the teeth are on only one side, have three teeth on that side. The defendants, in their clamps, have increased the number of teeth to four on each side, where there are teeth on each side, and to four where there are teeth on only one side. The teeth, after passing through the strap, are clinched and embrace the hoop. The clamps also have projections above and below, at each end of their length, which are clinched around the hoop, without passing, as teeth, through the strap. There can be no doubt that this arrangement is an infringement of the second claim of the plaintiff's patent. Increasing the number of teeth which pass through the strap, and are clinched, does not avoid infringement, nor does the addition of the clinched projections avoid it. The use of teeth on the clamp, passing through the strap, and clinched around the hoop, is the essence of the invention, the teeth, when they pass through the strap, being at right angles to the plate of the clamp, and being, when clinched to their final position, in a plane parallel with such plate. The words, "constructed as herein described," in the claim, mean, arranged as described when in final position, securing the hoop to the strap.

In this view, the letters patent to David Holmes, granted June 15th, 1858, and the letters patent to Thomas Wallace, Jr., granted June 15th, 1858, contain nothing in conflict with the invention of Mann, even if the inventions shown in those patents antedated Mann's invention. The patent to Holmes shows a clamp which has no teeth penetrating the strap and

Doughty v. Day.

then clinched around the hoop. The patent to Wallace shows a clamp which, before it is applied, is, in substance, the same in shape and construction as the defendants' clamp, except as to the size and number of the teeth. But, the specification of the patent describes the projections, above and below, at each end of the length of the clamp, as bent over the hoop outside of the tape or strap, on each side of its width, and closed tightly on the hoop, and securing the clamp firmly to the hoop, while the teeth, penetrating the tape or strap, secure the latter. The teeth, although they penetrate the tape, are not clinched around the hoop. The specification states, that the space in the length of the clamp occupied by the teeth is equal to the width of the tape forming the strap, and that the teeth are sharp, and that the part of the plate of the clamp from which the teeth project is of a width a little greater than the width of the hoop, and that the projections at the ends and the teeth are turned up at right angles to the face of the clamp, so as to leave a space of a width to receive the hoop. The drawings show three views of the teeth, two of which show twelve teeth on each side, and the other shows sixteen teeth on each side. There is nothing in the description or drawings to indicate that the teeth were to be clinched after penetrating the tape. The smallness of the teeth, their number, their proportion in size to the size of the clinched projections, and the general arrangement of the clamp when in final position, show that no clinching of the teeth, after penetration, was intended; and it is very doubtful whether such and so many teeth as are shown could be clinched with any advantage or effect, much less with any compared with the expense and trouble, or whether the clinching of penetrating teeth on a clamp, to secure the hoop to the tape, would be suggested to any one by seeing the teeth on the clamp of Wallace. Independently of this, Wallace is not shown to antedate Mann. The specification accompanying Wallace's application for his patent is sworn to May 13th, 1858. The date of Mann's invention is carried back by the evidence to as early at least as May 1st, 1858.

Doughty v. Day.

The oral testimony as to prior inventions satisfactorily shows nothing which anticipates Mann's invention. What Joseph Thomas did was a mere experiment, which came to nothing. This is also true of all that David Holmes did, except what is contained in his patent, before considered.

As to the various clasps or clamps testified to by Antoine Schlumpf and Theodore Schmidt, as having been made, used and sold by Schmidt, neither the first form, nor the second form, if they were prior to Mann's invention, were the same thing as that invention. The first form had no teeth. The second form was like the clamp in Wallace's patent. Schlumpf says it was useless, because it cut the tapes; and, undoubtedly, Wallace's clamp was, for the same reason, useless. As to the third form testified to by Schlumpf and Schmidt, called the spangle, with one tooth on each side, the evidence does not establish with that degree of certainty which is necessary that it anticipated Mann. Independently of the material contradictions between Schlumpf and Schmidt, the evidence on the part of the defendants is preponderating to show that no skirts with spangles were made by Schmidt prior to Mann's invention. This view is strongly corroborated by the fact that the most extensive hoop-skirt dealers knew of no skirts with clamps having teeth which penetrated the tapes and were clinched around the hoops on the other side, until they saw the clamp of Mann, and that they took licenses to manufacture under the plaintiff's patent in 1859. The case is entirely free from doubt, and there must be a decree for the plaintiff, as to the second claim of the patent, for a perpetual injunction and an account of profits, with costs.

Stephen D. Law, for the plaintiff.

John B. Staples, for the defendants.

ALLSTON WILSON AND OTHERS

vs.

JOHN N. A. GRISWOLD.

W., by a charter party under seal, hired from G. a vessel, for a specified term, to be run, as a freight and passenger vessel, between New York and San Domingo, for so much per month, W. to supply, man and navigate the vessel; and G., in case of damage to her by the perils of the seas, to repair her, and no claim for charter money to be made during the time she should be unfitted for use on such route by such damage. The charter party contained no covenant that, at the time of the charter, the vessel was seaworthy. W. sued G., in covenant, averring such a covenant, and alleging a breach of it, in that the vessel was not seaworthy, so that the voyages stated in the charter party could not be commenced. G. demurred to the declaration: *Held*, that there was an implied covenant by G. that the vessel was seaworthy, or fit for the service for which she was hired, and that W. could aver such a warranty and declare on it, in covenant.

(Before WOODRUFF, J., Southern District of New York, December 30th, 1871.)

WOODRUFF, J. The plaintiffs declare upon a charter party, under seal, whereby the defendant charters to the plaintiffs, and the plaintiffs hire, the defendant's vessel, the steamer Norwich, for the term of four months from the date thereof, with the privilege to the plaintiffs of continuing the charter for an additional four months, the vessel to be run by the plaintiffs as a freight and passenger vessel, between the city of New York and a port or ports in San Domingo, at a fixed compensation of \$1,500 per month, payable, \$750 at the beginning, and \$750 at the end, of each month, the plaintiffs to coal, victual, officer, man and navigate the vessel, with covenants by the plaintiffs against negligence or mismanagement in the care, conduct and navigation of the vessel, and a covenant by the defendant, that, in case of damage by fire, collision, the breaking of machinery, or injury to the steamer, or other unavoidable accident, caused solely by perils of the

seas, he will repair the same without delay, "so that the said steamer may resume service under this charter, and, if the said steamer shall become unfitted by such damage for use upon the said route, no claim for charter-money shall be made for the time she shall be so unfitted for business." There are many other provisions in the instrument, but there is no express covenant or stipulation, that, at the time of the charter, the said vessel is tight, staunch, and strong, well fitted and furnished, seaworthy, and fit for the uses and purposes in the charter party stated. The pleader has, nevertheless, averred such a warranty and covenant, and alleges a breach thereof, in that she was not tight, staunch, strong, well fitted and furnished, and was not seaworthy or fit for the uses and purposes in the charter stated, but was leaky, rotten, and utterly unseaworthy, and unfit, from inherent weakness and defects, for the purposes and voyages in the charter party stated, or to go to sea at all with cargo or passengers, by reason whereof, the voyage was never commenced, but the vessel was returned to the defendant. Various items and amounts of damage are averred and claimed by the plaintiffs.

The defendant, having obtained oyer of the instrument, demurs to the declaration; and thereupon two questions have been discussed by the counsel for the respective parties: (1.) Whether, in this case, there was an implied covenant or warranty by the defendant, that the vessel was seaworthy, or was fit for the service for which she was hired, and which voyage, as one of the terms of the contract, he agreed to perform; (2.) Whether it was competent for the plaintiffs, in declaring, to aver such a warranty, if implied, or whether they should have proceeded in assumpsit, for the breach thereof.

(1.) The general rule, that, in a contract of affreightment, there is an implied covenant or undertaking by the owner of the ship, that the ship is seaworthy, is not questioned. But, it is claimed that this is only incidental to his obligation, as a common carrier, to carry the goods safely, and that, therefore, when the owner lets his ship to hire without any undertaking

either to carry goods, or to assume any duties, either in the navigation or supply of the ship, or in the conduct of the business in which she is to engage, the hirer acts at his peril, and the principle applies to him, as to a purchaser, "*caveat emptor*."

Looking to the terms of this charter, the purposes for which the ship was hired, the service prescribed to the hirers by the very terms of the instrument, and the obligation of the owner to repair, if, by perils of the sea, &c., she became unfit, every reason to infer a covenant of seaworthiness and fitness for the purpose, which can exist in any case of charter, exists in this case; and, that such was the actual intent and meaning of the parties, inferrible from the contract, seems to me to admit of no doubt.

The text writers, in declaring, as all, without exception, to which I have referred, do, that the chartering of a vessel for the transportation of goods implies an undertaking that she is seaworthy, point out no distinction between a charter wherein the owner mans, victuals and navigates the ship, and a charter wherein the charterer assumes to do this. Nor is there any sound reason for such a distinction. In case of an ordinary bailment for hire, there is an implied undertaking or warranty that the subject of the letting and hiring is without faults or defects which prevent the due enjoyment or use of the thing. (*Story on Bailments*, § 390; *Edwards on Bailments*, 311; *Sutton v. Temple*, opinion of Lord Abinger, 12 *M. & W.*, 52, 60.) And so of a letting of a furnished house, (*Smith v. Marrable*, 11 *M. & W.*, 5;) and selling a horse, (*Harrington v. Snyder*, 3 *Barb. S. C. R.*, 380.) With especial reference to the chartering of a vessel, see also, *Addison on Contracts*, p. 413; *Abbott on Shipping*, 421, 422; 1 *Parsons on Shipping*, 284, 285; 3 *Kent's Comm.*, 204, 205; *Lyon v. Mells*, (5 *East*, 428.)

(2.) As to the form of action, it is wholly immaterial whether the covenant be implied or express. If, from the specialty executed by the parties, the law implies such a covenant, it is, as respects the form of action thereon, as if it were

Miller v. O'Brien.

incorporated therein in terms. In a legal sense, the law does incorporate the covenant therein. Assumpsit would not lie, for the reason, that, whatever the parties stipulated, was by their sealed instrument. (See cases cited below.) And, although it was competent for the pleader to have set out the instrument in *totidem verbis*, and alleged thereupon the want of seaworthiness as a breach, I see no reason why he might not in this, as in ordinary cases, declare upon it according to its legal effect. (*Randall v. Lynch*, 12 *East*, 179; *Lent v. Padelford*, 10 *Mass.*, 230; *Grannis v. Clark*, 8 *Cow.*, 36; *Barney v. Keith*, 4 *Wend.*, 502.)

The plaintiffs must have judgment on the demurrer, but leave is given to the defendant to withdraw the demurrer and plead, upon the usual terms.

William R. Darling, for the plaintiffs.

Charles M. Da Costa, for the defendant.

ELIAS N. MILLER, ASSIGNEE IN BANKRUPTCY, &C.,

vs.

JAMES O'BRIEN, SHERIFF, &C.

A sheriff who, after proceedings in bankruptcy are commenced, wherein an assignee is appointed, levies an execution upon, and sells, property which was of the bankrupt, is liable to the assignee for the proceeds of such property, although he pays such proceeds to the execution creditor, before receiving actual notice of the bankruptcy.

It makes no difference, that, before the proceedings in bankruptcy were instituted, the sheriff seized, under an attachment in the suit in which the execution was afterwards issued, the property in question, and held it to be levied on in case execution should issue, or sold it by order of Court, and held its proceeds for the same purpose.

Miller v. O'Brien.

The operation of the bankruptcy Act dissolved the attachment, and the title of the assignee vested as of the time of the commencement of the proceedings in bankruptcy.

(Before WOODRUFF, J., Southern District of New York, December 30th, 1871.)

WOODRUFF, J. Reduced to its simplest form, the question raised by the demurrer herein is, whether a sheriff, who, after the proceedings are commenced in bankruptcy wherein an assignee is appointed, levies an execution upon and sells property which was of the bankrupt, is liable to the assignee, notwithstanding he pays the proceeds of sale to the creditors before he receives actual notice of the bankruptcy.

It is true, that, in the discussion of the subject on the part of the defendant, some importance was given to the circumstances, that the property had been attached by the sheriff a few days before the proceedings in bankruptcy were instituted, and, that, by order of Court, the property seized was sold as perishable, and the proceeds were held by the sheriff *in lieu* of the property, to abide the event of the suit, and to be levied upon if judgment was obtained and execution issued. But, it is quite clear, that, as between the assignee in bankruptcy and the sheriff, these circumstances are not material. The statute, in the most explicit terms, (§ 14,) declares the attachment dissolved. In like explicit terms, it declares, (§ 14,) that the assignment to the assignee shall relate back to the commencement of the proceedings in bankruptcy, and that the title to all the bankrupt's estate shall vest in the assignee. This can only mean, that the title of the assignee shall be vested with like legal effect as if the assignment had been executed at the commencement of the proceedings. The sale of the property as perishable, assuming that it was justified by the order of the State Court, had no effect except to substitute, in the hands of the sheriff, the proceeds of sale in the place of the property seized. It gave the creditor no greater right, and it in no wise enlarged the power or duty of the sheriff.

When, therefore, by operation of law, the attachment was

Miller v. O'Brien.

dissolved, the title of the assignee in bankruptcy was perfect, and the sheriff was liable to pay over the proceeds of the property to him. The sheriff had ceased to have any claim or right to withhold them. Unless, then, he is protected by the issue and levy of the execution, and the payment of the money to the execution creditors, before he was actually notified of the bankruptcy, he is still liable, and the demurrer herein must be overruled.

The question is an important one, but not because it involves any conflict between the Courts of the State and the Federal Courts. The law is the same in both Courts. The paramount law having dissolved an attachment, although valid and operative when issued, the relinquishment of the property to the assignee in whom the property was vested, is in no derogation of the authority of the State Court, but a legal duty recognized in all tribunals. And so, when an execution was issued, if the property was no longer liable to levy for the satisfaction of the judgment, it is no matter of conflict between the one Court or the other, which of them is called upon to recognize or administer the law. The question is important, however, because the construction and effect of the bankrupt Act, contended for by the plaintiff, may operate very harshly upon sheriffs and like ministerial officers, and it accords with our sense of justice to say, that they ought not to be held liable for their acts in the execution of process, done in good faith, without actual notice of any proceedings in bankruptcy against the debtor. But the same may be said of private persons dealing, in good faith, and without notice, with the debtor, pending the proceedings, an example of which was considered by Mr. Justice Sharswood, in *Mays v. The Manufacturers' Nat. Bank of Philadelphia*, (4 *Nat. Bank. Reg.*, 147.) I shall not discuss the question at length. I am wholly unable to withdraw the question, as it is presented under the bankrupt law of the United States, from the reasoning and the principles upon which the same question was settled in England, under the bankrupt law of that country. It was then settled, after full and repeated

discussion, in several cases, and finally in the House of Lords.

By operation of law, the money received by the sheriff was the money of the present plaintiff, whether the sheriff knew it or not; and in that statement lies the whole of the plaintiff's case. All the arguments founded in the duty of the sheriff to execute process, in the hardship of holding him to take the hazard of the title to property which he applies to executions in his hands, and in various other considerations, which were urged upon me with great ability on the argument, are most fully considered in the English cases to which I have referred. (*Balme v. Hutton*, 9 *Bing.*, 471; *Garland v. Carlisle*, 10 *Bing.*, 452; *S. C.*, in House of Lords, 4 *Bing. N. C.*, 7, and 4 *Clark & Fin.*, 693; and numerous cases cited and commented upon in those cases.) On principle, those cases seem to me to have been correctly decided, while it at the same time seems possible to guard against fraud in the conduct of the bankrupt and his creditors pending the proceedings, by some provision in the law which shall not necessarily operate with such hardship upon innocent parties acting in good faith.

The demurrer must be overruled, with leave to withdraw the demurrer and plead, on the usual terms.

Aaron P. Whitehead, for the plaintiff.

Edmund Randolph Robinson and *Aaron J. Vanderpoel*,
for the defendant.

Tenny v. Townsend.

DANIEL K. TENNEY

vs.

THOMAS S. TOWNSEND, IMPEADED, &c.

In an action on a judgment of the Superior Court of Chicago, Illinois, the declaration averred that that Court was a Court of general jurisdiction, duly created by the laws of Illinois, but did not aver that that Court had jurisdiction of the person of the defendant, either by service of process, appearance, or otherwise: *Held*, on demurrer, that the declaration was sufficient.

(Before WOODRUFF, J., Southern District of New York, December 30th, 1871.)

WOODRUFF, J. The action herein is debt on judgment, demanding \$539. The declaration avers, that the plaintiff is a citizen of the State of Wisconsin; that the defendant Townsend is a citizen of the State of New York; that the Superior Court of Chicago, within and for the county of Cook and State of Illinois, was, at the time in the said declaration afterward mentioned, a Court of general jurisdiction, duly created by the laws of the said State of Illinois; that, on the 23d of February, 1870, in the said Superior Court of Chicago, at * * before the justices thereof, by the consideration and judgment of said Court, the said plaintiff recovered against the said defendants the said sum of money above demanded, which, in and by the said Court, was then and there adjudged to the said plaintiff for his damages which he had sustained, as well by reason of the non-performance, by the said defendants, of certain promises and undertakings theretofore made by the said defendants to the said plaintiff, as for his costs and charges, &c., whereof the said defendants were convicted, &c.; with the usual averments, that the judgment still remains in full force and effect, not reversed, &c., &c., and that the plaintiff hath not obtained execution or satisfaction thereof, &c., whereby, &c.; with the usual formal conclusion. To this declaration the defendant Townsend has pleaded their several pleas, to which the plaintiff has demurred, assigning

Tenney v. Townsend.

special causes of demurrer. It is not necessary to state the pleas. They are each of them defective, either in form or substance, and that they are so was very properly conceded by the counsel for the defendant, on the argument of the demurrer. But, as, on demurrer, judgment must be rendered against the party who commits the first fault in substance, the defendant's counsel insists that judgment should be for the defendant, because the declaration is insufficient.

The sole objection made to the declaration is, that it does not aver, or in any manner show, that the Superior Court of Chicago had jurisdiction of the person of the defendant Townsend, either by service of process, appearance, or otherwise. The declaration is in conformity with the established precedents used in England, in declaring upon judgments of the Court of King's Bench and the Court of Common Pleas, and would have been approved in the State of New York, under the system of pleading in use before the adoption of the Code of Procedure, in declaring on a judgment of the Supreme Court of that State. The principle governing the subject is, that, when the judgment of a Court of general jurisdiction is declared upon, jurisdiction of the person is presumed, from the averment of the recovery. This presumption is, however, not conclusive. Want of jurisdiction of the person may be set up as a defence, and may prevail. The presumption, however, suffices to sustain the declaration as a pleading, and puts the defendant to plead his defence.

By the Constitution of the United States, (*Art. 4, sec. 1*), full faith and credit are to be given, in each State, to the judicial proceedings of every other State; and this imports, that a judgment shall have, in each State, the same credit, validity and effect as it has in the State in which it was rendered. But, on the other hand, this is qualified, in respect to its operation against a defendant in another State, by the condition, that the Court in which it was rendered had jurisdiction of such defendant. In this view, it was suggested, on the argument, that, inasmuch as the defendant was here sued as a citizen of New York, it ought affirmatively to appear,

Tenney v. Townsend.

when a judgment of another State was declared upon, that jurisdiction of the person was in fact acquired; and that no presumption arose, in the tribunals of this State or District, that the Court of the State of Illinois, however general its jurisdiction, had any jurisdiction of such a defendant. That the want of such jurisdiction is available as a defence is unquestionable; and it would be no unreasonable rule which required a plaintiff who wished to rely on such a judgment, and assert its conclusiveness under the Constitution, to take the affirmative, in the very form of his declaration, and aver all the facts essential to make the judgment not only valid, but conclusive. Under the peculiar relations existing between the States, and this stipulation in the Constitution, which forbids us to treat the judgment of a sister State as a foreign judgment, such a rule of pleading would harmonize with the construction which is given to the clause in the Constitution, referred to. But no case is cited to me which shows that the general rule of pleading has been modified, to change the burthen of averment from the defendant to the plaintiff, or which indicates that, upon averring that the Court in which the judgment is rendered is a Court of general jurisdiction, the plaintiff may not, for the purposes of his pleading, rely upon the same presumption which would avail him if he were declaring thereon in the same State in which it was rendered, and leave the defendant to plead and prove want of jurisdiction, if he can. The cases to which I have referred lead to the contrary conclusion; and it may well be suggested, that, if, in the State in which a judgment is rendered by a Court of general jurisdiction, the fact of recovery imports, *prima facie*, that such Court did acquire jurisdiction of the person, and, in the absence of counter averment, that *prima facie* import would prevail, then, like faith and credit, which should be here given to such judgment, includes the same *prima facie* import, and requires that Courts, here, should accord to the mere averment of recovery in such a Court the like presumption of jurisdiction. In support of the declaration in question, and as bearing on the question

Young v. Lippman.

discussed, see 2 *Chitty's Pleading*, 225 *et seq.*; 3 *Id.*, 228; *Wheeler v. Raymond*, (8 *Cowen*, 311); *Griswold v. Sedgwick*, (1 *Wendell*, 126); *Starbuck v. Murray*, (5 *Wendell*, 148); *Mills v. Duryee*, (7 *Cranch*, 481); and, that, when Congress gave the effect of a record to the judgment, it gave all the collateral consequences, see *Hampton v. McConnel*, (3 *Wheat.*, 234); *Biddle v. Wilkins*, (1 *Peters*, 686); *D'Arcy v. Ketchum*, (11 *Howard*, 165); *Westervelt v. Lewis*, (2 *McLean*, 511); *Lincoln v. Tower*, (*Id.*, 473); *Wilson v. Graham*, (4 *Wash. U. C. R.*, 53); *Sumner v. Marcy*, (3 *Woodbury & M.*, 105.) Some conflict of opinion appears to exist on the question whether, if the record of the judgment shows service of process on the defendant, or appearance in the action, the fact can be controverted by the defendant. On that question this demurrer calls for no opinion.

Judgment must be given for the plaintiff on the demurrer, but leave is first given to the defendant to amend his pleas, on the usual terms.

J. H. & B. F. Watson, for the plaintiff.

Charles Donohue, for the defendant.

ALEXANDER K. YOUNG

vs.

PHILIP LIPPMAN AND CLARA SELIGMAN. IN EQUITY.

The claim of the letters patent granted to Thomas B. De Forest and Thomas S. Gilbert, February 18th, 1868, for an "improvement in springs for hoop-skirts," namely, "A skirt-hoop, formed by enclosing one or more wires within a covering, which not only envelopes and protects the wire, but forms an edge, A, or connection, B, substantially as and for the purposes specified," is a claim to such a skirt-hoop as is described, as an article of manufacture—a skirt-hoop capable of use in making what is known as a hoop-skirt.

The invention in the patent is limited to a skirt-wire made by folding the fabric

Young v. Lippman.

over one or more wires, and securing it by sizing or glue and pressure, so as to thus enclose the wire or wires in a covering, and leave an edge of the fabric on the one wire, or a connection, formed by the fabric, between the two wires, so as to admit of attaching the skirt-wire to vertical tapes, in making a hoop-skirt.

The securing the fabric by gluing it, or using other equivalent adhesive substance, in contradistinction to securing the fabric, to form the enclosure, by weaving around the wires, or weaving pockets, in which to insert the wires, being cheaper, and an improvement in the trade, and useful, is, if new, patentable, the resulting fabric being a different article from one formed by weaving. An article of dress, called a bustle, containing wire hoops, each of which is a skirt-hoop, formed by enclosing, by means of glue or sizing and pressure, two wires within a covering, which not only envelopes and protects the wires, but forms a connection between them, so that, while the wires are confined to their proper places within the covering, the wire hoop or spring has the appearance of being made from a much broader wire than it in reality is, and may be secured to the vertical tape by means of a metallic fastening passing through the vertical tape and the material covering the spring, is, substantially, a hoop-skirt, of a diminished size, and the making and selling of such bustles is an infringement of said patent.

The ownership of a right to manufacture covered wire for springs for skirts, under a patent granted to John T. Loft, March 18th, 1860, for an "improved machine for covering the springs of skeleton skirts," confers no right, as against the De Forest and Gilbert patent, to make, under the Loft patent, the covered wire contained in such bustle.

Although such covered wire may be made by means of the machinery described in the Loft patent, no such wire or skirt-hoop is described or shown in the Loft patent, nor is the apparatus of that patent one which necessarily produces nothing else but such wire or skirt-hoop.

In opposition to a motion for an injunction, a general allegation, by affidavit, on information and belief, that the thing patented existed before, without disclosing the particulars of the information leading to the belief, is insufficient.

The fact that the plaintiff is infringing the Loft patent, by using the Loft apparatus to make skirt-hoops, is no ground for refusing an injunction against the defendant, restraining him from infringing the plaintiff's patent.

A separate affidavit, by the plaintiff, of his belief that the patentees were the original and first inventors of the thing patented, dispensed with, the bill having in it such an averment, and having been sworn to eleven days before it was filed and notice of application, on it, for the injunction, was given.

A provisional injunction was dissolved, on evidence showing the prior existence, in the United States, of the skirt-wire of the patent, specimens of the thing, known before being produced.

(Before BLATCHFORD, J., Southern District of New York, January 2d, 1872, and March 29th, 1872.)

BLATCHFORD, J. This is a motion for a provisional injunction, founded on letters patent granted February 18th, 1868, to Thomas B. De Forest and Thomas S. Gilbert, for an "improvement in springs for hoop-skirts," and now owned by the plaintiff. The specification states that the inventors have invented "a new improvement in the manufacture of hoop-skirts." There are three figures of drawings annexed to the specification. Figure 1 is a front view of one of the vertical tapes, with three springs attached. Figure 2 is a section of one of the springs, enlarged. Figure 3 is a like section, of a different construction. The specification says: "This invention relates to an improvement in the manufacture of springs attached to vertical tapes, and well known as hoop-skirts, the object being to produce a lighter and cheaper skirt than has heretofore been done; and the invention consists in enclosing one or more flat elastic wires in a covering, the said covering being, when sized, folded and pressed, of greater width than the spring, so that, while it confines the spring to its proper position within the covering, it gives to the spring the appearance of being made from a much broader wire than it in reality is, and admits of securing the spring to the vertical tape by means of a metallic fastening passing through both the vertical tape and the material covering the spring. * * * In fig. 2, we represent the spring as two flat wires enclosed within the same covering, the wires being denoted in black. Various devices may be employed in covering the two wires. One, and, we think, practically, the best, is to take a narrow strip of fabric, sufficient in width to surround the two wires, and form the space between the two. Then, the two wires, with the fabric, are drawn through an apparatus prepared for the purpose, the fabric being sized with any adhesive material, and the wires sustained equidistant from each other, the apparatus folding the fabric over the wires, and pressing it down into the space between, the sizing being sufficient, or, other sizing being added, so that, when thoroughly dried, the wires will be sustained at their given distances from each other, one wire

Young v. Lippman.

at each edge of the folded fabric. The wires may be very light, and the fabric equally light, and, when completed, the article has the appearance of a broad spring. Instead of the two springs, as seen in fig. 2, a single spring may be inserted, as in fig. 3, and the fabric guided and folded so as to leave an edge, A, of fabric upon the spring, as denoted in said fig. 3. This folded edge, being sized and pressed, secures the wire in its position in like manner as first described, and gives the like appearance of a broad spring, the sizing in all cases being sufficient to sustain that portion of the fabric at the edge of the wire, or between the wires; or, if preferred, and to give more material at the edge, a single spring may be inserted at one edge, and a cord at the other edge. To construct a skirt from springs thus formed, pass the springs, B, through the pocket in the vertical tape, C, in the usual manner, then insert an eyelet, or other suitable metallic fastening, through the vertical tape, and through the fabric of the covering of the spring, as denoted in fig. 1, and this may be done on the former, and the same means which secure the springs in the vertical tape may also lock the two ends of the spring within the pocket of the tape. A skirt constructed in this manner has every appearance of a strong spring, but is much lighter than the ordinary skirts, as the wire employed for the spring may be much lighter than that used in the ordinary manner, and the manner of attaching the parts together is of the strongest possible character. Other wires may be added, to increase the width, but forming a space in like manner between each two. We do not wish to be understood as broadly claiming the introduction of two or more springs into a fabric, as such is not new; but, in cases when it has been done, the fabric has been first formed into pockets for the reception of the springs, and the springs themselves covered separately and independent of the said pockets. This arrangement is seen in several well-known patents for the whole or lower portions of a skirt. It will be observed, that we do not in any way form a pocket in the fabric, the covering being simply a folded fabric, the folds being secured by

strong sizing and pressed hard together." The claim is in these words: "A skirt-hoop, formed by enclosing one or more wires within a covering, which not only envelopes and protects the wire, but forms an edge, A, or connection, B, substantially as and for the purposes specified."

The allegation of infringement, in the bill, is, that the defendants are making and selling springs for hoop-skirts, precisely the same as those described in the plaintiff's patent. The evidence of infringement is, that the defendants have sold an article of dress called a bustle, containing hoop-skirt wire made substantially in the manner described in the patent, and that the defendant Lippman has been vending such hoop-skirt wire. The making and selling of the bustle is not denied, and a specimen is produced, which contains wire hoops made in the manner described in the patent. Each hoop, in fact, is a skirt-hoop, formed by enclosing, by means of glue or sizing and pressure, two wires within a covering, which not only envelopes and protects the wires, but forms a connection between them, substantially as and for the purposes set forth in the specification of the plaintiff's patent.

There can be no doubt that the claim of the patent is for such a skirt-hoop as is described, as an article of manufacture—a skirt-hoop capable of use in making what is known as a hoop-skirt. The bustle referred to is substantially a hoop-skirt, of a diminished size.

The defendants set up, in defence, that the defendant Lippman is the owner of the right to manufacture covered wire for springs for skirts, under letters patent granted to John T. Loft, March 13th, 1860, for an "improved machine for covering the springs of skeleton skirts," and that he is making, under that patent, covered wire such as is contained in the bustle referred to. The specification of the Loft patent describes a machine for covering, in a continuous manner, the springs for hoop-skirts with any textile or other suitable fabric, the invention consisting in the use of glue or cement, distributing rollers, cutters, guides, folders, and drawing and

Young v. Lippman.

pressure rollers, substantially as described in such specification, whereby the desired end is attained. The machine is intended to take the place of machines for weaving or braiding the covering around the wires of which the hoops are made. It describes and claims the covering of wires or springs for hoop-skirts, by passing the same, in connection with strips or covers of suitable fabric, having a suitable glue, cement or adhesive substance applied to them, through folders and between drawing and pressure rollers, arranged to operate substantially as and for the purpose set forth. There is no description or representation of any such skirt-hoop as the plaintiff's. The only wire or skirt-hoop shown or described is one in which the fabric merely encloses or covers the wire, so as to envelop and protect it, and does not, as in the plaintiff's hoop, also form an edge to a single wire, or a connection between two wires, for the purpose shown in the plaintiff's specification. There is no suggestion, in the Loft specification, of the construction of such an article as the plaintiff's skirt-hoop. It may very well be, that the Loft machine is capable, either with or without modification, of being used to manufacture the plaintiff's skirt-hoop. The specification of the plaintiff's patent speaks of making his skirt-hoop by drawing it through a proper apparatus; but the mere fact of the prior existence of such apparatus shows no want of novelty in the invention covered by such patent. The novelty of such invention would not have been affected even if the plaintiff's patent had stated that the new skirt-hoop was to be made by the use of the Loft apparatus. Such apparatus is not one which necessarily produces nothing else but the plaintiff's skirt-hoop. This is shown by the fact that, as described and represented in the Loft patent, it does not produce the plaintiff's skirt-hoop, or any thing having its characteristics.

The defendant Lippman, in an affidavit, states, that he is informed and believes, that, long before the date of the plaintiff's patent, and before the alleged invention of De Forest and Gilbert, covered wire, with spaces of the covering fabric between or on the outside of the wire, was known and used

Young v. Lippman.

publicly for various purposes, and was an article well known and used and sold. This general allegation, on information and belief, amounts to nothing. If the defendant has any information to the effect stated, sufficient to warrant a belief in the truth of what is stated, he is bound to disclose it for the judgment of the Court, if it is to be of any avail to him. He cannot swear to the conclusion and withhold the particulars of the information.

The fact that the plaintiff does not or cannot make his hoop without using the apparatus covered by the Loft patent, as is urged, cannot affect the questions involved in this motion. It may be that the plaintiff is infringing the Loft patent, while the defendants are infringing the plaintiff's patent, and that neither can make the plaintiff's hoop without using what is covered by both of the patents. But the case of each must be treated separately, on its merits, when presented.

It is objected, that the application for the injunction is not accompanied by an affidavit of the plaintiff, that he believes that De Forest and Gilbert were the original and first inventors of the thing patented. The bill, however, which was sworn to on the 13th of November, 1871, and filed on the 24th of November, avers that De Forest and Gilbert were the first and original inventors of the improvement for which the patent was issued. On the filing of the bill, notice of the application, founded on the bill, for the injunction, was given for the 2d of December. Under such circumstances, no separate affidavit is necessary. (*Sullivan v. Redfield*, 1 *Paine*, 441.)

An injunction must be granted, as prayed for in the bill.

Edward N. Dickerson, for the plaintiff.

John B. Staples, for the defendants.

AFTER the granting of the injunction, in January, 1872, a motion was made, in March, 1872, to dissolve it, on matters not presented on the original motion.

Edward N. Dickerson, for the plaintiff.

John B. Staples, for the defendants.

Young v. Lippman.

BLATCHFORD, J. I do not regard anything adduced by the defendants against the novelty of the invention covered by the plaintiffs' patent, as of any importance, except the skirt wires brought from England by Marcus Berliner, in 1865. The invention in the patent is limited to a skirt wire made by folding the fabric over one or more wires, and securing it by sizing or glue and pressure, so as to thus enclose the wire or wires in a covering, and leave an edge of the fabric on the one wire, or a connection formed by the fabric between two wires, so as to admit of attaching the skirt wire to vertical tapes, in making a hoop skirt. This securing the fabric by gluing it, or using other equivalent adhesive substance, is in contradistinction to securing the fabric, to form the enclosure, by weaving around the wires, or weaving pockets, in which to insert the wires. It is in evidence, that the manufacture by folding and gluing is cheaper than that by weaving. It is an improvement in the trade, and useful, and, if new, patentable. The resulting fabric is a different article from one formed by weaving.

The article brought from England by Berliner in 1865, if his affidavit is true, and not a fabrication, and if the specimens which he produces, as the identical articles he brought from England in 1865, are not fabricated for this occasion, is the same thing as the skirt wire of the patent, made of a folded fabric, glued and pressed, over two or more wires, and with the connection of fabric between two wires. If his affidavit and these specimens had been presented on the original motion for injunction, I should not have deemed it proper to grant the injunction; and I think they must now avail to throw such doubt over the question of the novelty of the invention, as to entitle the defendants to have the injunction dissolved, leaving it to the plaintiff to proceed to proofs for final hearing.

In re James R. Dey, a Bankrupt.

In re JAMES R. DEY, A BANKRUPT.

Under the mechanics' lien law of the State of New Jersey, (*Nixon's Digest*, 4th ed., p. 571,) A. performed labor and furnished materials in erecting a building on real estate of B. in New Jersey. Afterwards, B. executed a mortgage to C., on such real estate. After that B. was adjudged a bankrupt, on his own petition, in the District Court for the Southern District of New York, and an assignee of his estate was appointed. Thereafter, and within one year after the performance of such labor, A. filed his claim, under said law, in the office of the clerk of the county, in New Jersey, in which such building was situated: *Held*, that the lien of A. attached as of the time the labor was performed, and was superior to the lien of C. under his mortgage, and that the real estate, in the hands of the assignee in bankruptcy, was subject to such lien of A.

(Before WOODRUFF, J., Southern District of New York, January 3d, 1872.)

THIS case came up on a petition by Hewes and Phillips, and a petition by Uzal Cory, for the review of an order of the District Court touching the distribution of the bankrupt's estate, which order excluded liens claimed by the petitioners severally under the law of New Jersey, known as the "mechanics' lien law." (3 *Benedict*, 450.)

John H. Strahan, for the assignee in bankruptcy.

Morris S. Thompson, for the mortgagees.

Wheeler H. Peckham, for Hewes and Phillips.

Joseph F. Randolph and *B. F. Randolph*, for Cory.

WOODRUFF, J. The petitioners respectively claim liens upon certain real estate of the bankrupt, in New Jersey, for work and materials done and furnished for the erection of buildings thereon, prior to the adjudication in bankruptcy, made upon the application of the bankrupt, for which liens, after such adjudication, and within one year after the performance of the labor and the furnishing of the materials, they have respectively filed their claims in the office of the

In re James R. Dey, a Bankrupt.

clerk of the county, in New Jersey, in which the buildings, &c., were situated. The assignee and certain mortgagees subsequent to the commencement of the building, insist that, by the filing of the petition in bankruptcy, the adjudication thereon, and the appointment of the assignee, intermediate the performance of the work, &c., and the filing of the claims of lien, the assignee takes title free of all such liens and claims, and that the mortgagees subsequent to the commencement of the building are let in, to the exclusion of such liens. The petitioners, on the other hand, insist, that, under the statute of New Jersey, they have liens which the bankrupt could not, by his proceedings in bankruptcy, divest. On the one hand, it is claimed, that no lien is created until the claim therefor is filed, and, therefore, that, when the property passed to the assignee in bankruptcy, no act of any creditor could thereafter create such lien. On the other hand, it is claimed, that the moment work is done, or materials are furnished, a lien attaches in favor of the creditor, which the proceedings in bankruptcy could no more divest than could any act of the bankrupt himself. Obviously, the question in contest depends upon the construction and legal effect of the statute of New Jersey; and it is settled, that, if any doubt appears to exist touching that construction and effect, this Court must look to the decision of the Courts of that State, if any there be, as its guide in determining the question. The construction given by the District Court was deemed sustained by the case of *Morris County Bank v. Rockaway Manufacturing Co.*, in the Court of Chancery of New Jersey, (1 *C. E. Green*, 150, 161,) and the District Judge states, in his opinion, that no decision of any Court in New Jersey was cited, on the argument, in conflict with the views stated. I cannot doubt, that, had counsel called to the attention of Court the numerous cases, some of which are below referred to, in which the Judges of the Courts of that State have declared their opinion upon this statute, a different conclusion would have been the result.

The 1st section of the Act (*Nixon's Digest*, 4th ed., p. 571.)

In re James R. Dey, a Bankrupt.

provides, that every building shall be liable "for the payment of any debt, contracted and owing to any person, for labor performed, or materials furnished, for the erection and construction thereof, which debt shall be a lien on such building, and on the land whereon it stands, including the lot or curtilage whereon the same is erected." Although it would have been unwise to leave this section to operate, without enacting other supplemental provisions touching the duration of the lien, the notice thereof to be given, and the manner of its enforcement, it is not doubtful, I think, that, if there had been nothing more in the Act, a party performing work, or furnishing materials, would, by virtue of this section, have a lien which it would be the duty of a Court of equity to recognize and enforce. No language would make the intent more plain, to secure the creditor payment by a charge on the premises, to secure the debt *eo instanti* it was incurred, by making it then a lien. Such language in an instrument executed by the owner to the party performing labor or furnishing materials, would give the latter a lien, in equity, which would be enforced, even though the legal title were not conveyed. Much more should the statute have that effect when, within its clear power and authority, it so enacts. What, then, is the effect of the subsequent provisions? .

In the first place, it was obvious to the legislature, that the alienability of the property ought not to be too long hindered by the uncertainty which any proposed purchaser would feel in regard to the existence and amount of such debts; and, second, it was practically certain, that many of such debts would be paid, or otherwise secured, so that the creditor would neither desire nor need to assert his lien. It was, therefore, enacted, (§ 6,) that the creditor "intending to claim a lien" shall, within one year after the labor is performed, or the materials furnished, for which such lien is claimed, file his claim in the office of the county clerk, containing the particulars specified in the statute, and that, when such claim shall not be filed in the manner or within the time aforesaid, or, if the same shall contain any wilful or

In re James R. Dey, a Bankrupt.

fraudulent misstatement of the matters required to be stated, "the building or lands shall be free from all lien for the matters in such claim." It is claimed, that it is the filing of this claim which "constitutes" the lien upon the premises; that, until then, although the statute has enabled the creditor to acquire a lien, has given him the right to acquire such lien, no lien, in fact, exists until such claim is, in fact, filed; and that, although, by a subsequent section, if the claim be so filed, it relates back to the commencement of the building, and takes precedence of mortgages, or conveyances, or other liens, made or created after the commencement of the building, the lien itself has no existence until the claim is filed. This is giving to the provision requiring the claim to be filed a plain repugnance to the terms of the first section, which declares that the building shall be liable for the payment and the debt shall be a lien. In a large degree, it defeats the purpose of the Act, which was to furnish an instant security while the work was in progress, on which laborers and material men might rely. Such a construction is not necessary to the giving of full force and effect to the provision itself. It was intended to operate, and it does operate, as a limitation of the time within which persons desiring to assert their liens must place their claim in the proper office, within the inspection of purchasers and others; and it enabled them and the owner to know, and be protected by the assurance, that the various persons performing labor or furnishing materials, but not asserting liens, had been paid or otherwise provided for. In effect, it operated, as to all creditors, as a condition subsequent, defeating any pre-existing lien, and as a conclusive bar to the assertion thereof. This satisfies the language, and harmonizes both of the sections.

This construction is also in harmony with the subsequent 8th section, which provides, that, "when a claim is filed, agreeably to the provisions of this Act, upon any lien created thereby, the same may be enforced by suit," commenced and prosecuted as directed in the Act. As the premises are, by the previous section, to be free of the lien, if the claim be

In re James R. Dey, a Bankrupt.

not filed within one year, so, in the last-named section, it is provided, that, when filed, it may be enforced by suit; and, by necessary implication, if not filed, it cannot be enforced. This is not only consistent with the previous sections, but seems a necessary conclusion therefrom. The 11th section, in a pointed manner, indicates the intent of the legislature to make the liability and lien declared in the first section efficient beyond the control of the debtor or owner of the building, by providing that, when such suit has proceeded to judgment, a conveyance, in pursuance of a sale on the execution, shall convey the estate which the owner had in the land at, or at any time after, the commencement of the building, free from all subsequent estates or incumbrances by deed or mortgage, made by such owner, or any person claiming under him. This provision, read in connection with the previous sections, shows that it was not in the power of the owner to defeat the security provided to laborers and material men by the statute; that such security was to operate effectually from the time the building was commenced; and that the right of such creditors was prior in time to that of such subsequent grantees or mortgagees. It was conceded, by the counsel for the assignee, that, if the claim was filed within the year limited, the lien which he insists was then first constituted related back to the commencement of the building, and, when enforced, operated to hold and convey all the interest of the owner at that time, but, still, that, until the claim is in fact filed, no lien exists. I have already expressed the opinion, that the first section gives the lien, and that the filing of the claim is not a condition precedent to the liability declared in that section, but only a condition subsequent, which operates to discharge or bar the assertion of the right which the first section confers.

Nothing can be more plain, however, than this. The first section confers a right, whether it be what is therein called, the liability of the building, or a lien on such building and the land whereon it stands, in the sense of a legal lien. In virtue of work performed and materials furnished, the creditor is secured the right, within one year, to file his claim,

In re James R. Dey, a Bankrupt.

bring suit and sell the property, divested of all estates or incumbrances by deed or mortgage. This right is vested by the statute. Twice, in sections subsequent to the first, it is called the lien "created by this Act"—that is, created not by the filing of the claim, but by force of the Act itself. This right was vested in the creditor the moment he was brought within the scope of the statute. I do not deem it very material to enquire by what name this right is called, when the question is whether an adjudication in bankruptcy defeats it. Let it be conceded that it is only a right in equity to acquire a legal lien, or an equitable right. Whatever it is, it is absolute in the creditor. It is the security in reliance upon which he has performed the work, or furnished the materials, and is indefeasible by act of the debtor or owner, or those claiming under them by title subsequently acquired. Why, even in this view, should the title of the assignee in bankruptcy be held, in a Court of bankruptcy, proceeding as a Court of equity, to defeat that right? The reasoning of the counsel for the assignee is, in a high degree, technical. It overlooks the evident purpose of the statute to furnish security that will accompany the credit given. It fails to recognize the claim of the creditor as being even equitable. This case illustrates, in a marked manner, the utter subversion of the design of the statute, and the disregard of all equities resulting therefrom, by its operation on the subsequent mortgagees, who are here contesting these liens. Their mortgages are subsequent to the commencement of the building. It is conceded, and is expressly enacted, that the right of these petitioners, when they had filed their claims, was complete, perfect, and prior to those mortgages, and that, when duly prosecuted, a sale must follow, which would cut them off, and give the proceeds of sale to the holders of these mechanics' liens. What is the effect of the construction for which they and the assignee contend? It is not claimed that their title is not prior to that of the assignee; and the consequence is, under the order before us for review, that the mechanics' liens are excluded, the mortgages are sustained, and, in direct contravention of the purpose of the statute, the

.

In re James R. Dey, a Bankrupt.

mortgages are to be paid by the proceeds of the property. Surely the design of the bankrupt law was not thus to affect the relations between these lien claimants and such subsequent mortgagees, and give the latter a preference, where the statute made their claims subordinate to those of the former. This incidental effect may not be a conclusive reason for rejecting the construction claimed, but it is a reason for doubting its correctness, and for adhering to a more just and equitable view of the statute, if its terms will permit.

The case bears no analogy to judgments sought and obtained by creditors of an insolvent, with knowledge of such insolvency, in a struggle to obtain preferences in fraud of the bankrupt law, and which, as well as executions issued after petition filed, have been held inoperative, as against the title of the assignee. The right here asserted, according to the views above expressed, was acquired contemporaneously with the performance of the labor and the furnishing of the materials, and, therefore, is free from any suggestion of such fraud upon the law.

It must be conceded, that the language of the 12th section furnishes plausible ground for the interpretation given to the statute in the District Court, namely: "No debt shall be a lien, by virtue of this Act, unless a claim is filed, as herein before provided, within one year from the furnishing the materials, or performing the labor, for which such debt is due." But that section is to be read in connection with the other provisions, and it is fully satisfied, while the prior indefeasible right of the creditor in equity, vested the moment the work is done, is sustained. It is enough, that no claimant can assert a lien, who has not filed his claim within the prescribed period. No case could arise under the statute, in which a lien could be successfully asserted, unless such claim was filed within twelve months. But, looking at the whole statute, it does not follow, that, if, before the lapse of twelve months, the state of the property and title, and the rights of all parties, became a proper subject of inquiry in the Courts of New Jersey, they must say that parties heretofore perform-

In re James R. Dey, a Bankrupt.

ing labor, or furnishing materials, have no interest in the property, no rights arising and vested, entitling them to perfect their security, by complying with the statute within the time limited thereby.

The construction and legal effect of the Act, as stated by the learned judges of the Courts of New Jersey, seem to me clearly to support the validity of the lien claimed in this case. In *Ayres v. Revere*, (1 *Dutcher*, 474, 480, 481,) Green, Chief Justice, (afterwards Chancellor,) in giving the opinion of the Supreme Court, says: "The beneficial design of the Act must have been to enable parties interested, before the work was done, or materials furnished, to ascertain whether they must look to the responsibility of the builder, or may rely upon the security of the building itself." "The man who has furnished a brick, or a stone, or a plank, for the erection of the building, or who has labored a day in its construction, is secured his remuneration in full. * * * It reaches to the claims of mortgage and judgment creditors, and supersedes even these incumbrances, if created after the building is commenced, in favor of the subsequently created debts of a favored class of creditors." In *Tomlinson v. Degraw*, (2 *Dutcher*, 73,) the same distinguished Chief Justice says: "Where the claim is filed within the time prescribed by the Act, the statute makes the debt a lien on the building, and on the land whereon it stands. The lien attaches at the commencement of the building, or one year before the filing of the claim in the clerk's office." In *Edwards v. Derrickson*, (4 *Dutcher*, 39,) Vredenburg, Justice, (pp. 61, 62,) regards the filing of the claim as in the nature of a bill in equity, and then says: "This statute gives to the plaintiff a right to file his lien, or bill in equity, if we choose to call it so, against the estate either of the original owner, or a subsequent purchaser or incumbrancer under him, and, as in case of the mortgagee in chancery, he sells only the estate of the person against whom he seeks, by his lien claim, to enforce his lien. * * The fair meaning of the statute is, that the lien may be filed against any estate in the lands, either at the time of the attaching of the lien, or at any time afterwards before the lien is filed." In his opinion,

In re James R. Dey, a Bankrupt.

the expression, "the attaching of the lien," is repeatedly used to indicate, not the time the claim is filed, but the time when the right accrued to the party. Chief Justice Green, in the same case, (though he dissented from his associates on the question whether the claim filed in that case was sufficient to entitle the party to maintain the suit,) says, (*p.* 75,) on the subject now under consideration: "The lien attaches, and becomes a valid, subsisting incumbrance, at the time of the commencement of the building, and upon the estate of the then owner." After reciting section 11, he adds, (*p.* 76.): "This language renders it very clear, not only that the lien attaches, at the commencement of the building, upon the estate of the then owner, but, also, that the said owner, against whom the suit is commenced, and who is to be specified in the claim filed, is the owner at the time the building is erected." In *Gordon v. Torrey*, (2 *McCarter*, 112, 114,) the same learned Chief Justice, now Chancellor, says: "The lien attached at the commencement of the building, upon the estate of Torrey," the then owner. "A change of ownership does not affect the validity of the incumbrance." "The statute, in express terms, makes the debt a lien from the commencement of the building. The proceeding to enforce the lien is a proceeding *in rem*. It does not create the lien, any more than a proceeding and decree for the foreclosure of a mortgage creates the incumbrance. There is nothing in the statute which requires that the time of the commencement of the building, and the consequent attaching of the lien, should be specified, either in the lien or in the record of the judgment." The opinion of the same Chancellor, in *Morris County Bank v. Rockaway Manufacturing Co.*, (1 *C. E. Green*, 150, 161,) was supposed to support the claims of the assignee, but I think, on examination, it merely indicates what is above conceded, namely, that, unless the creditor asserts his lien, by filing his claim with the county clerk within twelve months after the work is done, &c., he has no standing in Court thereon, and loses all right to enforce his lien. By the non-performance of that condition, his lien is defeated, and he has thereafter no lien on the premises. The Chancel-

Jurgensen v. Magnin.

lor was discussing various objections to the claims of certain parties, who were reported by the master as having liens, but who had not filed their claim with the county clerk, and he adds: "The radical objection is, that the claim was not filed according to the requirement of the statute, and constitutes, therefore, under the provisions of the law, no incumbrance upon the premises." The contest was between mortgagees and sundry lien claimants, and the purpose was to marshal the proceeds of sale. The observation of the Chancellor was of a present fact. The claim had never been filed. The words of the Chancellor are but a reiteration of the statute, and are in entire harmony with the views above expressed.

I am constrained to the conclusion, that the rights of these petitioners were not cut off or defeated by the act of the owner, Dey, in presenting his petition in bankruptcy, or by the adjudication thereon, and that the order under review should be modified so as to require payment to them of the debts secured by their liens, in priority to the mortgagees, and to the rights of the assignee. The costs of this review should be paid out of the estate.

JULES JURGENSEN

vs.

ELISE MAGNIN AND OTHERS. IN EQUITY.

The claims of the reissued letters patent granted to Jules Jurgensen, April 11th, 1871, for an "improvement in stem-setting watches," the original letters patent having been granted to him January 15th, 1867, namely: "1. A stem-setting watch, so constructed that the setting mechanism is thrown into gear by turning down the pendent ring or bow, when the front cap or case is open, substantially as shown and described; 2. The combination of the cap or guard, E, with the pendent bow, C, and hand-setting mechanism, whereby the said cap, while closed, is made to prevent the bow from throwing the hand-setting mechanism in gear, substantially as shown and described," are infringed by

Jurgensen v. Magnin.

watches containing mechanism constructed in accordance with the description contained in letters patent granted to V. J. Magnin, Guédin & Co., as assignees of James Nardin, August 17th, 1869, for an "improvement in stem-winding watches."

Before the plaintiff's invention, no projection on the bow or pendent ring of a watch had been used, through the turning down of such bow, to actuate a slide, to throw into gear the hand-turning wheels, and the slide had never been placed within reach of any such projection; and the plaintiff was the first to dispense at once with the projection of the slide outside of the case, and with the necessity for locking it by a pin, by putting it within the closed cover, and making it impossible for the projection on the bow to move it with the cover closed.

The defendant's arrangement infringes, because the slide does not project outside of the case, and is within the cover, when the cover is closed, so as to be thereby protected from accidental contact with anything; and because the slide is so placed, relatively to one of the collars on the bow, that, when the cover is open, and the bow is turned over, the collar will press on the slide, to effect the gearing with the hand-turning wheels.

In both, if the bow is turned down, when the cover is open, a projection on the bow presses against a slide, which bears against a spring, through the compression of which the gearing is effected with the hand-turning wheels, by the sliding motion imparted to a toothed wheel on the winding-stem; and, in both, when the cover is shut, such gearing cannot be effected, even accidentally.

It makes no difference, that there is, in the plaintiff's arrangement, a larger quantity of mechanism, and that the plaintiff places the slide, and the projection to move it, within the stem, while the defendant places them outside of the stem, and that the defendant can still move his slide by hand, when the cover is open, and the plaintiff cannot so move his.

(Before BLATCHFORD, J., Southern District of New York, January 5th, 1872.)

BLATCHFORD, J. This is a motion for a provisional injunction, founded on re-issued letters patent granted to the plaintiff April 11th, 1871, for an "improvement in stem-setting watches," on the surrender of original letters patent granted to him January 15th, 1867. The specification says: "The nature of my invention consists in so constructing the rotating device and the bow or pendent ring, and so arranging them with relation to each other, that, by turning down the bow, the rotating device is thrown into gear with the mechanism which operates the hands. In stem-setting watches, as previously constructed, it has been usual, in addition to the stem-turning gear, whereby the hands are adjusted, or set

Forward or backward, as required, to employ a pin or spring, arranged to protrude from the case, and requiring a separate application of pressure or force, say, by the thumb or finger, before and while turning the rotating device at the stem, for the purpose of locking said rotating device with the cannon or minute-hand-operating pinion of the watch. This, however, is very objectionable, not only on account of the double manipulation requisite to set the hands, but also on account of the liability to accidental and improper adjustment of them by some casual outside contact with, and action on, the stem-gearing pin or spring, and turning of the attachment that is used for setting the hands. The difficulties referred to are obviated in my invention, by making automatic, consequent on the adjustment of the pendent bow of the stem, when the cap, or a portion of the case only, is open, the gearing of the rotating device at the stem with the cannon-pinion of the watch, the pendent bow controlling the action of the rotating device." The specification then describes the new mechanism. The bow or pendent ring, C, is divided, where it is hung in the stem, so as to admit of a spindle passing up through the stem. The spindle is provided with a milled-cap, or rose-head, on its exterior end, to facilitate the turning of it by the fingers, in setting the hands of the watch; and, passing through the rim into the body of the case, and supported by suitable bearings, it carries, near its opposite or inner end, a clutch, the inner face of which is made to form, or has attached to it, a contrate-wheel. The clutch is made to turn with the spindle, and also to slide longitudinally on it, for the purpose of throwing the spindle, by the contrate-wheel, in or out of gear with a pinion, that meshes, through a train of spur-wheels or pinions, with the cannon-pinion of the watch. On one end of the bow or pendent ring, C, where it enters the stem, is an eccentric pin or projection, which is so pitched in relation to a sliding rod or pin passing from the stem into the body of the case, that, when the bow is extended, it is out of gear or contact with the sliding rod, and remains so even when the bow is turned down on the closed cap or case, E, or

other stop or guard to it; but, on opening or removing the guard, say, opening the cap or case, E, to see the position of the hands, and the amount of adjustment necessary to be given to them, then, on turning the bow, C, yet further down, which the removal of the stop or guard, or the opening of the cap or case, E, admits of, the eccentric pin is brought to bear on and press inward the sliding pin, which touches and compresses a spring extending partly around the rim on the inside of the case. This spring has a tendency to keep pressed outward the sliding pin, which, when forced inward by the action of the eccentric pin connected with the bow, C, compresses the spring, and causes it to bear on, and drive inward, a branch or arm of a spring-clutch lever, said branch or arm working through a suitable guiding cavity or aperture in a fixed bracket, or plate, and the free end of such spring-clutch lever being forked to fit the clutch on the inner end of the spindle which passes through the stem. The spring-clutch lever being forced inward or compressed, it being of a spring or elastic character at its attachment to the case, causes the clutch on the spindle to slide inward, and with it the contrate-wheel, which is accordingly thrown into gear with the train of pinions actuating the cannon-pinion, so that, by turning the milled-cap of the spindle to the right or to the left, the hands of the watch are set forward or backward, as required. On again throwing back, or extending, or commencing to lift, the bow, C, the eccentric pin is released from pressure on the sliding rod, such rod is thrown outward by the spring on which it bears, while the spring-clutch lever, on being relieved from the action of such spring, also shoots back and draws with it the clutch on the inner end of the spindle, which detaches the contrate-wheel from being in gear with the train of pinions actuating the cannon-pinion, so that the turning of the milled-cap and the spindle will have no effect on the setting mechanism of the watch; and the closing of the cap or case, E, or putting into action the stop or guard, secures or locks the setting mechanism out of gear, without regard to the position of the bow, which may then be either closed or

Jurgensen v. Magnin.

extended. As the pendent bow, C, can operate upon the setting mechanism only when the cap or case, E, is open, or the stop or guard is not in action, the parts cannot be accidentally thrown into gear when the cap or case, E, is not open, or the stop or guard is in action. The claims are as follows: "1. A stem-setting watch, so constructed that the setting mechanism is thrown into gear by turning down the pendent ring or bow, when the front cap or case, E, is open, substantially as shown and described. 2. The combination of the cap or guard, E, with the pendent bow, C, and hand-setting mechanism, whereby the said cap, while closed, is made to prevent the bow from throwing the hand setting mechanism in gear, substantially as shown and described."

The defendants are engaged in selling watches made in Switzerland by James Nardin, of Locle, Switzerland. The mechanism in such watches, which is alleged to infringe the plaintiff's patent, is constructed in accordance with the description contained in letters patent granted to the defendants, under the name of V. J. Magnin, Guédin & Co., of New York, as assignees of said Nardin, as the inventor, August 17th, 1869, for an "improvement in stem-winding watches." The specification of the defendants' patent, so far as it relates to anything involved in this suit, says, that Nardin's invention relates to improvements in stem-winding watches, and has for its object to arrange the slide by which the winding device is changed to gear with the hands, so that it may be better protected against being moved by the accidental contact of the slide against anything when the watch is in the pocket, or other use; and that his invention also comprises an improved mode of operating such slide, to gear the winding stem with the hands, for turning them. It further says: "Stem-winding watches are now commonly arranged for adjusting the hands by the winding stem, the toothed wheel thereon being arranged to slide out of gear with the winding gear, and into gear with wheels gearing with the hands, a spring, moved by a slide, projecting through the case, to be pressed by the thumb, to effect the said change, the spring

Jurgensen v. Magnin.

restoring the connection with the winding gear when the thumb is removed. This thumb piece, projecting outside of the case, is liable to be inadvertently moved, and to catch in the clothing, &c. Pins, projecting from the cover, have been used to take into holes in these slides, to lock them, but this arrangement is objectionable. I propose, instead of having this slide, B, project through the case, to arrange it so as to project only through the bezel, A, which holds the glass, and above or into the wall, C, of the case, where it is equally or nearly as accessible for pressing into gear with the hands as when projecting outside, and where it is protected from accidental contact with anything to move it, by the cover, D, when closed. I have also so arranged this slide or thumb piece, relatively to the bow, E, and one of the collars, F, thereon, commonly used to prevent the entanglement of the vest-chain with the milled-head, G, of the winding stem, that, when the bow is turned over, in the position shown in red, the collar, F, will press upon the slide, B, and force it inward, to effect the gearing with the hand-turning wheels." There is a sliding wheel on the shaft of the winding stem, which is moved into and out of gear with the hand turning wheels, by a spring arm, to which the slide B is connected. The specification also says: "I am aware that watches are in use, provided with bows, on one end of which is formed an eccentric projection, for operating a sliding pin for compressing a spring-clutch lever, which bears a crown-wheel or pinion into contact with the train of wheels for setting the hands, but such do not pertain to my invention." The two claims of this patent which concern the present question are these: "1. The arrangement of the slide, B, relatively to the bezel, A, cover, D, and the part K, of the case, substantially as specified. 2. The arrangement of the slide, B, with the case, and the bow, E, having the collar, F, substantially as specified."

The specification of the defendants' patent manifestly refers to the plaintiff's invention, where it speaks of watches with bows on one end of which is an eccentric projection, &c. It also speaks of the prior arrangement of a slide, projecting

Jurgensen v. Magnin.

through the case, pressed by the thumb to move a spring which causes a toothed wheel to slide into gear with the hand-gearing wheels, and condemns such arrangement of the thumb piece even when locked by a pin projecting from the cover. It proposes, as a novelty, to have the slide not project outside of the case, and to have it within the cover when the cover is closed, so as to be thereby protected from being moved by accidental contact with anything. It proposes, as a further novelty, so to place the slide relatively to one of the collars on the bow, that when the cover is open, and the bow is turned over, the collar will press on the slide, to effect the gearing with the hand-turning wheels. It is impossible to distinguish this arrangement, as a mechanical structure, in respect to the plaintiff's invention and the claims of his patent, from the arrangement of the plaintiff. In both, if the bow is turned down, when the cover is open, a projection on the bow presses against a slide, which bears against a spring through the compression of which the gearing is effected with the hand-turning wheels, by the sliding motion imparted to a toothed wheel on the shaft of the winding stem. In both, when the cover is shut, such gearing cannot be effected, even accidentally. There is, in the plaintiff's arrangement, a larger quantity of mechanism, but it is impossible not to see that Nardin has appropriated, and taken directly, from the plaintiff's arrangement, all that constitutes its essence and merit. Starting with the projecting slide moved by the hand solely, and liable to be moved accidentally, the plaintiff placed the slide in such position that a projection on the bow would move it by turning the bow down, and interposed the closed cover of the watch as a guard against an accidental movement of it. The plaintiff, indeed, placed the slide and the projection to move it, both of them, within the stem. The defendants' arrangement places them outside of the stem. But this difference is not of the essence of the plaintiff's invention. True, the collars on the bow were old, and the slide and its connections with the hand-turning wheels, out of reach of being moved by the turning down of the bow, were

Clark v. Scott.

old, and the locking of the slide by a pin on the cover of the case was old. But, before the plaintiff's invention, no projection on the bow had been used, through the turning down of the bow, to actuate the slide, and the slide had never been placed within reach of any such projection, and the plaintiff was the first to dispense at once with the projection of the slide, and with the necessity for locking it by a pin, by putting it within the closed cover, and making it impossible for the projection on the bow to move it with the cover closed. The defendants can, indeed, move their slide by the hand, when the cover is open, and the plaintiff cannot so move his. But the defendants' is none the less movable by the projection on the bow.

Entertaining no doubt as to the infringement, I must grant the injunction.

Thomas C. T. Buckley, for the plaintiff.

Charles M. Keller, for the defendants.

THOMAS CLARK, JR., TRUSTEE OF W. U. DUDLEY AND
LAWRENCE W. CLARK, AND THE SAID W. U. DUDLEY
AND THE SAID LAWRENCE W. CLARK

vs.

GEORGE A. SCOTT, AGENT OF THE FLORENCE MANUFACTURING
COMPANY. IN EQUITY.

The letters patent granted to W. U. Dudley and Lawrence W. Clark, as assignees of W. U. Dudley, the inventor, July 27th, 1869, for an "improved hand-mirror," are valid.

The claim of said patent, namely, "A hand or portable-toilet mirror, constructed, substantially as described, of a base-piece, P, with its handle-extension piece or stiffener, C, glass, A, and outer back and handle, D, made of any suitable

Clark v. Scott.

composition or cement, substantially as specified," covers a hand-mirror made of a cement applied in a plastic state and afterwards hardened, and which has in it two flat wires or strengtheners, made of metal, embedded in the cement and concealed from view, and running, from the body of the mirror part, through the neck and into the handle, and serving to stiffen and strengthen the article, particularly at the junction of the handle with the body.

The brush described in letters patent granted to J. S. Parsons and George A. Scott, as assignees of Alanson C. Esterbrook, June 19th, 1866, for an "improved brush," namely, a brush in which the bristles, inserted through a perforated plate, are imbedded and held firmly in a suitable cement, which cement, at the same time, in combination with the plate, and an extension of the plate into the handle, forms the back and handle of the brush, is not, as a structure, substantially the same thing as the hand-mirror covered by the patent to Dudley and Clark.

Such hand-mirror, as an article of manufacture, was patentable, as distinguished from a brush, even though the backs and handles of the two were made in the same way, there having been a point of utility and adaptability, in applying the non-warping property of the back and handle to rendering the glass of the mirror free from liability to fracture, which constituted sufficient invention to support a patent for a mirror, even though a brush with a like back and handle had existed before.

Dudley, at the time he applied, in August, 1866, for a patent for the hand-mirror, also applied, as inventor, for a patent for an "improvement in brushes," with this claim, namely, "A brush, in which the bristles are inserted through a perforated plate or holder, imbedded in a composition or cement of any suitable substance, as described, which cement shall, in combination with a base-piece and stiffener of metal, or other material, form the back and handle of the brush, substantially as specified." Both of the applications were rejected. In December, 1866, he assigned to a corporation, who were the real defendants in this suit, all his inventions "in the manufacture of composition brush backs and handles, with suitable strengtheners," and all applications for a patent "therefor," and certain apparatus used by him "in said manufacture," with all his useful information "for making and selling said composition brush backs and handles," "meaning hereby to transfer" all his rights "to the manufacture and sale of said composition brush backs and handles." The applications for both of the patents were pending at that time: *Held*, that the assignment was one only of the invention of the brush, and of the application for the brush patent, and did not carry a right to the invention of the hand-mirror.

Dudley, from August, 1866, until May, 1869, did nothing further towards obtaining a patent for the hand-mirror. The said corporation put into the market, in the fall of 1867, hand-mirrors made in accordance with Dudley's invention. Dudley did not know that fact. His co-patentee, Clark, obtained no interest in the invention until April, 1869: *Held*, that these facts constituted no objection to the validity of the patent.

(Before BLATCHFORD, J., Southern District of New York, January 16th, 1872.)

Clark v. Scott.

BLATCHFORD, J. This suit is founded on letters patent granted to W. U. Dudley and Lawrence W. Clark, as assignees of W. U. Dudley, the inventor, July 27th, 1869, for an "improved hand-mirror." The specification, signed by the inventor, says: "My improvement relates to that description of hand-mirrors for toilet use and other purposes, in which the frame that holds the glass is elongated at one end, to form a handle, or it may be similarly shaped at both ends. The usual mode of constructing such mirrors is to mount the glass in a solid frame or thin block of wood, either naturally of ornamental character, or afterwards made so by veneering, cut or shaped so as to be of similar contour to the glass, and with a projecting end formed to constitute a handle. Apart from the expense of hand-mirrors so constructed, where a very ornamental appearance is required, there is not only a general want of strength, especially at the neck or junction of the handle with the body, but a great liability to fracture of the glass by the twisting or warping of the wood of which the frame or holder is made. This latter defect is not merely at first, or peculiar to any greenness of the wood or newness of the article, when fracture of the glass from such causes frequently occurs, but is induced at any time by sudden and violent changes in the temperature of the atmosphere, exposure to damp and extreme heat. My improvement obviates such defect, being non-absorbent as regards damp, and free from any liability to warp, at the same time combining beauty with strength at a comparatively trifling cost; and the nature of my invention consists in mounting the glass on a base-piece, of wood or other material, having a stiffening extension running into the handle, and embedding the whole in a composition or cement of suitable description, that, on hardening, forms the back, edges and outside handle of the mirror." The manner of constructing the article is then described, with references to the drawings: "A, is the glass; B, a base-piece, of wood or other suitable material, preferably of similar contour to the glass which is designed to be mounted on it, but elongated at one end, which extension, with a strip of

Clark v. Scott.

metal or other stout material at its back, forms a handle-stiffener, C, to the mirror. This base-piece, with its handle extension or stiffener, C, is then laid in a mould or on a block, face downward, with or without the glass, A, in its place, and a composition or cement of any suitable plastic material, applied in sufficient quantity to cover the back and extend beyond the edges of the base-piece, B, and so as to surround the handle-stiffener or end extension of the latter, when an upper mould, of suitable configuration, and having its interior embellished with any ornamental device or devices, is pressed down upon the cement, which, when hard or dry, on removing the upper mould and lifting the article from the lower one, constitutes a smooth or finished, and, it may be, highly ornamental outer back and handle, D, impervious to damp, exempt from warping, with its consequent liability of fracturing the glass, and preservative of the wooden or other base-piece, which may be of a cheap and rough construction; and that, by its end extension, with strengthening strip at its back, gives not only a general stability to the whole article, but especially stiffens the handle at its junction with the back or body, where it is naturally weakest or most liable to break. The under mould or block may also be embellished with any ornamental device. The glass may either be laid on a cushion of the lower mould, so as to be embedded at its edges, simultaneously with the forming of the outer back and handle, in the plastic composition or cement, or it may be afterwards inserted and restrained to its place on the base-piece, either by an ornamental bead around the edges of the glass, and formed of the same composition or cement of which the outer handle and back are made, or of different material afterwards run around and applied thereto. As I do not desire to confine myself to any particular composition or cement of which to form the outer handle and back, but design to use any plastic substance or compound of suitable character, it will here suffice to state, that a mixture, in equal parts, more or less, of paint, sifted sawdust and shellac, forms a very desirable composition for the purpose,

Clark v. Scott.

and one which readily admits of the color being varied to suit different tastes or demands." The claim is in these words: "I claim, as a new article of manufacture, a hand or portable-toilet mirror, constructed, substantially as described, of a base-piece, B, with its handle-extension piece or stiffener, C, glass, A, and outer back and handle, D, made of any suitable composition or cement, substantially as specified."

The hand-mirror of the defendant is made of a cement applied in a plastic state, and afterwards hardened, and embedded in the cement and concealed from view are two flat wires or strengtheners, made of metal, and running from the body of the mirror part through the neck and into the handle, and serving to stiffen and strengthen the article, particularly at the junction of the handle with the body.

The defendant insists that the claim of the patent must be construed as being for a hand-mirror made by means of a glass mounted on a piece of wood shaped for the glass, and a handle, the handle being strengthened by a strip of iron, and the whole covered with a cement; that the defendant's mirror is a hand-mirror with a composition back, the composition being strengthened by the two wires; that the only office of the wires is to give strength to the back, and they are not, in any sense, the base-pieces or foundation on which the cement is pressed; that, in the defendant's mirror, the composition is the base or foundation, while, in the patent, the wood is the base or foundation; that the defendant's mirror has nothing corresponding to the base-piece, B, of the patent, the two wires corresponding only to the stiffener, C, of the patent; that the base-piece, B, is an essential part of the article claimed, and is claimed in the patent as such part; and that, therefore, the defendant's mirror does not infringe the patent. But, the patent is not fairly susceptible of this limited construction. According to the description, the glass is to be mounted on a base-piece of any suitable material, which base-piece is, at its end, to be elongated or extended through the neck and into the handle, the extension being made sufficiently strong not only to give general stability to

Clark v. Scott.

the whole article, but especially to stiffen the handle at its junction with the body, and the whole being embedded in a suitable cement, applied in a plastic form, and which, when hardened, forms the back, edges and outside handle of the mirror. The defendant's wires act as a base-piece or support for the glass, and the wires extend through the neck and into the handle, and act at the neck and in the handle as stiffeners, and there is an outer back and handle of cement. There can be no doubt that the defendant's mirror is, in its construction, substantially the same as the patented mirror.

Various defences are set up in attack on the validity of the patent. To understand them, it will be necessary to give a history of certain events. The application for the patent sued on was filed on the 6th of August, 1866, the oath to the specification having been made by W. U. Dudley, on the 1st of August, 1866. The specification presented was in the same language as that attached to the patent. The application was rejected on the 23d of August, 1866, as being anticipated by a patent granted to Alanson C. Estabrook, June 19th, 1866. Nothing further was done towards procuring the patent until the 1st of May, 1869, when an argument in favor of granting the patent, notwithstanding the Estabrook patent, was sent to the Patent Office by the attorneys for Dudley. The Office, on the 8th of May, 1869, decided to grant the patent; but, through accident, it was not issued till the 27th of July, 1869.

On the 6th of August, 1866, Dudley filed an application for a patent for an "improvement in brushes," the oath to the specification being made by him August 1st, 1866. The specification said: "In the manufacture of toilet and other brushes, it is customary to insert the bristles in a block or stock, which, by its extension, may be made to form the frame or handle of the brush, and afterwards to cover by veneer the unfinished and usually perforated and wired back that holds the bristles. This is a slow and expensive process, and the article, when completed, is but slightly ornamented by the veneer or outer covering to the back. My present

Clark v. Scott.

invention constitutes a great improvement upon such articles, combining strength with a high degree of ornament, at a cheap cost of manufacture; and the nature of it consists in inserting the bristles through a perforated plate, which is united, by cement, or otherwise, to a back frame of wood, having attached to it a strip of metal or other stiffening material, that runs into the handle of the brush, and that, together with the back frame, is covered by any suitable composition or cement, which, after being moulded, hardens, and forms a compact mass, that constitutes the stock and handle of the brush." The mode of constructing the brush is then described, with references to drawings. A suitably perforated plate or holder, of, say, corresponding configuration to the brushing surface, is taken, and in it are inserted the hairs or bristles, which may be bound and held therein by the usual wire-threading at the back, or otherwise. This perforated plate holding the bristles is afterwards connected, by cement, or otherwise, with a frame and handle constructed as follows: A wooden back, or other suitable base-piece, mainly of similar contour to the perforated plate, but longer, so as to form an extension into the handle of the brush, and having lashed to its back and handle end a strip of metal, or other stiffening material, is inserted in a mould, the form of which embodies the frame or body and handle of the brush, and may include any fanciful design or ornament to the back and handle. In the mould is put any suitable composition or cement, that, after receiving the impression of the mould, hardens into a compact mass, such, for instance as that used in photographic picture frames or cases, including the many well-known combinations of coal tar admixed with various materials, or composition or cement having shellac as a basis. The base-piece, with its stiffener, is so imbedded and pressed in this composition, as that it is not only backed by it, and the composition made to project beyond the edges thereof, so as to form a border to the edges of the bristle holder, but the handle end of said base-piece is entirely covered by said composition or cement, which constitutes the outside frame, back

◀

Clark v. Scott.

or body, and exterior part of the handle of the brush. There is a drawing representing the base-piece with its stiffener before being coated with the cement; and another drawing representing the same after being coated, and, when ready to receive the bristle holder, which, being united by cement with the base-piece, forms one with it. The stiffening strip serves to strengthen the brush where it is naturally weakest, namely at the junction of the handle with the frame or body, and prevents the cement or composition, which, conjointly with the base-piece and stiffener, forms the back and handle, from fracturing at such part, to which it otherwise would be liable. The claim applied for was in these words: "I claim, as a new article of manufacture, a brush constructed substantially as described, that is to say, a brush in which the bristles are inserted through a perforated plate or holder, imbedded in a composition or cement of any suitable substance, as described, which cement shall, in combination with a base-piece and stiffener of metal, or other material, form the back and handle of the brush, substantially as specified." This application was rejected August 23d, 1866, as being anticipated by the said patent granted to Estabrook June 19th, 1866. On the 15th of December, 1866, W. U. Dudley and his father executed to the Florence Manufacturing Company the following assignment: "Be it known, that we, W. J. Dudley and W. U. Dudley, brush makers, in the city of New York, under the firm of W. J. Dudley and Son, in consideration of three thousand dollars, to us paid by the Florence Manufacturing Company, of Florence, Massachusetts, the receipt whereof is acknowledged, do hereby bargain, sell, assign, convey and transfer unto said company, its successors and assigns, all the inventions and improvements in the manufacture of composition brush backs and handles, with suitable strengtheners, made, contemplated, or hereafter to be made, by us or by either of us; also, all applications for a patent now pending or hereafter to be made therefor, by us or either of us; also, one press, three dies and one heater, used by us in said manufacture, with all our useful informa-

Clark v. Scott.

tion for making and selling said composition brush backs and handles, in the best way known to us or either of us, meaning hereby to transfer to said company all our rights to the manufacture and sale of said composition brush backs and handles, and all our implements therefor, and hereby agreeing not to continue the same ourselves, nor to authorize or instruct others so to do ; and we covenant that we have good and exclusive right to convey and transfer the aforesaid invention and property, and that no other person has any right or interest therein, and that we, and each of us, will, at the request and sole expense of said company, its successors and assigns, do all further acts and things necessary and proper to secure any patent or patents for said inventions and improvements, which patents, if allowed, are to be granted to said company for its exclusive benefit."

Before proceeding further it is proper to refer to what is before spoken of as the patent granted to Estabrook June 19th, 1866. It was granted to J. S. Parsons and George A. Scott, as assignees of Estabrook, as inventor, for an "improved brush." It describes a brush in which the bristles, inserted through a perforated plate, are imbedded and held firmly in a suitable cement, which cement, at the same time, in combination with the plate, and an extension of the plate into the handle, forms the back and handle of the brush. As a structure, such brush was not substantially the same thing as the hand mirror of Dudley. The Patent Office so decided, necessarily, in granting the patent for Dudley's mirror, and the decision was proper. The removal from Estabrook's brush, of the plate and bristles, removes also the extension of the plate, which forms the strengthening piece in the handle, and, if a mirror were inserted, in lieu of the plate and bristles, the article would be without a strengthening piece. The cutting off of the bristles would leave no cavity for the glass. The specifications of the Parsons and Scott patent gives no suggestion as to how to construct a mirror like Dudley's.

The hand mirrors sold by the defendant are made by the Florence Manufacturing Company, and they are the real de-

pendants in this suit. The defendant contends, that the company, by the assignment of December 15th, 1866, acquired a right to use the invention covered by the patent sued on. The ground taken is, that the entire invention embodied in that patent is embraced in Dudley's "improvements in the manufacture of composition brush backs and handles, with suitable strengtheners," and in his application for a patent for such improvements; or, in other words, that, as the company have the right to make such brush backs and handles as are described in the application of Dudley, filed August 6th, 1866, for a patent for an "improvement in brushes," they have also the right to make and sell such mirrors as have been sold by the defendant, on the ground that the assignment of December 15th, 1866, embraces the latter right as well as the former right. It is claimed, on the part of the defendant, that the only invention involved in making the mirror covered by the Dudley patent, is in the manner in which the back and handle are made; that the back and handle, when made, are equally ready and suitable for the insertion, in the recess, of a plate with brush bristles or of a mirror glass; that there is no invention in inserting a mirror glass in the recess, or in removing the plate with brush bristles from the recess and inserting in its place a mirror glass; and that the back and handle, with a mirror glass inserted in the recess, cannot properly be treated as a distinct article of manufacture from the article of manufacture consisting of the same back and handle with a plate with brush bristles inserted in the same recess. The sum and substance of these propositions is, that Dudley ought to have applied for and obtained a patent for the back and handle, consisting of the base-piece, handle-extension piece or stiffener, and cement outer back and handle, with a recess, such recess admitting of the insertion in it of a mirror glass, or of a plate with brush bristles, or of anything else; and that he ought not to have covered by his patent the back and handle with the mirror glass in the recess. If such back and handle with the recess had clearly existed before the invention of Dudley, the question as to whether he could

Clark v. Scott.

insert a mirror glass in the recess, and claim a patent for the article thus formed, would arise; or, if such back and handle, with a plate with brush bristles in the recess, had clearly existed before the invention of Dudley, the question as to whether he could remove the plate with brush bristles and insert in its stead a mirror glass, and claim a patent for the article thus formed, would arise. But no such questions arise on this branch of the case. And, if Dudley had patented the back and handle, with a recess unfilled, and had then conveyed to the Florence Manufacturing Company the exclusive right to the invention so far as it could be applied to making brushes, such conveyance would not have carried any right to apply the invention to the making of mirrors or of anything except brushes.

What was the actual state of things when the assignment to the Florence Manufacturing Company was made? Dudley had not only invented the back and handle, consisting of the base-piece, handle-extension piece or stiffener, and cement outer back and handle, with a recess, but had demonstrated its applicability to the making not only of brushes but of hand mirrors. He had applied for a patent for a brush, embodying such back and handle, and had claimed such brush as his invention. He had also applied for a separate patent for a hand mirror, embodying such back and handle, and had claimed such hand mirror as his invention. It is stated, in the specification of the mirror patent, and is manifest, and the evidence shows, that, where the glass in a hand mirror is mounted in a wooden frame, it is liable to be broken by the warping of the wood; and that, in the mirror of Dudley, there is no liability to warp in the frame, and no danger of the fracture of the glass from such cause. It is also shown, that this point of advantage in the mirror does not exist in the brush. Consequently, there is a special function exerted by the mirror back, in protecting the glass from fracture through the warping of the frame, which is not exerted by the brush back. A wooden brush back and handle may be warped and disfigured to the eye, yet its usefulness not be

Clark v. Scott.

materially impaired, while an equal extent of warping in a wooden mirror back and handle would fracture the glass and render the mirror useless. The applications of Dudley were both of them rejected in August, 1866. Less than four months afterwards, the Florence Manufacturing Company, which was at the time making cement brushes but not cement hand-mirrors, applied to the Dudleys and paid them the sum of \$3,000 for the assignment in question. It is limited, on its face, to "brush backs and handles." It only conveys improvements in the manufacture of "brush backs and handles," and applications for a patent "therefor," and information for making and selling "said brush backs and handles," and states that the assignors mean to transfer to the company all their rights to the manufacture and sale of said "brush backs and handles," and agree not to continue the same themselves, or to authorize or instruct others so to do. At that time, the application by Dudley for the mirror patent, as well as his application for the brush patent, were both of them pending. Subsequently, the Florence Manufacturing Company applied to Dudley to execute a paper having reference to mirrors, but he declined to do so. I am entirely satisfied, from the evidence, and the tenor of the assignment made by the Dudleys, that it was in fact, and was intended at the time as, an assignment only of the invention of the brush and of the application for the brush patent.

The mirror, as an article of manufacture, was, in my judgment, patentable, as contradistinguished from the brush, even though the backs and handles of the two were made in the same way. There was, as before explained, a point of utility and adaptability in applying the nonwarping property of the back and handle to rendering the glass of the mirror free from liability to fracture, which constituted sufficient invention to support a patent for the mirror, even though a brush with a like back and handle had existed before. Whether, if the mirror had existed before, a patent for a brush with a like back and handle could be sustained, and whether, the Dudley mirror being patented, a patent for the Dudley brush

Clark v. Scott.

could be sustained, are questions which do not here arise. The Dudley mirror has been patented. The Dudley brush has not been patented.

It is contended, by the defendants, that the neglect of Dudley to prosecute further his application, after it had been rejected, until a period of two years and eight months had elapsed, constitutes an abandonment of the application, or an abandonment of the intention further to prosecute the application. It is not alleged in the answer, that this constituted an abandonment of the invention to the public. The answer only avers, that, after the rejection of the application, for want of novelty in the invention, the plaintiffs "abandoned said application for over two years, well knowing that said Florence Manufacturing Company were making and using this pretended invention, and that the patent afterwards granted was obtained upon false and fraudulent representations by the plaintiffs, or some of them, made to the Commissioner of Patents, and is wholly void in law." The answer does not set up any abandonment of the invention to the public, nor does it set up the defence that the invention was in public use or on sale, with the consent or allowance of Dudley, for more than two years prior to his application for a patent for it. The answer, in the averment cited, is entirely frivolous. The abandonment of an application amounts to nothing, unless it is in such wise as to become an abandonment of the invention to the public; and the allegations as to false and fraudulent representations are too general to raise any triable issue. But the answer does not even aver an abandonment of the application. It avers that the plaintiffs abandoned the application for over two years. It does not set up a conclusive or final abandonment. It implies that the abandonment was only temporary and was made with the intention of resuming the application. The proofs, however, show, that there was no abandonment of the application, or of the invention, and no obtaining of the patent on false or fraudulent representations. Hand mirrors made by the Florence Manufacturing Company in accordance with Dudley's invention, were first put into the

Clark v. Scott.

market in the fall of 1867, which was less than two years prior to the time when Dudley, in May, 1869, again pressed his application. Nor is there any evidence that Dudley had any knowledge, prior to the granting of the patent, that any mirrors made in accordance with his invention had been made by the Florence Manufacturing Company; and, although his co-patentee, Clark, may have known of the making of such mirrors by the company, Clark obtained no interest in the invention until April 30th, 1869.

The only other defence set up in the answer is, that Dudley was not the first inventor of what is patented. It is not set up that he was not its inventor, or that he stole it from another. It is not set up that one Dane invented it, and that Dudley stole it from Dane. That defence was urged at the hearing; but the answer does not suggest it, nor does the evidence sustain it. The defence in the answer is, that the same thing was, before Dudley's invention, known to and used by the Florence Manufacturing Company, A. C. Estabrook, Isaac S. Parsons, and William Gerhard, at Florence, Massachusetts.

Without discussing the details of the evidence, which is quite voluminous, it is sufficient to say, that Dudley fully conceived and described his invention in May, 1865; that he at that time, or a month later, ordered the construction of dies with which to make the mirrors; that the dies were cast in the summer of 1865, and proofs taken from them in plaster of paris by November, 1865; that, prior to November 27th, 1865, Dudley took the dies into his possession, and removed them from Newark, New Jersey, where they were made, to the city of New York; and that, soon afterwards, and during the month of November, he exhibited some backs made in the dies, which backs were complete, and constructed entirely in accordance with the description in the patent. On the 12th of March, 1866, he employed attorneys to procure the patent. He made some samples of finished mirrors in accordance with the invention, but he did not prosecute the business, for want of means. The only date in this series which the defendant

Clark v. Scott.

undertakes to controvert with any show of reliance, is the date of the making of complete backs by Dudley. That date is claimed to have been not in November, 1865, but in January or February, 1866. Then the defendant undertakes to carry back the existence of the same invention at Florence, as made by Gerhard, Estabrook and himself, all or some of them, to December, 1865. But the attempt fails. There was no such invention in the Parsons and Scott patent of June 19th, 1866, taken out on Estabrook's brush, as has been already shown. There was no suggestion of a mirror in connection with the first die made at Florence, which was a die for the brush of the Parsons and Scott patent; and there is no satisfactory evidence that the invention of a mirror like Dudley's was made at Florence earlier than the latter part of February, 1866, if even as early. The burden is on the defendant to make out clearly an anticipation of Dudley's invention. The evidence fails to do this, and there must be a decree for the plaintiffs, for a perpetual injunction, and an account of profits, with costs.

Frederic H. Betts, for the plaintiffs.

Daniel W. Bond, for the defendant.

Heath v. The Erie Railway Company.

JOHN BENJAMIN HEATH AND OTHERS

vs.

THE ERIE RAILWAY COMPANY AND OTHERS. IN EQUITY.

THE ERIE RAILWAY COMPANY AND OTHERS

vs.

JOHN BENJAMIN HEATH AND OTHERS. IN EQUITY.

The bill in the first cause was an original bill. The bill in the second cause was a bill for discovery and relief, and denominated itself a cross bill. The relief prayed in it was, that certain releases and proceedings might be declared to be a bar to any further proceedings in the first cause, and that the bill in that cause might be dismissed, and that an injunction might issue restraining the prosecution of any suit involving the questions covered by such releases and proceedings. The discovery prayed was as to whether such proceedings did not take place, and as to whether the agent of the defendants in the second cause was not present when such proceedings took place. The releases were given, and the proceedings took place, after issue was joined in the first cause. The defendants in the second cause being aliens, and out of the jurisdiction of the Court, and being the plaintiffs in the first cause, the plaintiffs in the second cause, who were the defendants in the first cause, moved, that the subpoena to appear and answer in the second cause be served on the solicitors for the plaintiffs in the first cause, and that the proceedings in the first cause be stayed until the cross bill should be answered. In reply to the motion, such solicitors tendered a stipulation, withdrawing their replications to the answers in the first cause, and permitting such answers to be amended by setting up therein the matters of the cross bill not contained in such answers, or supplemental answers to be filed, setting up such matters: *Held*, that such stipulation made the cross bill unnecessary, as to its prayer for relief, except so far as it prayed for an injunction; that, in that respect, it was an original bill; and that the substituted service asked for could not be made in an original suit.

Held, also, that there was no allegation in the cross bill that it was material the plaintiffs should have the discovery asked; and that, if there were, the discovery was unnecessary, in view of the Act of July 6th, 1862, § 1, (12 *U. S. Stat. at Large*, 588,) and the Act of July, 2d, 1864, § 3, (13 *Id.*, 351,) permitting parties to be witnesses.

Heath v. The Erie Railway Company.

The theory and basis of a bill of discovery in equity, in aid of a defence in another suit, is, that the Court in which such other suit is pending has no means of compelling a discovery from the plaintiff therein, of facts material to the defence.

The motion was denied, but the benefit of the stipulation tendered was given to the defendants in the first cause.

If the defendants in that cause choose to examine the plaintiffs therein by commission, the Court can require that the plaintiffs answer fully all interrogatories put to them, or else debar them from the benefit of their suit.

(Before BLATCHFORD, J., Southern District of New York, January 16th, 1872.)

BLATCHFORD, J. The bill in the second cause, so far as it sets up matters which are alleged to have transpired since the answers to the bill in the first cause were put in, sets up matters which appear to be particularly within the knowledge of the plaintiffs in the second cause, and not at all within the knowledge of the defendants in that cause, except as to one point. The holding of the annual meeting of the stockholders of the company, on the second Tuesday of October, 1871, the laying before that meeting of the report of an investigating committee, and of the releases executed by the company, and of the declaration of trust and agreement executed by the other plaintiffs in the second cause, the adoption by the meeting of a resolution of ratification, the election of directors, and the subsequent execution of a release by the company to the other three plaintiffs in the second cause, are not matters of which it is pretended the defendants in the second cause know anything. The bill alleges that, at such meeting of stockholders, one John Swann was present; that said Swann is the agent and attorney in fact of the defendants in the second cause, and of all the stockholders of the company who are acting in concert with them; and that Swann was, at the time of the meeting, in possession of powers of attorney or proxies empowering him to vote at such meeting on behalf of each and every one of the defendants in the second cause.

The bill in the second cause prays for a discovery from the defendants therein, as to whether such proceedings, acts and resolutions were not had at the stockholders' meeting; as to whether Swann was not present at such meeting, when

Heath v. The Erie Railway Company.

such resolutions were passed; and as to whether Swann was not and is not the agent and attorney in fact of such defendants, and employed by them, as such, to carry on the first cause, and authorized and empowered by them to vote in their names at such meeting.

The bill in the second cause also prays for relief, namely, that such releases and proceedings may be established and declared by this Court to be a full and sufficient bar to any further proceedings, by the defendants therein and all other stockholders of the company, in the first cause, and that the bill in the first cause may be dismissed, and that the defendants and all other stockholders of the company may be enjoined from prosecuting any suit involving the questions disposed of by the action of the stockholders at such meeting.

As a foundation for these prayers, the bill in the second cause, which denominates itself a cross bill, avers, that issue was joined in the first cause on the 2d of September, 1871; that no witnesses have been examined in it, and the time for taking proofs in it has not expired; that the defendants threaten and intend to proceed in it, and to bring it on for hearing in due course, and pretend that no such releases were executed, or that, if they were executed, they are not valid and binding on the defendants; that such releases were properly granted and duly executed by the company, and, with such proceedings, constitute a good bar in equity to the first cause; and that, under the circumstances, the plaintiffs are unable to put such proceedings in issue or to use the same as a plea in bar in the first cause.

The defendants in the second cause being all of them aliens, and none of them being found within the jurisdiction of this Court, the plaintiffs in that cause, who are the defendants in the first cause, move that the subpoena for the defendants in the second cause, who are the plaintiffs in the first cause, to appear and answer, may be directed to be served on the persons who are the solicitors for the plaintiffs in the first cause; and that the proceedings in the first cause may be stayed until the bill in the second cause is answered.

Heath v. The Erie Railway Company.

In answer to this motion, the solicitors for the plaintiffs in the first cause tender to the defendants therein a written stipulation, entitled therein, in these words: "In order to obviate any necessity for a cross bill herein, the plaintiffs hereby offer, by stipulation, to withdraw their replications to the defendants' answers, and permit the defendants, within fifteen days from this date, to amend such answers, by setting up therein such of the matters of the cross bill as are not already contained in the answers, or, if the defendants so prefer, to allow them to file supplemental answers, setting up such matters."

The stipulation tendered makes the bill in the second cause unnecessary, so far as it prays that the releases and proceedings set up may be established and declared to be a bar to any further proceedings in the first cause, and that the bill in the first cause may be dismissed. So far as the bill in the second cause prays that the defendants therein, and all other stockholders of the company, may be enjoined from prosecuting any other suit involving the questions alleged to have been disposed of by the action of the stockholders at the meeting referred to, the bill is not a cross bill, but is an original bill. The substituted service asked for cannot be made in an original suit.

So far as the bill in the second cause is a bill of discovery, there is no allegation that it is material that the plaintiffs should have the discovery. If there were, and if the bill were purely a bill of discovery, and not a bill for discovery and relief also, it would be wholly unnecessary, in the present state of the law. By the Act of July 6th, 1862, § 1, (12 *U. S. Stat. at Large*, 588,) the laws of the State of New York are made the rules of decision, as to the competency of witnesses, in this Court, in trials in equity. By the laws of New York, the plaintiffs in the first cause could be examined as witnesses by the defendants therein, if that cause were pending in a Court of the State. So, also, by the Act of July 2d, 1864, § 3, (13 *U. S. Stat. at Large*, 351,) it is provided, that, in the Courts of the United States, there shall be no exclusion of

In re The Iron Mountain Company of Lake Champlain, a Bankrupt.

any witness in civil actions because he is a party to or interested in the issue tried. So far as the bill in the second cause seeks the discovery of any facts resting in the knowledge of the defendants, it is unnecessary, for the discovery can be had by an examination of them in the first cause. The theory and basis of a bill of discovery in equity, in aid of a defence in another suit, is, that the Court in which such other suit is pending has no means of compelling a discovery from the plaintiff therein of facts material to the defence. I do not deem it a proper exercise of discretion, in these cases, to direct the substituted service asked for, or to stay proceedings in the first cause till the bill in the second cause is answered. But the defendants in the first cause may have the benefit therein of the stipulation tendered them by the plaintiffs therein, and, if the defendants in that cause choose to examine the plaintiffs therein by commission, the Court can require that the plaintiffs answer fully all interrogatories put to them, or else debar them from the benefit of their suit.

David Dudley Field and Dudley Field, for the motion.

William M. Evarts and Charles F. Southmayd, opposed.

In re THE IRON MOUNTAIN COMPANY OF LAKE CHAMPLAIN,
A BANKRUPT.

After the filing of a petition on which I was adjudged a bankrupt, and after the appointment of an assignee, and the conveyance to him of all the estate of the bankrupt, S. commenced a suit, in a State Court, to foreclose a mortgage on real estate of I. The District Court, after restraining the prosecution of the suit, made an order dissolving the injunction, and permitting the suit to proceed. The mortgaged premises were worth less than one-half of the

In re The Iron Mountain Company of Lake Champlain, a Bankrupt.

amount of the mortgage, the mortgage was given long before the bankruptcy of I., and there was no proof of the invalidity of the mortgage. On a petition of review, by I.: *Heid*, that the order of the District Court was proper.

The District Court has power to restrain the holder of a mortgage, or other lien, on the property of a bankrupt, from enforcing such lien by suit; and, where the value of the property exceeds the amount secured by the lien, or the amount or validity of the lien is in doubt, it is, in general, proper to do so.

(Before WOODRUFF, J., Northern District of New York, January 16th, 1872.)

WOODRUFF, J. The bankrupt seeks, by petition of review, to reverse an order of the District Court, which, by the dissolution of an injunction, permits the respondent, Samuel C. Smith, to continue a suit brought in the State Court for the foreclosure of a mortgage upon certain lands of the bankrupt, which suit was commenced after the filing of the petition whereon the Iron Mountain Company was adjudged bankrupt, and after the appointment of an assignee, and the conveyance to him of all the estate of the bankrupt. It appeared, by uncontradicted evidence, that the mortgaged premises were worth less than one-half the amount of the mortgage, so that it was quite clear that the equity of redemption is of no value whatever. There was no proof that the mortgage is not in all respects valid, and it was given long before the bankruptcy of the company.)

There is no doubt whatever of the power of the District Court, in bankruptcy, to take the administration of the entire estate, and ascertain and liquidate liens thereon, and to restrain the holder of a mortgage or other lien from proceeding in any suit to enforce such lien; and, where the value of the property exceeds the amount secured by such mortgage or lien, it will, in general, be proper to do so, in order to preserve to the assignee his right, secured by the twentieth section of the bankrupt law, to receive the excess in value, and release the right of redemption, or to sell the property subject to the mortgage, or to invoke the power of the Court to first liquidate and settle the amount of the lien. So, it

In re The Iron Mountain Company of Lake Champlain, a Bankrupt.

will be proper to restrain the proceeding in any other Court, where the amount or the validity of the lien is in doubt. This may often be necessary to the full protection of the general creditors, who are entitled to such protection in the Court in bankruptcy, where they are to look for the fund to be distributed to them. In all such cases, it would be the duty of the assignee to apply to the Court in bankruptcy, to assist him in bringing all the assets into that Court, to be applied and disposed of according to the rights and interests of all concerned, whether holders of liens or general creditors.

But, where no advantage can result to the estate of the bankrupt, I see no reason why the Court should interfere, when neither the assignee nor any creditor invokes such interference, and it appears, without contradiction, that the equity of redemption is of no value. There is no excess of value to be paid to the assignee on his releasing the right of redemption. There is nothing to be sold subject to the mortgage, which will yield anything; and any action of the District Court, for the liquidation and settlement of the amount of the lien, and for the sale of the property to satisfy it, would be a mere expense to the estate, producing nothing. Under those circumstances, the Court may, I think, properly exercise a discretion on the subject, and may decline interference. The case should be clear, and the proof that nothing can be saved to the estate should be satisfactory; and, if the Court can see that any prejudice to the interests of creditors may happen, it should not permit those interests to be put at hazard by a proceeding to which the general creditors are not parties, and in respect to which they have no protection but through the proceedings in bankruptcy.

Upon the uncontradicted facts in this case, nothing can be gained, and expenses chargeable upon the estate would be incurred, by any interference in the matter. Whether the property, when sold in foreclosure, shall produce one-half, or only one-fourth, of the amount of the mortgage, is not of the least moment. The claimants of the lien, by electing to

The Comet.

pursue the mortgaged premises, will deprive themselves of any right to prove their debt in bankruptcy, for the deficiency, (§ 20,) and, in that view, it may be greatly for the interest of the general creditors to permit such election to be carried into effect, and thereby enhance the dividends to be made to them.

The order of the District Court was a proper one, and must be affirmed.

William C. Holbrook, for the bankrupt.

C. T. Ostrander and *S. M. Ostrander*, for Smith.

THE COMET.

In a collision between two steamers, in the night, the S. and the C., the S. was held in fault for not having any lookout assigned or stationed for the performance of that duty; and for starboarding, instead of porting, when the two steamers were meeting nearly end on; and for starboarding when she saw the red light of the C., a short distance off, a very little on her starboard bow; and for not stopping and reversing.

It being shown that the S. was negligent, she is to be held to clear proof of contributing negligence or fault in the C.

On the evidence, the C. was held not to have been in fault.

(Before WOODRUFF, J., Northern District of New York, January 16th, 1872.)

WOODRUFF, J. The libel herein was filed by the owners of the steamboat *Silver Spray*, for damages caused by a collision on Lake Huron, between their vessel and the propeller *Comet*, in which collision the steamboat was sunk. In the District Court, the libellants obtained a decree for contribution, upon the ground that both vessels were in fault. (1 *Abbott's U. S. Rep.*, 451.) The claimants, owners of the *Comet*, appealed, and the cause has been tried in this Court.

The *Spray*, a small steamboat of 150 tons burthen, was on

The Comet.

a voyage from Goderich, in Canada, on the east side of the lake, to Sarnia, on the east side of the St. Clair river. She left Goderich about 2 o'clock and 45 minutes in the afternoon of the 13th of August, 1869, and took her course south-west by south, (or, by her compass, south by west half-west,) for Fort Gratiot light, on the American or west side, a short distance north of the mouth of St. Clair river. She continued that course until she made the light, directly ahead, when her course was changed to south-west by south half-south, (or, by her compass, south by west,) in order to enter the St. Clair river at the centre of its mouth. While on this course, at a speed of from nine to ten miles an hour, about 10 o'clock at night, and not far from the mouth of the river, green and white lights were seen, (according to the testimony of six witnesses, who were on board,) which bore a little on her starboard bow. These lights, the witnesses say, proved to be on the Comet. The witnesses differ slightly as to the angle of variation from dead ahead. Her master says, one point on her starboard bow; her mate, one half a point to one point; her wheelsman, one half to one point; a passenger, from half a point to a point; her engineer, that it appeared to bear a little to the right of her course; another passenger says, "on the starboard side." After two or three minutes, the master blew two whistles, and, after that, gave an order to starboard the helm, which was done. The change in the bearing of the green light, if any, during that two or three minutes, was so slight, that the mate thought it bore, when the two whistles were sounded, in the direction in which he says he first saw it, namely, from half point to a point on the starboard bow. The master thinks, that, during that interval, if anything, it widened. Having starboarded, the Spray continued under a starboard helm, until the red light of the Comet was seen. According to the testimony of the passenger, who gives its bearing, "it was in the same direction to us, when first discovered, as the green was when first discovered;" and the mate says, that, prior to that, he had not seen any change in the relative position of the white and green lights pre-

The Comet.

vously observed. The master and mate think that the red light was from one to two points on their starboard bow. After seeing the red light of the Comet, then distant, as estimated by the master and mate of the Spray, about 300 feet, the master blew two more blasts of the whistle, and gave another order to starboard, and, immediately after, hard-a-starboard, under the influence of which the Spray swung around two or three points; but no effort was made then or previously to slacken speed, or stop or reverse the engine. The Comet struck the Spray "two or three feet forward of her starboard paddle wheel," the direction of the blow being indicated by the captain as "about seven points between the two sterns." The Comet was a much larger vessel, of over 700 tons burthen, and the injury to the Spray was such that she sank almost immediately after the blow.

The night was clear, and there was nothing in the state of the weather, or of the atmosphere, to justify or explain any mistake or error on the part of either vessel, or excuse any neglect of observance of the rules of navigation, or of the requirements of good seamanship. The Comet was bound from Buffalo, New York, to Green Bay. Passing up the St. Clair River, she arrived, shortly before ten o'clock, at the dock in front of the passengers' station of the Grand Trunk Rail Road Company, near Fort Gratiot, on the west or American side of the river, and stopped to receive a passenger. When about leaving the dock, her officers saw the lights of vessels apparently about entering the mouth of the river, from the lake, which was about 2,300 feet distant from the dock. In order to avoid them, she "sagged" over to the right or Canada side of the river, near to the shore. Moving up, she passed a schooner, nearly opposite what the witnesses call "Sand Point," on the Canada side, at or about the mouth of the river, leaving her about 200 feet off to port, and blowing one whistle as she passed her. Next, and very soon after, she met and passed a propeller called the Fountain City, and, almost immediately afterwards, the propeller Cleveland, giving them one blast of the

The Comet.

whistle as she passed the Fountain City, and leaving them also about 200 feet to port. In avoiding these vessels, the Comet had got into shoaler water than usual, nearer to the Canada shore than the captain had ever been before, and was, according to the testimony, on a course north-east-one-quarter-east, having the red light and two white lights of the Spray on the port bow, and, according to the captain, three or four points on that bow, when he passed the Fountain City. The Comet drew eleven feet, and her captain says: "I starboarded the wheel a little, as I was getting closer to the Canada shore than I had ever been before. I let her (the Spray) come up within a point, or point and a half, on my port bow." The speed of the Comet was about the same as that of the Spray, but, in the river, the current was about three miles an hour—in the lake, the current was less—and the current must be assumed to have reduced somewhat her actual progress. So soon as the Comet had passed the Cleveland, so as to make it apparent that his signal was intended for the Spray, her master blew one whistle, to indicate that each should pass to the right, or port to port, and gave the order to "port half a point and show your red light strong," which, he says, was done, the Spray already, before the change, bearing one and a half points on the port bow. He heard from the Spray the apparent answer, two whistles, and instantly gave the order to stop, and, as rapidly as would give time to execute the order, rang to back, and, as soon as he could feel her back, rang the alarm bell to back strong, and also gave the order to port, and, according to the wheelsman, hard-a-port, under which orders, he says, the Comet swung off three or four points. The Spray having swung around, on her starboard wheel, across the bow of the Comet, the latter, her headway not being overcome, struck the Spray, as already stated.

The testimony of the master, mate, wheelsman, look-out, and engineer, and of one passenger, of the Comet, is to the effect, that, when she passed the propellers, and continuously thereafter, the red light of the Spray was in view over the

The Comet.

port bow of the Comet, until just before the collision, when the *Spray*, swinging around on her starboard helm, brought her green light into view.

The faulty negligence and mismanagement of the *Spray*, and that such negligence and mismanagement were a cause of the collision, was deemed fully established in the District Court; and, on this trial, it is hardly claimed that the conclusion of the District Court on that point is not correct. In fact, the proof of her fault is fully established by witnesses for the libellants, from their own vessel.

The *Spray* had no look-out. There was no person on board assigned or stationed for the performance of that duty. Her master stated, that, upon his watch, he looked out, and the mate, on his watch, looked out. The *Spray* was approaching the mouth of a river navigated by frequent vessels passing each way through the river, from lake to lake. On each side, near the mouth of the river, and up along the shore of the lake, was a railroad, with its depot-houses and switches, with lights, red and green, elevated to signal to approaching trains the condition of the switches, and where colored lanterns on cars, or in the hands of conductors and other attendants, might be expected. In such circumstances, and in view of other suggestions to be presently made, the importance of a look-out exclusively devoted to that duty, and vigilant in its performance, cannot be over-stated; and it will appear, I think, that, had there been a competent and vigilant look-out on the *Spray*, she would not have made the mistake which, I think, she did make, nor the unfortunate manœuvre which produced the collision. Indeed, the proof goes even further. It is not necessary to repeat what has so often before been said, that, in circumstances calling for the watchful vigilance of, a look-out, the master, or the mate, charged with the general management of the vessel, is not competent to act at the same time as look-out. On this occasion, the mate, left in charge by the captain, appears to have been occupied, for more than an hour, in conversation with a passenger; and when, at the usual time, the captain

The Comet.

was called, he joined them; and there is no pretence that either mate or captain discovered the Comet until the passenger enquired of the mate about a green light which he had observed near the centre of the river. In this state of gross inattention, neither the whistle blown by the Comet to signal the schooner, the whistle she gave to the other propellers which she passed, nor, finally, the signal given by the Comet to the Spray, was heard by any one on the latter.

So, also, upon her own testimony, she was in fault in starboarding and persisting therein. Conceding, for the purposes of this point, that, when she saw a green light, it was the green light of the Comet, her testimony is, that it was at about the centre of the river, and her witnesses place it from half point to a point only on her starboard bow. After observing it, according to their testimony, for a period of two minutes, at least, it opened so little, that even the master qualifies his statement by saying, that it widened, if anything. Considering their own speed, of nine or ten miles an hour, this indicated, that, if that light was approaching, it was coming nearly end on. But that is by no means the worst of this fault. Whatever may be true of the green light, if their testimony be taken, they did see the Comet, with her red light in view, distant 300 feet, at least, and bearing very slightly on their starboard bow. To starboard after that, and hard-a-starboard, and rush, with unabated speed, upon almost certain destruction, was recklessness or want of skill, of such degree that no suggestion that peril was then imminent will excuse. They had blown two whistles, as a proposition to pass to the left, and, without any reply of assent, had starboarded. On discovering that the Comet was passing to the right, in obedience to the rule prescribed to steamvessels meeting end on, they made no effort whatever to check the motion of the Spray, but increased the danger by starboarding again. It is palpable, that if, even then, the Spray had either ported, or slowed and backed, and, as I think, also, if she had done nothing, no collision would have happened.

The Comet.

In every view of the circumstances, as presented by her own witnesses, her neglect to slow, stop, and reverse is inexcusable, and, of itself, seems sufficient to account for her disaster, if her actual movements were otherwise deemed justifiable.

This reference to the negligence of the *Spray* is not important as ground for sustaining the like conclusion reached in the District Court. Not having appealed from the decision there, the libellants' conduct is not to be examined here with a view to test the correctness of that conclusion. Such negligence is, nevertheless, important to the further enquiry, whether the *Comet* was also in fault: and, in an apparent conflict of testimony, and an apparent uncertainty as to the accuracy of observations made on the *Spray*, it may be very significant. When the libellants come into Court, themselves showing negligence and want of skill, and seek to cast the burthen of its consequences, in part, upon another vessel, there is some presumption, at least, adverse to their claim; and they may properly be held to clear proof of contributing negligence or fault in the management of the other vessel. Their own negligence sufficiently accounts for their disaster, and it should not be enough that they make the care and skill and good management of the other vessel doubtful.

In this case, after the most careful scrutiny, I cannot escape the conclusion, that there is not so much as doubt. In view of the elaborate and able presentation of the opposite view, in the opinion of the careful, painstaking, and learned Judge of the District Court, it would have been easy to rest upon his analysis of the evidence, and his estimate of its weight; and, as a mere matter of personal choice, I should much prefer to do so, if such choice might have any place in the discharge of duty. But I am not able to concur in his conclusion. A conviction of the injustice of that conclusion is strengthened by each examination of the testimony, and I am bound, therefore, to acquit the *Comet* of fault.

The Comet.

The only two supposed facts which were deemed to indicate fault in the Comet, are, first, that she did not maintain a competent and vigilant lookout; and, second, that, after she passed beyond the two propellers, the Fountain City and the Cleveland, she starboarded, and went across the course of the Spray, to her starboard, and, continuing on that course, showing her green light to the Spray until within a short distance, (the greatest stated by the captain of the latter being 330 feet,) suddenly turned, ported her helm, and attempted to pass again across the bows of the Spray. If the evidence warrants these conclusions, then, undoubtedly, the Comet was in fault.

As to the first, there is no just ground for doubting or denying that the Comet had a man on duty as lookout; and, whatever his general competency, he did see the Spray as soon as, or before, the Comet passed the Cleveland, and as soon as there was any occasion for any manœuvre to avoid her. The captain, also, of the Comet saw the lights of the Spray, when lying at the railroad dock in the river below; and, though then uncertain what the numerous lights then visible indicated, (they, viewed at that distance, suggesting to him and to others on board, that it might be an approaching tow,) he observed them with his glass, made out the different vessels, proceeded to the right hand side of the river, to avoid them, and, before passing the Cleveland, was in full observation of the Spray. He was, therefore, in full charge of the situation, and with full knowledge that the Spray was approaching, and knew her bearing. If he mismanaged after that, the fault was not the want of a competent look out or of a vigilant look out, but his own negligence or want of skill. The mate, also, had like knowledge and observation, as, also, the others who testified to seeing and watching the Spray. Indeed, I do not see what any other lookout could have done, which would have affected the question, when the other officers were cognizant of the approach of the Spray, and were actually taking measures to avoid her. I think the inference of fault in the lookout was, in the mind of the learned Judge

The Comet.

below, connected with the other conclusion, or second alleged fault; that is to say, if, in truth, all on board of the Comet were mistaken in saying that the red light of the Spray bore on them, from the time the Comet passed the propellers, till the instant before the collision, and the Comet did cross the bows of the Spray between her and the Cleveland, so as to show her green light to the Spray, and, therefore, necessarily, to be herself in view of the Spray's green light, and yet no one on the Comet saw that light, then, indeed, the inference that no sufficient and vigilant lookout was kept on the Comet would be warranted. This is, I think, the ground on which the want of a proper lookout was deemed proved. The enquiry into the conduct of the Comet becomes, therefore, reduced to the second allegation of fault above stated; and, on that subject, I observe:

(1.) It cannot be denied, upon the proofs, that the Comet did go up the river on the right hand side, near the shore, and keep off towards the Canada shore, until after she passed the propellers. She passed those propellers in the lake, above the mouth of the river. The mate of the Spray had seen the propellers. One of them had passed him, and he saw her enter the mouth of the river. The Comet passed that propeller on her port side, at a distance of 200 feet. At that time she was on a course northeast one-quarter east, and her red light then, beyond all possible question, was in full view from the Spray. If she then crossed the course of the Spray, between her and the propeller Cleveland, to the starboard of the Spray, so as to change her light from red to green, why was not that movement seen by the mate of the Spray especially, and why not, also, by some other one on the Spray?

(2.) That the Comet did thus cross over between the propeller and the Spray, and, having accomplished that, and so got nearer to her course up the American side of the lake, then, with every motive to continue to move further in that direction, and more fully reach that course, after getting over so as to have the Spray's green light in view, turned back,

The "Comet."

and attempted to recross before the bows of the *Spray*, is, in itself, incredible.

(3.) The master not only regarded an attempt to pass between the *Cleveland* and the *Spray* imprudent, but he and the mate, wheelsman, engineer, lookout, and passenger unqualifiedly deny that any such attempt was made. It is true, that, when he found himself nearer than he had ever before been to the Canada shore, he starboarded a little, so that the bearing of the *Spray* came up a point or point and a half on his port bow. Their combined speed bringing them constantly nearer, she would continue to bear, when they ported, at about the same angle on that bow as before, and thereafter would open further, had she not herself run across the bows of the *Comet*.

(4.) The six witnesses from the *Comet* concur in the statement, that it was the red light of the *Spray* which was in view from the *Comet*; and some of them, from their position when seeing it, could not have seen it at all, if it had not been the red light on the port bow. And here it is to me of special importance that—where there are six witnesses from the *Spray* testifying that they did see the green light of the *Comet*, and they thereby bring the *Comet* over to the west of the course of the *Spray*, and, on the other hand, there are six witnesses from the *Comet* who testify that she was never in any such relative position to the *Spray*, and that the red light of the latter was in full view till near the moment of collision—there is testimony from a disinterested party, an observer of the course of the *Comet*, and of the actual collision, which throws light on the point in conflict. *Maisonville*, the captain of the steamboat *W. J. Spicer*, was, with his boat, lying at the railroad dock, when the *Comet* left it. His view up the river enabled him to see the course of the *Comet*, and her passing the schooner and propellers; and he declares her very near the Canada shore. He saw the *Silver Spray* come down, and he witnessed the actual collision; and, upon his information of the place of the collision, the wreck of the *Spray* was afterwards found and raised. He did not

The Comet.

see any such crossing of the Comet past the bows of the Spray, as is necessarily involved in the libellants' testimony; and it is not credible, if even possible, that he should not have seen it if it happened. And it is strongly corroborative of the testimony from the Comet, in this conflict of witnesses, that Lathrop, a wholly indifferent witness, testifies, that, after the collision, the master of the Spray attempted to account for his not stopping, by saying that he thought he could cross the bows of the Comet, and get on to his own side—the Canada shore,—and that he was heading right on to the Canada shore.

Hereupon, the question presents itself—What is to be believed concerning the master, mate, wheelmen, engineer and two passengers on the Spray, who all say, that they saw the green light of the Comet bearing on the starboard bow of the Spray, and that it so continued till suddenly her red light appeared over the same bow? Are they perjured? My conclusion involves no such necessary inference; and, if they are mistaken, the whole pretence of fault on the part of the Comet is at an end. Their seeing the Comet's red light on that bow tends to confirm the testimony from the Comet, for it was after the Spray had starboarded, and had been moving some time to port, on a starboard wheel, that the red light of the Comet was discovered. It should have been seen before, and then it would have been seen on their port bow. By starboarding, they brought it a little on their starboard bow, just before the collision. They did not see the Comet's green light, as they suppose they did. They saw some other light, and, acting on the assumption that it was an approaching vessel, they now say it was the green light of the Comet. A careful examination of the testimony shows, I think, conclusively, that, unless the Comet crossed the course of the Spray, so as to exhibit a green light, she is without fault. The testimony of her witnesses is positive and has confirmation in the testimony of Maisenville and Lathrop, already referred to. The testimony from the Comet seems also to me to be consistent, natural and credible.

The Comet.

There was less liability to mistake. From the Comet, looking outward towards the lake, there was no other vessel or lights in view. Her officers and others on board had, therefore, nothing to distract their attention or mislead them. On the other hand, the view before the eyes of those on the Spray presented many lights. Her wheelsman had covered the compass and was endeavoring to steer his ship by colored lights which were, or which he supposed were, on shore. He selected a red light on the Canada shore, supposing it, no doubt, one of the semaphore lights along the line of the railroad. The counsel for the claimants suggests that this was the red light of the Comet. Who shall say it was not? By covering his compass, he had rendered it impossible to detect his mistake, if he made that blunder. And who shall say, that, if he was steering by a red light off his port bow, he did not mistake one of the green lights on shore for the green light of the Comet, and then, when, by starboarding, he brought the red light of the Comet in fact just over the starboard bow, conclude that it was a red light on the same vessel on which he had seen the green? But, more plausibly still—the W. J. Spicer, lying at the railroad dock, exhibited her green light fully to the view of the Spray. That view was a little, and but a little, to her starboard, as her course and position, and the direction of the river, and the line of sight to the dock distinctly show. The assumption that it was this green light which was seen on the Spray, accounts for two circumstances of no little importance, in explaining the conflict of testimony, besides disposing of the main dispute as to the course of the Comet. First, the distance at which the master of the Spray thinks he first saw the green light of the Comet. He makes it much greater than is consistent with the witnesses from the latter vessel. Now, the dock of the railroad company, where the Spicer lay, is over one third of a mile below the mouth of the river; and, seeing the green light there, he would, of course, estimate the distance as greater than in fact he was from the Comet, which he did not then see. Second, it seems extraordinary, and yet

The Comet.

is testified by the witnesses from the Spray, that the green light, which they say was the Comet's light, was first seen from half a point to a point on their starboard bow; and yet, notwithstanding, upon their theory, the two vessels were approaching each other at a combined speed of from 12 to 16 miles an hour, they observed it two or three minutes, and it opened so little, that the captain speaks of it as "widening, if anything," and other witnesses create doubt whether it changed its bearing at all, and the utmost suggested is, that its starboard bearing reached two points. This is incredible, if it was borne by the Comet on a course crossing the bows of the Spray to the starboard enough to keep a green light in view, but is not only not extraordinary, but inevitable, if the green light was on the Spicer, lying still, and the Spray was on a course to the centre of the river, in a line very slightly varying from a direct line to that light.

It is not certain that this was the mistake which they made; but their want of look out, the inattention of the officers when on duty, the actual fault in what they did, whether it was the green light of the Comet or not, and their neglect of the obvious precaution to slacken speed, prepares me for the conclusion to which the other evidence compels me, that some such mistake was made.

In what I have written I have aimed at giving an intimation of the grounds of my conclusion, rather than at discussing all the details of the testimony. No doubt, there are some of those details, not adverted to, which conflict with the conclusion. So, on the other hand, there are many other particulars, which might be stated, which go to sustain it. The counsel on both sides have presented them fully, and I have not failed, I think, to give them due consideration. To recite and discuss each in writing would involve labor which would be of no profit to counsel already familiar with the whole. For them, it might have been sufficient to state my conclusion without any reasons, and leave them to infer that I was convinced by the argument. It seemed to me just, however, to say enough to point to the prominent reasons, which, on

Merriam v. Drake.

examination and re-examination of the testimony, have forced upon me the conviction, that the Silver Spray is alone in fault, and that the libel of her owners, filed herein, should be dismissed, with costs.

George B. Hibbard, for the libellants.

John S. Newberry and *Henry B. Brown*, for the claimants.

JOHN O. MERRIAM AND EDWIN CHAMBERLIN

vs.

FRANCIS DRAKE. IN EQUITY.

The claim of the reissued letters patent granted to John O. Merriam and Edwin Chamberlin, as assignees of Charles B. Morehouse, the inventor, July 12th, 1870, for an "improvement in whip-sockets," the original patent having been granted to said Morehouse February 6th, 1866, namely, "The whip-socket, B, having permanently attached thereto the stationary jaw or clamp, E, in combination with the detachable jaw or clamp, G, whereby the said whip socket may be fastened to, and connected with, the dash-board rod of a carriage or other vehicle, substantially in the manner and by the means herein described and set forth," is a claim to a whip-socket having, at the top and bottom thereof, metal rings or flanges, for the purpose of giving support and strength, with a stationary jaw of a clamp permanently attached thereto, and a detachable jaw, to be applied to clasp the rod of the dash-board, the detachable jaw forming, in connection with its fellow, a mouth or double jaw, which can be slid off and upon the object to which it is to be fastened, and made tight thereon by the single screw which holds its outer end to its fellow.

Such form of clamp allows the whip-socket to be made fast to the dash board rod without perforating the leather thereof.

Such claim is not infringed by a whip-socket which has no rings or flanges, and has a substantially different clamp, requiring the perforation of the leather of the dash-board to admit of its application thereto.

(Before Woodruff, J., Northern District of New York, January 16th, 1872.)

THIS suit was founded on reissued letters patent of the United States, granted to the plaintiffs, as assignees of Charles B. Morehouse, the inventor, July 12th, 1870, for "an improvement in whip-sockets," the original patent having been granted to said Morehouse February 6th, 1866. The specification said: "The nature of the said invention and improvement consists in the use of a whip-socket, having permanently attached thereto a suitably shaped extension or extensions, adapted to fit the dash-board rod of a carriage or other vehicle, in combination with one or more screw-caps, whereby said whip-socket may be securely fastened to the dash-board rod, substantially in the manner and for the purpose hereinafter more fully described and specified." It described the construction and operation of the invention as follows: "The whip-socket, B, may be made in any usual shape, and of any material desired, having at the top and bottom thereof metal rings or flanges, D, which are for the purpose of supporting and strengthening the whip-socket, B, and form part thereof. To these rings or flanges, D, are securely and permanently attached the stationary clamps, E. These clamps, E, should be of proper shape and size to conform to the dash rod. The clamp, G, is made of malleable cast iron, or other metal, and, in size and shape, to correspond with the stationary clamp, E. The operation of the improved fastening is as follows: The whip-socket, B, is placed against the dash-board, A, the stationary clamps, E, fitting closely against the dash-board rod, K. The clamp, G, is then placed against the said dash rod, K, opposite to the stationary clamp, E, and then, by means of a screw or screws, or other mechanical means, the said clamps are forced together, securely clamping, clasping, and grasping the dash-board rod, K, thereby securely holding and fastening the whip-socket, B, in its proper place and position, yet detachable at pleasure." The claim was in these words: "The whip-socket, B, having permanently attached thereto the stationary jaw or clamp, E, in combination with the detachable jaw or clamp, G, whereby the said whip-socket may be fastened to, and connected with,

the dash-board rod of a carriage or other vehicle, substantially in the manner and by the means herein described and set forth."

Esek Cowen, for the plaintiffs.

John B. Gale, for the defendant.

WOODRUFF, J. It will be seen, from the description and claim of the patent, that the patentees do not claim that either of the parts which make up their improved whip-socket is new. The whip-socket itself may be made in any usual shape, and of any material desired, having, however, at the top and bottom thereof, metal rings or flanges, plainly indicating, as, also, the plaintiffs' proofs in regard to the previous state of the art show, that whip-sockets for sustaining the whip, and attached to the dash-board rod, were not new, but were precisely what the patentees claim to have improved. And there is no claim, obviously there could be none, that clamps were not well known and common devices for clasp-ing and holding, permanently or temporarily, as the case might require, whatever might be placed between the two jaws thereof. Nor is the feature, that one jaw is permanent or fixed, and the other movable and detachable, claimed to be, in itself, novel. The manner in which parts of machinery are clamped by a double or single jaw; the well known clamping tools of the joiner, the cabinet-maker, the shoe-maker, and the blacksmith; the common device of a clamp connected with, and forming part of, various articles in domestic use, to fasten them to a table, or to a fixture, as, for example, the common reel, the needle cushion, and like articles found in the shops, and in the use of the seamstress or embroiderer—is familiar. Nor could the patentees claim the use of a clamp generally, as a means of attaching a whip-socket to a dash-board. That would be claiming, as an invention, the mere application of an old device to a new use, which, by itself alone, is not the subject of a patent.

In view of the state of the art, and of the want of any pretence, in the specification or claim, that either of the parts are new, the claim of the plaintiffs' patent must be construed to be for a whip-socket constructed substantially as described, that is to say, having, at the top and bottom thereof, metal rings or flanges, for the purpose of giving support and strength, with a stationary jaw of a clamp permanently attached thereto, and a detachable jaw, to be applied, by some mechanical means, so as to clasp the rod of the dash-board; and, as clamps are of various form and manner of application, the precise form and mode of attaching the detachable jaw in the plaintiffs' patent is carefully exhibited in the drawings, where it is exhibited as forming, in connection with its fellow, a mouth or double jaw, which, (like the clamp attached to a lady's pin and needle cushion) can be slid off and upon the object to which it is to be fastened, and made tight thereon by the single screw which holds its outer end to its fellow. It is a whip-socket having this combination, and the devices employed to adapt each part to its place and office in the combination, that is secured to the plaintiffs by their patent; and, each part being old, the plaintiffs could not, and do not, by their patent, close the door to any other combination of these old elements, or to any other mode of combining them which is not substantially like that employed by the plaintiffs.

The office, as well as the advantage, of the form of clamp specified by the plaintiffs as a part of their whip-socket, is shown by the evidence, as well as by the specification annexed to the original patent, of which the patent relied upon is a reissue. It was deemed important, that the whip-socket should be so constructed that it could be made fast to the dash-board rod without cutting, perforating, or injuring the leather which constitutes the dash-board. That was the chief feature in the patent. Other patents existed for fastening a whip-socket by means of a metallic clamp differing but little from the one used by the plaintiffs; but the application thereof to the dash-board rod involved the cutting or per-

forating of the leather, to permit one jaw of the clamp to pass through, so as to embrace the rod, when the socket was in its proper position. Accordingly, the specification and drawings of the original patent, and of the reissue, describe, exhibit, and refer to a peculiar arrangement of the jaws of the clamp, so that, at one end, they are held together and tightened by the clamp-screw, and, at the other end, are open, to be slid sidewise upon the rod, before the screw is made tight; and they may be removed in like manner, without disfiguring the leather of the dash-board.

I do not suggest that such a whip-socket, made up of these several parts arranged and adapted to each other in the manner described, was not a patentable device. Its peculiar arrangement of the parts, and their adaptation to the purpose in view, probably made it something more than a putting of an old device to a new use; but the patent stands upon rather narrow ground. It does not cover every possible mode of clamping a whip-socket to a dash-board, but, at most, only a mode which is substantially the same.

The defendant does not use or sell such a whip-socket as is described or referred to in the plaintiffs' specification, nor one that is at all like it. His socket consists of two parts hinged upon each other, so as to open and close at the top and bottom alternately, as the whip shall be inserted or withdrawn. It has no rings or flanges at the top or bottom, nor elsewhere thereon. Indeed, rings or flanges could not be placed thereon at all, without destroying its chief and peculiar characteristic, namely, the opening thereof at the top, to receive the whip, and the closing thereof around the whip when it is thrust to the bottom, and opening, in turn, when the whip is withdrawn. The defendant does not, therefore, use the plaintiffs' rings, nor any equivalent device, for either would be impracticable. The rings in the plaintiffs' whip-socket serve a double purpose. They strengthen the socket, and are its sole support, and are the base of the clamps, by an extension thereon forming the permanent jaws. The whip-socket used or sold by the defendant has not, and can-

not have, any such rings. It is made of sufficient strength to render them unnecessary for either strength or support. It will not avail the plaintiffs to say, that, by making the defendant's socket of a form, or thickness, or strength sufficient to render the rings unnecessary, the defendant does employ an equivalent. Not so. He dispenses with the plaintiffs' device altogether. He has no need to use it, and is unable to use it. He has contrived another mode of giving strength and support, and has provided, in such other mode, for attaching it to the clasp which he employs to secure it to the dash-board. It is not true, that a device is necessarily equivalent to another, merely because it effects the same result. The whole field of invention is cultivated with a view to devise other and new modes of effecting results that are known and common. The defendant does not use or sell a whip-socket having a clamp substantially like that which is described in the plaintiffs' patent. True, he fastens the whip-socket to the dash-board rod. That is the result attained by both. But, as already, in substance, suggested, the plaintiffs have not secured to themselves a monopoly of the result, but only of the special means of accomplishing it, in the combination constituting the whip-socket described, and such other means as are, in the combination, equivalent thereto. To one side of the body of the defendant's whip-socket are permanently attached projections, with outward curved faces, fitting the side of the dash-board rod, and, on the outer side of the rod, a strap of metal, also curved, is applied to the rod, and, by a screw at each end, passing to the projections first named, this strap is drawn down upon the rod and clasps it, drawing the inner projections on the socket firmly against the rod. This part of the defendant's whip-socket is not like that of the plaintiffs in form, nor in mechanical structure, nor in mode of operation, nor in its result, except only that it does fasten the whip-socket to the rod. It requires that the leather of the dash-board be cut or perforated, to allow of its application. It cannot be slipped upon the rod sidewise, and so removed at pleasure. It cannot be moved from one

Platt v. The U. S. Patent Button, Rivet, Needle and Machine Manufacturing Co.

position to another, slid up or down, without new perforations of the leather, with each change of position, thus disfiguring the dash-board. In short, the defendant's whip-socket, with its adaptation to use, is a different organization, and constitutes no infringement of the plaintiffs' patent.

The bill of complaint must be dismissed, with costs.

CLARK M. PLATT

vs.

THE UNITED STATES PATENT BUTTON, RIVET, NEEDLE AND
MACHINE MANUFACTURING COMPANY. IN EQUITY.

The letters patent granted to Clark M. Platt, July 10th, 1866, for an "improvement in buttons," are valid.

The claim of the patent, "The button, formed of a single piece of metal, with the edge turned over, and with one central hole, as a new article of manufacture, as specified," covers a button formed of a single thickness of metal, with the edge folded over upon the body of the metal, and with one central hole, capable of being used for a single rivet or eyelet, to fasten the button to the garment.

Such button is not anticipated by a button having the single piece of metal and the folded edge, but no central hole; or by a button in which the edge was not folded over upon the body of the single piece of metal; or by a button not made of metal; or by a button not made of a single piece of metal; or by a button made of a single piece of metal, with its edge folded over on the body of the metal, and with two, three or four holes, so as to be attached to a garment by sewing; or by a button made of more than one piece of metal, in which the edge of one of the pieces of metal is folded over upon the other parts which make up the thickness of the button, and not upon itself.

(Before BLATCHFORD, J., Southern District of New York, January 18th, 1872.)

BLATCHFORD, J. This suit is brought on letters patent of the United States, granted to the plaintiff July 10th, 1866, for an "improvement in buttons." The specification says:

Platt v. The U. S. Patent Button, Rivet, Needle and Machine Manufacturing Co.

"Buttons have heretofore been made with a hole in their centre, to receive a rivet that is passed through the garment. Said buttons have been made by uniting two thicknesses of metal at the edges, with a piece of paper between them. This mode of making is costly. Buttons have also been made of one piece of sheet metal, but the edge of the button formed by the thin sheet metal is sharp, and renders the button objectionable. My invention relates to a button which is a new article of manufacture, being made of one piece of metal, the edge of which is thickened by being folded over on itself, and the centre is perforated with one hole, for the reception of a rivet or eyelet passing through the garment and button, and riveted up to fasten the button to the garment." Then follows a description of the button, with references to the drawings. The edges of the disc or button blank are first turned back and then folded down on the button itself. The centre of the button is perforated for the reception of the rivet, the surface of the button is struck down, to increase its ornamental appearance, and the edges of the hole may be raised or pressed forward, so as to raise a burr, which will cause the metal of the button to sit tightly around the rivet. The button may, however, have a plain, central hole, adapted to a rivet, eyelet, or other fastening. The edge of the button may be turned forward instead of back, in either case making the edge of the button sufficiently thick and smooth for use, in consequence of the double thickness and fold at the edge. A conical hole or burr around the central hole is disclaimed. The claim is: "The button, formed of a single piece of metal, with the edge turned over, and with one central hole, as a new article of manufacture, as specified."

There can be no doubt of the great utility of the button covered by the patent. The folding over of the edge of the single thickness of metal of which the button is made, upon the body of the metal, thickens the edge and thus enables a light weight of metal to be used, while the edge of the button is strong and smooth. These features, with the central hole, make up the button. It has a light weight of metal, and is,

Platt v. The U. S. Patent Button, Rivet, Needle and Machine Manufacturing Co.

therefore, cheap to make. It has but one piece of metal to be handled, and is therefore cheap to make. The folded edge has the thickness and smoothness of the edge of a button made of two pieces of metal. The button can be attached without sewing and by a single rivet. The button sold by the defendants is identical with that of the patent.

The defendants have attacked the patent for want of novelty, but have wholly failed in such defence. It is not shown that any button made of a single piece of metal, with the edge folded over upon the metal in the body, and with a single central hole, existed before the invention of the plaintiff. This remark applies to the patents granted to Willoughby H. Reed, November 15th, 1864, and June 6th, 1865; to the application of Kosman Rose, of April 29th, 1858; to the application of John P. Jamison, of October 16th, 1860; to the patent granted to Festus Hayden, July 10th, 1840; to the patent granted to Henry S. Poole, August 11th, 1841; to the patent granted to P. Davey, November 29th, 1859; to the application of Samuel Cantrell, of February 22d, 1865; to the application of Samuel B. Fay, of August 13th, 1856; to the patent granted to Philander H. Benedict, March 14th, 1865; and to the patent granted to Edwin Smith, April 16th, 1861. Some of the prior buttons contain one or two of the three features of the plaintiff's button, but all of such features are not found combined in any one of the prior buttons. Those features are—the single thickness of metal—its edge folded over on its body—the central hole, capable of being used for a single rivet or eyelet, to fasten the button to the garment. Thus, the Rose button has the single piece of metal and the folded edge, but no central hole. In the Jamison button, the edge is not folded over upon the body of the single piece of metal, nor is it in the Reed button of 1864, or in the Hayden button, or in the Davey button, or in the Poole button. The Fay button is not made of metal. The Smith button is not made of a single piece of metal, nor is the Reed button of 1865. Nor is the plaintiff's button anticipated by a button made of a single piece of metal with

Day v. The Bankers' and Brokers' Telegraph Company.

its edge folded over on the body of the metal, and with two, or three, or four holes, so as to be attached to a garment by sewing; or by a button made of more than one piece of metal, in which the edge of one of the pieces of metal is folded over upon the other parts, which make up the thickness of the button, and not upon itself.

There must be a decree for the plaintiff, for a perpetual injunction and an account of profits, with costs.

Gilbert M. Plympton, for the plaintiff.

Charles A. Durgin, for the defendants.

SAMUEL F. DAY AND HENRY A. MANN

vs.

THE BANKERS' AND BROKERS' TELEGRAPH COMPANY. IN
EQUITY.

The second claim of the reissued letters patent granted to Samuel F. Day, March 23d, 1869, for an "improvement in electro-magnetic telegraph," the original letters patent having been granted to him May 24th, 1864, namely, "The arrangement of the sounding box, C, the lever, D, and the sounding post, G, of a magnetic telegraph, in combination with each other, in the manner hereinbefore described, and to the effect stated," is void, for want of novelty.

The combination covered by such second claim is one which is capable of being used either in a local current, or in a main line current, and is not claimed merely when used where a local battery is dispensed with.

The use of such combination in a local current would be an infringement of the claim; and the prior use of the arrangement in a local current is an answer to the claim.

The combination claimed is the arrangement of the sounding box, lever, and sounding post, relatively to each other, so that the blow of the armature will be struck directly towards the box, so as to produce a vibration of the box,

Day v. The Bankers' and Brokers' Telegraph Company.

and consequent sound, by direct action, and so that the sound produced by the blow will be more audible than if the blow were not struck at all in connection with a box or hollow base, but were struck in connection with a solid base, or were struck in connection with a box or hollow base, but not directly towards it.

Such an arrangement existed previously, though in a small instrument, used only in a local current, the box and the magnet being small, and the sound feeble; but, the absolute parts, and their relative arrangement, and their action, and their effect, remaining the same, it required no invention to make the box larger, to produce more sound, so as to use it in a longer circuit, with a larger and heavier magnet.

(Before BLATCHFORD, J., Southern District of New York, January 20th, 1872.)

BLATCHFORD, J. This suit is founded on reissued letters patent granted to Samuel F. Day, one of the plaintiffs, March 23d, 1869, for an "improvement in electro-magnetic telegraph," on the surrender of original letters patent granted to him May 24th, 1864. The second claim of the patent is the only one in question in this suit. The specification says: "This invention relates to a certain improvement in Morse's electro-magnetic telegraph, which dispenses with the use of local batteries and relays at the several stations on the line; and it consists, in part, in the adaptation to, and combination of, an indenting register with the main line. Said invention also consists in the arrangement, in combination with the other parts of the instrument, of a sounding box, in the manner hereinafter set forth, by which the audibility of the sound produced by the blow of the registering lever is very much increased, thus enabling the operator to catch the sounds with much greater facility, in case he desires to read a message by sound." The specification then proceeds to describe the construction of the apparatus, with references to the drawings. So far as the improvement covered by the second claim is concerned, the arrangement is this: There are two electro magnets placed in a vertical position, and surrounded by a sounding box, C. D is a lever, with a pin or arm projecting downward from its under side. This lever is attached to an arbor and is centred between two thumb-screws, which terminate in a standard, E. An adjustable thumb-screw,

Day v. The Bankers' and Brokers' Telegraph Company.

with a steel point, F, is attached to that portion of the lever, D, which is represented in the drawings as being bent downward. The opposite end of the lever terminates between a standard, G, provided with suitable thumb-screws for adjusting said lever according to the strength of battery on the main line. The lever, D, is hung on the standard, E, at about two-thirds its length, taken from the right hand end of the lever. A spiral spring is made to fasten on the arm or pin of the lever, D, the tension of which is regulated by a thumb-screw, around the shaft of which a fine cord is wound, which cord passes through the centre of the standard, G, and connects with said spiral spring. The object of such spiral spring is to withdraw the armature on the lever, D, from the electro-magnets, when the circuit is broken. The apparatus is provided with clock-work machinery, to feed continuously paper which is to be marked by the indenting register. When the circuit is closed, and the armature is attracted to the magnets, the steel point, F, is forced into the moving paper, and produces on it strokes or dots. The specification then states, that it is necessary to the success of the instrument in a main line current, not only that the fulcrum of the lever, D, should be placed as near as practicable to that end of the lever which carries the steel point, F, but that the magnets should, instead of being made of No. 22 wire, be made of No. 32 wire, and instead of being made of a weight of from four to eight ounces of wire, be increased to from twenty ounces to two pounds in weight, and that the length of the cores should be increased to about three inches, and their diameter to three-eighths or one-half of an inch. The specification proceeds: "By constructing my apparatus in this manner, I am enabled to work an indenting registering instrument in a main line circuit of any ordinary length, without the intervention or aid of a local battery, and by this means I entirely avoid the expense and trouble of the latter. This might, perhaps, be done by the change in the construction of the magnet, without changing the lever from an equal beam, but I prefer to construct the lever in the manner de-

Day v. The Bankers' and Brokers' Telegraph Company.

scribed, as it very materially aids in the accomplishment of the result. The combination with a registering instrument, of a magnet constructed as I have described, enables the line current to operate upon the instrument with great intensity, and this intensity well supplies the place of the volume derived from the local battery, by which it is now customary to work such instruments. The object of the improvement being to work an indenting-registering instrument by the power of the main line current, it is obvious that the nature and gist of the invention consist in giving to the parts such a construction as to cause this current to act upon the instrument with sufficient intensity to properly indent the paper for ordinary business purposes, on a line of ordinary or equivalent construction and length, in such a manner as to be available for the ordinary purposes of telegraphing, and that the line of distinction between this invention and the old form and manner of construction, is found in the adaptation of the instrument to the successful accomplishment of this purpose, of which it was before incapable. It will be observed, that the fulcrum post, E, and the sounding post, G, are set upon the top of the box, C, instead of being attached directly to the bed-plate of the machine, as in the construction now in common use. The object of this improvement is to make the sound produced by the blow of the lever more audible, which result it accomplishes in a very satisfactory manner, thus enabling the operator, if qualified, to read by sound, if desirable, under circumstances in which it would otherwise be difficult, if not impossible. It will be observed, that the sounding post, or part upon which the blow is struck, is so attached to the sounding box, C, and the other parts are so arranged in connection with it, that the blow is struck directly toward the box, in such a manner as to produce vibration thereof by direct action; that is to say, a tangential line, drawn from the arc in which the armature vibrates, at the point at which the blow is given, would intersect the box, making the action of the blow direct, in producing the vibration and consequent sound. It is only in this way that

Day v. The Bankers' and Brokers' Telegraph Company.

the full effect of the blow, in producing the sound for reading the message, can be realized. I am aware that an instrument has before been constructed, in which the coils have been placed longitudinally above a similar box, and the blow struck in a line parallel to the top of the box, and passing outside of and above said box; but this does not accomplish the purpose of my invention, as the action of the blow is not and cannot be direct, but is only incidental, and does not have that effect in developing sound from the box, which a direct blow would have." The claims are these: (1.) "I claim combining with an indenting telegraphic registering instrument, a magnet constructed according to the proportions described in the foregoing specification, or substantially so, so as to accomplish the result stated, by means substantially the same, that is to say, so as to give sufficiency of intensity and power of action to produce uniformly legible indentations in the paper, in an ordinary line current, without the aid of a local battery, as hereinbefore set forth." (2.) "I also claim the arrangement of the sounding box, C, the lever, D, and the sounding post, G, of a magnetic telegraph, in combination with each other, in the manner hereinbefore described, and to the effect stated."

The principal defence urged, in respect to the second claim of the patent, which is the only one alleged to have been infringed, is its want of novelty.

There can be no doubt, from the language of the specification and claim, and from the evidence, that, while the combination specified in the first claim is one for use only in a main line current, when a local battery is dispensed with, the arrangement or combination covered by the second claim is one which is capable of being used either in a local current or in a main line current, and is not claimed merely when used where a local battery is dispensed with. The combination in the second claim is claimed "in the manner hereinbefore described, and to the effect stated." The "manner" is the arrangement of the sounding box, lever, and sounding post, relatively to each other, so that the blow of the arma-

Day v. The Bankers' and Brokers' Telegraph Company.

ture will be struck directly towards the box, so as to produce a vibration of the box, and consequent sound, by direct action. The "effect" is, to make the sound produced by the blow more audible than if the blow were not struck at all in connection with a box or hollow base, but were struck in connection with a solid base, or were struck in connection with a box or hollow base, but not directly towards it. This arrangement or combination, in the second claim, is applicable as well to a local current, produced by a local battery, as to a main line current, where a local battery is not used; and the use of the arrangement in a local current would undoubtedly be an infringement of the claim. Hence, the prior use of the arrangement in a local current is an answer to the claim.

The evidence is clear, that the arrangement or combination, in the second claim, of the sounding box, lever, and sounding post, with the blow struck directly towards the box, was in use, as a successful, practical telegraphic instrument, a considerable time before the invention of Day. To say nothing of any other apparatus, that represented by Exhibit No. 6 was so in use. It produced the "effect" stated in the specification, of making "the sound produced by the blow of the lever more audible" than it would be with a solid base. It was known by the name of the "Chester sounder." It had, and could have, no other object than to make more sound than would be made by a solid base, the base being a box made hollow, and the blow being struck directly towards the box. The instrument was small, and the box was small, because it was intended for use, and was used, only in a local current, and the magnet was small, and the sound was feeble, at most. But the moment the occasion arose for using an instrument that would make more sound, the production of more sound, by making the box larger, was obvious, and was no invention. It was only the difference between a large drum and a small drum. The absolute parts, and their relative arrangement, and their action, and the effect, are the same in the patent as in the Chester sounder, only the sound is louder, because the box is larger. The Chester sounder

Day v. The Bankers' and Brokers' Telegraph Company.

produced more sound with its box than if the base had been solid. Day's apparatus produces more sound than Chester's, but only because the box is larger. The difference is one merely in degree, not in patentable substance.

The date of the existence of the Chester sounder is carried back to 1858 or 1859—a time anterior to the invention of Day. In the shape in which it then existed, it continued to be used until quite recently. It was a complete and successful instrument, and was used in telegraph offices in various parts of the United States, in local circuits. The instrument was placed upon a box, the coils were set in a perpendicular position, the lever was horizontal, the blow was struck on the end of a sounding post, in a direction towards the box, and the sounding post and the supports of the lever centres were fastened to a metallic plate, which plate was screwed to the top of the box. When the circuit was closed, the lever was drawn down, and struck the sounding post, and the blow produced a sound which was louder, because the sounding post was attached to a box, instead of being attached to a solid base. The combination of parts, their arrangement relatively to each other, the direction of the blow, and the effect in sound, were the same, in substance and in kind, as in the combination covered by the second claim of the Day patent. The instrument was not practically applicable to a long line or main circuit, but only to a local circuit, or a line a few miles in length. But the difference between a main circuit and a local circuit is merely one of length. It is shown that, the larger and heavier the magnet, the greater the range of length of line on which the Chester sounder would work, and the larger the box, the louder the sound. I cannot resist the conclusion, from the evidence, that Day's sounder is merely the Chester sounder, adapted, indeed, for use on a main circuit, by having a larger magnet and a larger box, and its other parts proportionally enlarged, but the combination of parts, their mode of operation, and their result in kind, as claimed in the second claim of the patent, remaining the same as in the Chester sounder. It may, perhaps, be, that Day invented something, in connec-

Webb v. Quintard.

tion with the sounder, which he can patent by a proper claim. But, what he has patented, in his second claim, existed before, in the Chester sounder. He merely claims the sounding box, lever, and sounding post, in combination with each other, to make a louder sound when the lever strikes the sounding post, by reason of the apparatus being set on a hollow box, instead of a solid base, and the blow being struck directly towards the box. The three parts are not claimed in combination with any particular magnet, or with any other part of the apparatus. They are not claimed in combination with a larger magnet, to work in a main line circuit, (if such a claim could be made,) but are claimed only in combination with each other, to make a louder or more audible sound in any circuit, long or short, and with any size of magnet—to develop sound from a box, by a blow struck directly towards the box.

The result is, that the bill must be dismissed, with costs.

Thomas P. How, for the plaintiff.

Charles H. Wesson, for the defendants.

WILLIAM H. WEBB AND CHARLES W. S. HEATON

vs.

GEORGE W. QUINTARD. IN EQUITY.

The letters patent granted to Charles W. S. Heaton, April 14th, 1863, for an "improved defensive armor for ships and other batteries," are void, for want of novelty.

In 1861, a description and drawings were published in a printed publication, in England. From those, the United States, in 1863, caused to be constructed and placed on a vessel, armor like that claimed in the patent of Heaton, one of such drawings being practically the same thing as the armor placed on such vessel. Heaton conceived the idea of his armor in 1856. In 1858, he experi-

Webb v. Quintard.

mented, by firing a pistol at small pieces of wood and iron. He made no experiments from the fore part of 1859 till the latter part of 1861, when he began to make a model of a war vessel, which he completed early in 1862. The first trial he made with real armor was in March, 1863: *Held*, that Heaton did not make his invention before the date of the English publication.

A printed publication is, by the 6th, 7th, and 15th sections of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 119, 123,) put on the same footing with a patent taken out at the time of the publication; and, regarding the English publication as a patent, it was not unjustly obtained for that which had before been invented by Heaton, who was using reasonable diligence in adapting and perfecting it.

Heaton did not make his invention until he made his model, and he did not begin to make that until after the English publication had been made.

A previous conception of the possibility of accomplishing what the English publication makes known, was not enough. There must have been a reduction of the idea to practice, and an embodiment of it in some distinct form.

(Before BLATCHFORD, J., Southern District of New York, January 24th, 1872.)

BLATCHFORD, J. This suit is brought on letters patent granted to the plaintiff Heaton, April 14th, 1863, for an "improved defensive armor for ships and other batteries." The specification states, that the longitudinal outer timbers of the vessel form the backing to the armor, that the armor plates are laid against the backing in the usual way, and that the armor plates are covered with an outer layer of timbers, to deaden and to gradually resist the penetrating force in its passage to the armor plates. It then says: "In this heavy buoyant surface lies the gist of my invention or discovery. My invention consists, not in the introduction of wood, rubber, or any other like yielding substance, behind the metal armor, but in the discovery that a timber or other yielding surface, will deaden or resist the power of a cannon ball, when such wood or other surface is backed by the metal armor, which usually is on the surface, and when such metal armor is backed by sufficient wood or other backing to hold it rigidly in its normal position. My system of armor for vessels or forts does not contemplate stopping the ball at the immediate surface; but the metal, or armor proper, is placed at an intermediate point, so that, by the time the shot has reached it, its momentum is so greatly reduced, that it is

arrested without serious injury, either from starting the bolts or fracturing the metal armor. The object of my system of armor is to render a war vessel or other structure shot-proof with a less amount of iron armor than is now used with that end in view. By using less metal and more timber, I increase, instead of decreasing, the buoyancy of a ship, and, at the same time, greatly increase the resisting effect of the armor plating. Another object which I have in view is, to obviate the tendency to break the bolts or fastenings of the plating, when it is struck by a ball." The specification then illustrates the operation of the invention, in connection with drawings. It states that the patentee, in practice, simply overlays the iron armor of an ordinarily constructed vessel (which iron armor is backed up by sufficient backing to rigidly support the plates) with an outer layer of timber, which timber is only bolted on sufficiently strong to hold it to its place; and that his invention also consists in plating or thinly sheathing this timber, on its outer or exposed surface, not however to stop shot, but to prevent a raking shot from tearing the timber, and also to prevent the wood from being too readily set on fire, as such sheathing would exclude the air and so retard combustion. The claim of the patent is: "The employment of wood, or its equivalent, when used in the manner and for the purpose substantially as described." The application for the patent was filed on the 28th of March, 1863.

In 1863, the Government of the United States caused to be constructed for itself a vessel of war called the Onondaga. The vessel was built by the defendant, under a contract with the Government, as a vessel with iron armor. During the progress of her construction, wooden armor on the outside of the main iron armor, and a thin plating of iron on the outside of such wooden armor, were put upon the vessel, by the order of the Navy Department, given in March, 1863. The wooden armor and the iron plating were put on and completed in June and July, 1863. Such wooden armor and iron plating were applied in consequence of a description and drawings published at London in 1861, at pages 8 to 17, and

plate 2, of a volume entitled, "Transactions of the Institution of Naval Architects, volume 2," being a paper "On the construction of iron vessels of war iron-cased," by J. D'Aguilar Samuda, Esq., and were made in accordance with such description and drawings. The vessel, when completed, passed into the ownership, possession and service of the Government. On the 2d of March, 1867, an Act was passed by Congress, (14 *U. S. Stat. at Large*, 543,) authorizing and directing the Secretary of the Navy to deliver the vessel to the defendant for his own use and behoof, on the payment by him to the Treasury of the United States of the sum of \$759,673. He paid the money and received the vessel, and, in the spring of 1867, sold her to the French Government, and delivered her at that time to such Government, on such sale, in the city of New York. When so received and when so delivered; she had upon her the said wooden armor and iron plating. It is for this sale, as an infringement of the patent, that this suit is brought. The patentee, in his testimony in the case, admits that one of said drawings in said volume is practically the same thing as the armor of the Onondaga.

To counteract the force of this state of facts, it is attempted to carry back the invention of Heaton to a date anterior to 1861, but, I think, without success. The patentee testifies, that, while in England, in 1856, he saw an iron-clad gun-boat, and the idea occurred to him that the wood ought to be outside of the iron armor; that, within a week from that time, he wrote to the British Admiralty, suggesting that a defence be made consisting of wood outside of iron, and asking for aid or authority to experiment to that end; that, three or four months afterwards, he received a reply refusing such authority; that, in September or October, 1858, while in the United States, he fired a revolver at the wooden head of a nail keg, fastened by a wire to the sheet iron top of the perpendicular lever of a railroad switch, and hit the wood obliquely, and concluded that an oblique shot would damage the side of a ship more than a shot striking it squarely would; that, a few days afterwards, he fastened a piece of plank be-

tween a thin piece of sheet iron and a thick piece of sheet iron, and laid the article down on a railroad tie, with the thin iron piece uppermost, and fired at it with a revolver straight down, and also obliquely, and found that the thick iron under the plank was not affected by the shots, and that the thin iron prevented the oblique shots from damaging the plank; that he made no experiments from the forepart of 1859 till the latter part of 1861; that, at the latter date, he began to make a model of a war vessel, to illustrate his new system of armor; that, early in 1862, about the time the model was done, he wrote to the Secretary of War, asking to have the model examined; that the first trial he made with real armor on his plan, by firing at it with cannon, was made in New York in March, 1863; and that a like trial was made by him at Washington city, about the same time. On these facts, it is contended, for the plaintiffs, that Heaton completed in 1856 the invention of putting wood outside of iron for armor, and that he completed in the fall of 1858 the invention of the wood outside of the iron, and the thin iron outside of the wood.

The 6th section of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 119,) provides for the granting of a patent to a person for an invention "not known or used by others before" his discovery or invention thereof. The 7th section provides, that there shall be an examination of the alleged new invention, and that if, on the examination, it shall not appear "that the same had been invented or discovered by any other person in this country, prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale, with the applicant's consent or allowance, prior to the application, if the commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor; but whenever, on such examination, it shall appear to the commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of

that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication, in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him briefly such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new." The 15th section provides, that it shall be a defence to an action at law on a patent, "that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery thereof by the patentee * * or that he had surreptitiously or unjustly obtained the patent for that which was in fact invented and discovered by another, who was using reasonable diligence in adapting and perfecting the same; * * * provided, however, that, whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been before known or used in any foreign country, it not appearing that the same, or any substantial part thereof, had before been patented or described in any printed publication." These provisions of the 6th, 7th and 15th sections of the Act of 1836 have been, in substance, re-enacted in the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 198.)

Under these provisions of law, if the publication in the English work preceded the discovery by Heaton, the defence to the suit is made out. Under the law, the publication in the English work is put on the same footing with a patent taken out at the time of the publication. The sole question, therefore, is, whether Heaton made his invention before the date of the English publication. The occurring of the idea to him, in England, in 1856, and his letter to the British

Admiralty, certainly, cannot be regarded as a making of the invention. Nor can his pistol practice in 1858 be so regarded. The first attempt he made to embody his ideas in a practical form, by constructing a model, was in the latter part of 1861, the model having been finished early in 1862. This was all of it, according to the evidence, after the publication had been made in England, from which the *Onondaga* was armored as she was. If the English publication were an American patent, could it be said, in defence to an action on it, that it was unjustly obtained, for that which had in fact before been invented by Heaton, who was using reasonable diligence in adapting and perfecting it? Heaton may have used reasonable diligence in developing his ideas towards making an invention. But that is not the point. To give him a precedence over the English publication, he must have first made the invention, and then have been using reasonable diligence in adapting and perfecting the invention so made. When did he make the invention? Not until he made the model, which, according to the evidence, he did not begin to make until after the English publication had been made. The articles at which he fired with a pistol cannot be regarded as an embodiment of the invention, so as to destroy the rights of the defendant in respect of a vessel actually armored in accordance with what was published in England in 1861. (*Colt v. Massachusetts Arms Co.*, 1 *Fisher's Patent Cases*, 108, 120.) Looking at the English publication as a patent issued, which is the proper view in respect to this case, it cannot be defeated by showing that Heaton previously conceived the possibility of accomplishing what the publication makes known so satisfactorily that it has been followed in armoring the *Onondaga*. To constitute Heaton a prior inventor, he must have proceeded so far as to have before reduced his idea to practice, and embodied it in some distinct form. (*Parkhurst v. Kinsman*, 1 *Blatchf. C. C. R.*, 488, 494.) In order to prevent the defendant from having the benefit of the English publication, it is necessary that Heaton should have previously discovered the thing and reduced it

Dart v. McKinney.

to actual practice. (*Cox v. Griggs*, 2 *Fisher's Patent Cases*, 174, 177.) The pistol practice of Heaton was not a reduction of his ideas to practice, or an embodiment of them in a distinct form, within the good sense of these rules, so as to constitute an invention on his part, within the meaning of the statute.

The bill must be dismissed, with costs.

Charles F. Blake and *Samuel D. Cozzens*, for the plaintiffs.

Edward N. Dickerson, for the defendant.

JAMES DART AND CHARLES J. OSBORN

vs.

ANDREW MCKINNEY.

A judgment was rendered, in a State Court, on the report of a referee, in favor of the plaintiff, against two defendants. The judgment was reversed, and a new trial was granted. After that, one of the defendants, before another trial, applied to the State Court, under the Act of July 27th, 1866, (14 *U. S. Stat. at Large*, 306,) for the removal of the suit, as against him, into this Court. The State Court ordered the removal, holding that the case stood for trial as if no former trial had occurred. The plaintiff then moved, in this Court, that the cause be remanded to the State Court: *Held*, that, as the Act gave the right of removal "at any time before the trial or final hearing of the cause," the cause was properly removed.

Form of the order of this Court, on the filing of the papers from the State Court.

In the case of a removal, by one of two defendants, under the said Act of 1866, after the cause is at issue, in the State Court, on pleadings, there is no need of any new pleadings in this Court, provided they are in a proper shape for a trial, as between the plaintiff and such defendant.

(Before BLATCHFORD, J., Southern District of New York, January 26th, 1872.)

Dart v. McKinney.

BLATCHFORD, J. This case was, I think, properly removable to this Court, as against the defendant McKinney, under the Act of July 27th, 1866, (14 *U. S. Stat. at Large*, 306.) The right of removal is given "at any time before *the* trial or final hearing of the cause," not "at any time before *a* trial or final hearing of the cause." The judgment which the State Court rendered in favor of the plaintiffs, on the report of the referee, on the trial which was had, was reversed, and a new trial was granted. The State Court, in its decision granting the removal of this cause, as against McKinney, says, that the former trial was adjudged a mistrial, and that the case now stands for trial, as if no former trial had occurred. This being so, the case was a removable one, under the Act of 1866, as against McKinney. The motion to remand it must, therefore, be denied.

The order that the cause "proceed in this Court, the same as if it had been originally brought herein," ought to be modified, so as to provide, that the cause proceed in this Court, against McKinney, in the same manner as if it had been brought in this Court by original process against McKinney.

By the Act of 1866, the copies of all pleadings in the State Court, filed or entered by McKinney in this Court, have the same force and effect, in every respect, and for every purpose, as the original pleadings would have had, by the laws and practice of the State Court, if the cause, as against McKinney, had remained in such State Court. There is, therefore, no need of any new pleadings in this Court, provided they are in a proper shape for a trial as between the plaintiffs and McKinney. I think they are in such shape. The motion to set aside the rule to declare is, therefore, granted.

Starr & Ruggles, for the plaintiffs.

Eldridge & Johnson, for the defendant.

Sawyer v. Bixby.

HENRY SAWYER

vs.

SAMUEL M. BIXBY AND CLARENCE TUCKER. IN EQUITY.

The reissued letters patent granted to Henry Sawyer, October 1st, 1867, for an "improvement in putting up powders, &c.," which claim, as a new article of manufacture, "a package or case, which, when made with distributing holes, and filled, is cemented by the wax or wafer, as set forth," do not claim any patentable invention.

The invention claimed is a small cylindrical box, perforated at the end with holes, and having the perforations closed by wax, or wafer, or paper pasted on, to retain the contents, while the box is being transported, the wax or wafer being removed, or the paper punctured, when it is desired to permit the contents to pass through the holes.

Everything in such invention, both in means and in result, was old.

(Before Woodruff, J., Southern District of New York, January 27th, 1872.)

WOODRUFF, J. The complainant alleges that the defendants have infringed re-issued letters patent granted to him October 1st, 1867, for an "improvement in putting up powders, &c." The claim contained in the specification annexed is in these words: "What I claim as a new article of manufacture is, a package or case, which, when made with distributing holes and filled, is cemented by the wax or wafer, as set forth."

The specification and the specimens of the manufacture produced show, that what the plaintiff claims as an invention, is a small cylindrical box, perforated at the end after the manner of a pepper or sand box, for the purpose of conveniently and evenly distributing the powder contained within it, when put to use, and the closing of these perforations by wax, or wafer, or paper, pasted, or made to adhere by mucilage, or some glutinous substance, for retaining the powder when

Sawyer v. Bixby.

sold and transported by the manufacturer, dealer or customer, the wax or wafer being removed, or the paper punctured, when it is desired to use the powder. I am decidedly of opinion, that, in this device, there is no patentable invention. Pepper boxes, sand boxes, dredge boxes, and spice boxes, either of which is exactly adapted to the distribution of powder of any kind, are not new and are not claimed to be new. In construction and effect, they are substantially like, and, in mechanical structure, identical with, the plaintiff's cylindrical box, perforated at one end for the distribution of the powder. In respect of distribution, the plaintiff employs no new means and produces no new result. The closing of packages of various forms, and of bottles, by wax, or wafer, or the pasting of paper, made to attach itself by the use of gum, or other adhesive material, is no more new than the other; and, when those or either of them are applied to the openings in the plaintiff's boxes, they produce no new result. They close the openings, and that is all. They are old means, and they produce their old and obvious, well-known result. In combination, there is no other effect. Each performs the same office, in the same manner, as it does when employed for any other purpose, and precisely as it must, whatever be the form of the package, or the particular use to which the package is applied. The employment of these instrumentalities, in putting up packages for transportation, is, therefore, the exercise of judgment in selecting, not of invention in devising or combining. At most, it consists in applying old devices to a new use, which, when it involves no new means and produces no new effect, is not patentable, notwithstanding it may be useful to combine the two results, by uniting the two instrumentalities.

But this is not all. The proof shows, that, long before the plaintiff's supposed invention, paper boxes and sand boxes, with a perforated end, were not only used for the convenient distribution of their contents, but were put up for transportation and sale, with the perforations covered by thin paper

 Meissner v. The Devoe Manufacturing Company.

pasted thereon, to be removed or punctured when actually used.

I find no ground upon which to sustain the claim of the plaintiff to any decree herein. The bill of complaint must be dismissed, with costs.

Andrew J. Todd, for the plaintiff.

Charles A. Durgin, for the defendants.

 FREDERICK MEISSNER AND OTHERS

vs.

THE DEVOE MANUFACTURING COMPANY. IN EQUITY.

The letters patent granted to Albin Warth, April 19th, 1870, for an improvement in stop-valves for petroleum packages, make, in each one of their two claims, a cup-shaped disk, a material part of the invention, such disk being a valve-seat for a valve, and having the effect, by reason of being cup-shaped, to sink the valve within the package, so that there shall be no part projecting outside.

The cup-shaped form of the disk is made, by the specification and claims, an essential part of the invention.

Such patent is not infringed by a stop-valve of convex-form, not suspended below the surface of the package, though in other respects constructed like the patented arrangement.

(Before WOODRUFF, J., Southern District of New York, January 27th, 1872.)

THIS was a final hearing, on pleadings and proofs, of a suit in equity founded on letters patent granted to Albin Warth, April 19th, 1870, for an improvement in stop valves for petroleum packages. The specification said: "This invention consists in the arrangement of a cup-shaped flanged

Meissner v. The Devos Manufacturing Company.

disk, provided with a vent-hole, with a discharge opening, and with a central hole, and with a flat internal face, said central hole being intended to receive a screw, which is tapped into the solid body of a valve covered with leather or other suitable packing, in such a manner that, by means of its flange, the disk can be readily soldered to the side of a petroleum package or case for carrying petroleum or other liquid, without producing an objectionable projection on said package, and that, by turning the screw in and out, the valve can be readily opened and closed, the valve being prevented from turning with the screw, and from dropping off, by hook-shaped arms, extending from the inner surface of the cup-shaped disk, and bearing against lugs projecting from the periphery of the valve. When the valve is opened, the contents of the case or package can be readily poured out through the discharge-spout, the vent-hole admitting the external air into said case. In the drawing, the letter *A* represents a case or package made of tinned sheet-iron, or any other suitable material, and capable of containing petroleum or other liquids, particularly such as are intended for transportation. In one side of this case is secured a stop-valve, *B*, which consists of a cup-shaped disk, provided with a flange, *a*, and perforated with three holes, (see figs. 2 and 3,) one in the centre, to receive the screw, *b*, and two on the sides, the hole, *c*, being the vent, and the hole, *d*, the discharge-opening, of the case. The head of the screw, *b*, is provided with a circular shoulder, to catch under a lip, *e*, projecting from the edge of the central hole in the cup-shaped disk, and to the bottom of said disk is secured a plate, *f*, so that the head is confined in a chamber, and prevented from moving in the direction of the axis of the screw. The plate, *f*, is smoothed off on its exposed surface, so that it forms a seat for the valve *g*, and said plate is provided with two hook-shaped arms, *h*, which form guides for the valve, and prevent the same from dropping off, and also from turning round, said valve being provided with lugs projecting from its periphery, and bearing against the edges of the arms, *h*. The valve, *g*, is cast of Babbitt metal, or other

Meissner v. The Devoe Manufacturing Company.

suitable material, and it is provided with a socket to receive the screw, *b*. The face of the valve is covered with a disk, *i*, of leather, or other suitable material, which is retained by studs cast solid with the valve, and riveted over said disk, as shown. The flange, *a*, is soldered to the side of the case, *A*, the head of the screw being situated in the cavity of the cup-shaped disk, so that no part of the valve projects materially beyond the face of the case. By turning the screw, *b*, in the proper direction, the valve, and the holes, *c* and *d*, are opened, so that the contents of the case can be poured out through the discharge-opening, *d*, the external air having free access to the interior of the case, through the vent-hole, *c*. By screwing up the screw, *b*, the valve is closed, and the case is hermetically sealed. The nip of the screw, *b*, is dove-tailed, to receive a handle, *C*, of the proper form, for the purpose of operating the same. It (the screw) may, however, be also operated by means of an ordinary screw-driver. If desired, the cup-shaped disk of the valve, together with the hook-shaped arms, *h*, may be produced by casting, and, in this case, the lip, *e*, is omitted, and the screw is prevented from moving in the direction of its axis, by a pin passing through it under the cup-shaped disk, as shown in fig. 2. This valve is of particular value for petroleum packages, which are transported across the ocean in very large quantities, and which have to be hermetically sealed, and, at the same time, so constructed, that their surfaces have no projecting parts, and that the contents of the package can be readily drawn off." The claims were these: "1. The cup-shaped disk, suspended within the package, *A*, receiving the screw, *b*, and forming a valve-seat, in combination with the valve, *g*, suspended from the screw between guides, *h*, substantially as and for the purpose described. 2. The vent-hole, *c*, and discharge-opening, *d*, in the cup-shaped disk, in combination with the central screw, and with the valve and the guide-arms, all constructed and operating substantially as described."

John Van Santvoord, for the plaintiffs.

George Gifford, for the defendants.

WOODRUFF, J. I deem it highly probable that the stop-valve made by the defendants, when considered in reference to its construction, and its office and function, as a mere stop-valve, is substantially like that described in the complainants' patent, and that, if the latter had been described and claimed by the patentee independently of the precise form and location of the parts, and of the material office or function which such precise form and location performs in the combination described, the stop-valve of the defendants must have been declared an infringement. But, the patentee has seen fit, by his specification and claim, to confine the right secured to him within much narrower limits. He does not, in his specification, claim that either part used in the construction of his stop-valve is new, or that any number of the parts, not including a cup-shaped disk by means of which the whole apparatus is sunk below the outer surface of the oil can, are new in their combination with each other.

Viewing the device, as described and claimed in either the first or second claim, as a combination of parts not new, the cup-shaped disk is, by each claim, made a material part of the invention. The form of the disk is material. Without the form described, the result at which the invention is directed, and which is represented as its peculiar feature, would not be effected, that is to say, without that form, it would not be a stop-valve which could be applied to packages for transportation, so that their surfaces would have "no projecting parts." It is, therefore, not (as represented in the specification and claim) a case in which form is not of the substance of the combination.

Viewing the device, as described and claimed, as a machine or structure—for, all machines and structures are, in a literal sense, combinations of things, old or new—the same observations are applicable. The patentee has made the peculiar disk which he describes, and which forms the valve-seat, a prominent feature. He has done so in both of his claims, and, in his specification, he represents the immediate

Meissner v. The Devoe Manufacturing Company.

and necessary effect of that form of disk as constituting the peculiarity of his stop-valve and its especial utility.

It is quite possible that he might have claimed this identical stop-valve, useful, and adapted for use, in admitting oil to a can or vessel, enclosing it tightly within the can, and, at pleasure, to be opened for discharging it therefrom, and to be inserted in the end or side of the can or vessel, according to the judgment of the manufacturer of such can or vessel. Had he done this, the question whether the defendants' stop-valve is within the claim would have been a very different one. Here he has chosen to define the object or result of his invention, to describe the parts thereof, and to specify the form, without which the object in view would not be attained.

The defendants do not use the parts in the same form, nor in an equivalent form, and do not produce the same result. The change they have made in the form of the disk constituting the valve-seat, is such as necessarily defeats the purpose for which the complainants' device was intended, and which it accomplishes. The defendants' disk is, therefore, not an equivalent to that used by the complainants. It has not the same effective operation. Instead of suspending the stop-valve below the surface of the can or vessel, by its convex form, it rises, necessarily, above that surface, and carries still higher the parts with which it is connected, thus doing the very thing which the complainants, by the peculiar form of their disk or valve-seat, profess to avoid and do avoid. The conclusion cannot be escaped by saying that the difference is not in the material or essential characteristics of the device, but only in the degree of utility, that the defendants' device is the same in principle and in substantial structure, but that, by a change in the form of the valve-seat, by inverting it, the device is rendered less perfect and less useful. Under a specification and claim which might readily be suggested, this reasoning might be entirely just and true, and might render it necessary to pronounce the defendants' device an infringement. But the actual claims cannot be re-

jected. The complainants must stand or fall by the claims as made, and those, not only in terms, but when read and construed with reference to the whole specification, make the form of the disk a part of the complainants' structure, material to its location in connection with the can, and especially material to the function or effect designed to be produced, and in fact produced thereby. I think, therefore, that, under this patent, the complainants cannot reject the form of the valve-seat, and the location of the structure within the can, and allege that any form of valve-seat, and any location of the stop-valve, however projecting above the surface of the can, is an infringement of their claims, provided, in other respects, it is substantially like theirs. I think, that, in all other respects, the defendants' stop-valve does include the complainants', and all of its parts, in substantially the same form and manner of combination, and operating in substantially the same way, and producing the same result. The difference in the nut and screw, in the guide, and in the contrivance for preventing the turning of the valve, are not changes in the principle, or in the manner of operation, which would relieve their stop-valve from condemnation as an infringement. They are a mere substitution of equivalents. For this reason, it seems not improbable that the conclusion to which I am compelled is not because the actual invention of the complainants has not been infringed or copied by the defendants, but because the specification and claims upon which the patent is granted have so narrowed the ground on which they stand, that they fail to realize all the monopoly to which, in virtue of the actual invention, the patentee may have been entitled. If this be so, the Court is, nevertheless, unable to relieve them. We can only deal with the rights of the complainants as they are defined in and secured by the letters patent; and, as there defined, my conclusion is that the defendants' stop-valve is not an infringement.

The bill of complaint must, therefore, be dismissed, with costs.

In re James K. Place and James D. Sparkman, Bankrupts.

In re JAMES K. PLACE AND JAMES D. SPARKMAN,
BANKRUPTS.

The District Court, by an order entered June 25th, rejected and disallowed the claim of a creditor against the estate of a bankrupt, and awarded to the assignee costs against the claimant, to be taxed, and collected by execution. They were taxed April 8th, following. The District Court refused to enter, on the application of the claimant, a further or more formal judgment against the claimant for the amount of the taxed costs, the assignee not asking to have such judgment entered. On April 18th, the claimant gave notice of an appeal to this Court from the order of June 25th. The assignee moved to dismiss the appeal, on the ground that it was not brought within ten days after June 25th: *Held*, that the appeal must be dismissed, as not having been taken within the ten days limited by section 8 of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 520).

The order of June 25th was final, in such sense that an appeal would lie therefrom.

(Before WOODRUFF, J., Southern District of New York, January 27th, 1872.)

WOODRUFF, J. The appellants, Charles P. Fischer and others, claiming to be creditors of the bankrupt Sparkman, presented their claim against his separate estate. Objection being made, the matter was referred, proofs were taken, a report was made, a hearing thereon was had in the District Court, and, on the 25th of June, 1870, an adjudication was made and duly entered, by which it was, in terms, ordered, adjudged and decreed, that the claimants are not creditors of said separate estate of James D. Sparkman, and that the said claim and proof be, "and the same hereby is, wholly rejected and disallowed," and, also, that the assignee recover against the said claimants the costs of the said reference, to be taxed by the clerk, and have execution therefor. On or about the 6th of April, 1871, the solicitor for the claimants requested the solicitor for the assignee to cause the costs thus awarded to be taxed, and the same were taxed on the 8th of April, 1871. Thereupon, the solicitor for the claimants requested

In re James K. Place and James D. Sparkman, Bankrupts.

the solicitor for the assignee to enter a further decree, in order that an appeal might be taken therefrom, and, on his refusal, application was made to the District Court, in behalf of the claimants, for leave to enter such further decree, reciting the previous decree rejecting their claim, and awarding costs and execution therefor, and further reciting the subsequent taxation of costs at \$220 26, and thereupon ordering, adjudging and decreeing that the assignee "have judgment" against the claimants for the said sum of \$220 26. The District Court refused to make this further order or judgment, unless the same was asked for by the assignee, and the solicitor for the assignee refused his assent to the entry thereof. On the 18th of April, 1871, the claimants gave notice that they claimed an appeal to this Court, from the order of June 25th, 1870, refusing to allow their claim. The assignee now moves to dismiss the appeal, on the ground that it is too late, more than ten days having elapsed, after the making of the order rejecting the claim, before such appeal was taken.

The claimants appear to have acted in good faith, in their endeavor to bring the decision rejecting their claim under review. It appears that they took an appeal, in July, 1870, from the same order, which appeal was dismissed by this Court. (8 *Blatchf. C. C. R.*, 302.) The claim is said to be large, the estate of the bankrupt is sufficient for its payment, and the consequences of its rejection are serious. Under these circumstances, if the matter rested in discretion, there would be much reason for relieving the claimants from any embarrassment arising from mistake or misapprehension in regard to the time for taking an appeal—not because the merits of the claim are before me, or because such relief would import doubt of the propriety of its rejection, but because the right of appeal given by the statute is an important right, and an appeal might, perhaps, be further prosecuted to the Supreme Court. But the objection goes to the jurisdiction of this Court. It does not rest in discretion. I am, therefore, compelled to act upon my conviction that the ap-

In re James K. Place and James D. Sparkman, Bankrupts.

peal was not taken within the time allowed by law, and that the Circuit Court has not gained thereby any jurisdiction to review the decision appealed from.

(1.) The appeal is, in terms, from a decree made on the 25th of June, 1870. But, the appeal was not taken until the 18th of April, 1871, about ten months after the order was made and entered. Section 8 of the bankrupt law is explicit, that "no appeal shall be allowed in any case from the District to the Circuit Court, unless it is claimed and notice given thereof * * * within ten days after the entry of the decree or decision appealed from." According to the language of the statute, then, the appeal should not be allowed. It is, by its terms, an appeal taken nearly ten months after the decree or decision appealed from.

The claimants insist, that the ten days did not begin to run until the costs awarded by the decree or decision were taxed. The language of the said eighth section will not warrant this claim. The order or decree made by the District Court, and the only order or decree which that Court has made, was made in June, 1870. It was then entered. It is the order or decree appealed from. The statute forbids an appeal if not taken within ten days after the entry of the decree or decision appealed from. This does not leave open to discussion the question whether the order of June 25th, 1870, was final, or whether, in order to carry it into actual execution, some further step was necessary, either taxation, or a further decree or judgment. If the claimants desired to appeal from it, they should have appealed within ten days after the *entry* thereof.

(2.) I entertain no doubt, that, agreeably to the decisions of the Supreme Court in analogous cases, the decision of June 25th, 1870, was final, in such sense that an appeal would lie therefrom. (*Forgay v. Conrad*, 6 *How.*, 201, 204; *Beebe v. Russell*, 19 *Id.*, 283; *Silsby v. Foote*, 20 *Id.*, 290; *Craig v. The Hartford*, 1 *McAllister*, 91.) The decision or decree settled the rights of the parties, it finally rejected the claim, and it awarded a recovery of costs and execution therefor.

In re Alanson M. Clark, a Bankrupt.

No act of the Court was, I think, necessary to the full and final effect of its order. If any such act of the Court was necessary for any purpose, no further action by the Court has been had in the matter.

The appeal must be dismissed, but I deem it proper to make such dismissal without costs.

Thomas C. T. Buckley, for the creditors.

Francis N. Bangs, for the assignee.

In re ALANSON M. CLARK, A BANKRUPT.

The District Court has, under the 1st section of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 517,) power to prohibit any proceeding in a State Court by a creditor, to liquidate and enforce a lien on the property of a debtor who is adjudged a bankrupt by such Court.

Such power is to be exercised summarily, and does not require a formal suit.

When the property affected by a lien is confessedly the property of the bankrupt, and has passed to the assignee, and it only remains to ascertain and liquidate the alleged lien, the summary jurisdiction of the District Court is entirely adequate.

The power of the bankruptcy Court to give further relief, in protection of the estate of the bankrupt, on a renewed application, on new or further evidence, after it has made one order in the premises, considered and sustained.

Semble, that the mode of review of an order made in the exercise of such summary jurisdiction, is not by an appeal under the 8th section of the bankruptcy Act.

The testimony, in a suit in equity, may be taken orally, in open Court.

An order of the District Court, restraining an alleged creditor of the bankrupt's from further prosecuting an action in a State Court, in which he had attached property of the bankrupt's, affirmed.

(Before WOODRUFF, J., Vermont, January, 1872.)

ONE BURTON, many months before proceedings were com-

In re Alanson M. Clark, a Bankrupt.

menced in bankruptcy against Clark, had commenced an action in the State Court, against the latter, on book account, for \$150,000, and therein had attached property of Clark, to be held to satisfy any judgment he might recover in that action. He had also recovered a judgment for \$46,000, against Clark, on a set-off in another action, pending at the same time, and for this judgment he had no security. Clark, becoming greatly embarrassed, and, in fact, insolvent, other attachments were levied on his property. In January, 1870, by consent, the judgment for \$46,000 was reversed, and soon thereafter an agreement was made by Clark with Burton, that all suits between Clark and Burton, (of which there were several,) except the action on book account, should be discontinued, and that, in such last named action, Burton might prove all his demands against Clark, without objection as to the form of action, and without any claim that they or any of them were barred by the statute of limitations. Clark was adjudged a bankrupt in February, 1870, and Samson, his assignee in bankruptcy, applied to the District Court to enjoin Burton and Clark from acting under that agreement, and to stay the prosecution of the action on book account, on the ground that the arrangement between Burton and Clark was collusive and fraudulent, and made to give Burton an unlawful preference; and an order was made forbidding the parties from making any use of the agreement, but not forbidding the prosecution of the suit. On a review of that order in the Circuit Court, it was affirmed, and leave was given to make a further or renewed application to the District Court, upon new or additional evidence. Thereupon, the assignee presented the petition now in question, to the District Court, praying an injunction against the prosecution of the action on book account in the State Court. The bankrupt and Burton appeared and answered. The issues were tried by the District Court, by the examination of witnesses and the taking of proofs orally before the Court. The proofs were deemed to establish that the fraudulent scheme or contrivance to give to Burton a preference was entered into before the

In re Alanson M. Clark, a Bankrupt.

reversal of the judgment above mentioned ; that that reversal by consent was in execution of that scheme ; that its design was to remove an obstacle to proving, in the action on book account, the matters claimed as a set-off, and determined by that judgment, and so, by letting them, with other claims, into the action on book account, waiving all forms and the statute of limitations, bring them within the scope of the attachment lien, whereas, in truth, and without such reversal, Burton had not and could not gain any security therefor ; and that, from a period shortly before that reversal of the judgment, Clark and Burton, who were brothers in law, were acting throughout in collusion, and with the fraudulent design to make use of the attachment lien acquired in the action on book account, as a means of sweeping into the hands of Burton so much of the bankrupt estate as possible, by the use of claims theretofore unsecured, and claims outlawed, collusively exaggerated, or fictitious, and not to be seriously contested by Clark, and so pervert the action to a fraudulent use, to the prejudice of other creditors, if not to deprive them of any share of the estate. The Court, thereupon, made an order restraining Burton from further prosecuting the action on book account, in the State Court. From this order, Burton brought an appeal to this Court, in the form and manner prescribed by the 8th section of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 520,) as if the order had been made in a suit in equity, proceeding on pleadings and proofs to a decree. On the hearing of the appeal, the assignee moved to dismiss it, on the ground that the order was made in the exercise of the summary jurisdiction given to the District Court by the 1st section of said Act, and could only be reviewed in accordance with the provisions of the 2d section.

George F. Edmunds and *Edward J. Phelps*, for the assignee.

Luke P. Poland, *Reuben C. Benton* and *Heman S. Royce*, for Benton.

In re Alanson M. Clark, a Bankrupt.

WOODBUFF, J. In the conclusions of the District Judge upon the questions of fact, I concur. I shall, therefore, content myself with stating the questions raised on this appeal, and, very briefly, my conclusions thereon.

It is contended, for the appellant: (1.) That the District Court had no power to proceed summarily, in this case; (2.) That the assignee is concluded by a former order, which will be hereafter referred to; (3.) That this proceeding is, in substance, a suit in equity, and an appeal, under the '8th section, is proper; (4.) That it was irregular and erroneous to try the questions of fact by the examination of witnesses in open Court, but the testimony should have been taken before an examiner; (5.) That neither the proofs, nor the law applicable thereto, warranted the order, in any form of proceeding.

(1.) I have no doubt whatever of the power and jurisdiction of the District Court, under the 1st section of the bankrupt law, to assume the entire administration of the estate of the debtor, to determine all questions touching the existence of liens thereon, to ascertain and settle the amount of such liens, and to make provision for the liquidation and settlement thereof; and, as incidental to this, it has ample power to restrain a claimant of such lien from proceeding elsewhere to enforce his lien. Language more comprehensive can hardly be suggested than is employed in the Act, giving power to collect all the assets, to ascertain and liquidate the liens and other specific claims thereon, adjust the various priorities, and marshal and dispose of the different funds and assets, so as to secure the rights of all parties. To this end, power is given to compel obedience to all orders, by process of contempt and other remedial process. The entire estate is brought within the reach of these comprehensive powers, by vesting it in the assignee appointed by the Court, to administer it, under the direction of the Court. Nor can it make any difference with the power of the Court over this subject, that the lien or alleged lien is inchoate, and incapable of execution, until the amount secured thereby is ascertained

and settled. Ascertainment and liquidation are expressly authorized; and the subsequent provisions of the Act, relating to creditors having mortgages, liens or other security, show how fully the whole administration of the estate is confided to the Court. True, it does not necessarily follow, that, in all cases, the Court must prohibit any proceeding in the State Court for the benefit of a creditor having a lien. There is, however, no want of power. Often, it is quite convenient; and, ordinarily, it may be quite desirable, to permit pending actions to proceed, so far as to ascertain the amount due. In one case, (*In re The Iron Mountain Co., ante, p. 320,*) a foreclosure of a mortgage in the State Court was permitted, though begun after petition filed in the District Court, and, under the special circumstances of the case, I deemed it proper, on review in this Court, to affirm the order. But, the power to control the creditors in this respect is, I think, clearly given. Two considerations illustrate the importance of the power, which are especially applicable to liens by attachment: 1. Without such power, there is no adequate protection to the other creditors, against collusion between the bankrupt and the claimant, not even aided by the authority given to the assignee to defend. 2. The early settlement of the estate may sometimes require that the Court in bankruptcy should take the determination of claims which are in dispute into its own hands.

I deem it equally clear, that this power conferred by the 1st section is to be summarily exercised, and does not require a formal suit. Indeed, whatever powers are given by the 1st section are designed to be exercised summarily.

There are cases, in which, in order to bring the property pursued by the assignee within the control of the Court or its assignee, or to remove obstacles to its administration, it may be necessary for the assignee to prosecute an action at law or a suit in equity; and such cases are provided for in the 2d section. But, when the property affected by a lien is confessedly the property of the bankrupt, and has passed to the assignee, and, it only remains to ascertain and liquidate the

In re Alanson M. Clark, a Bankrupt.

alleged lien, the summary jurisdiction of the District Court is entirely adequate.

(2.) On a prior petition, setting out some of the matters alleged in the present petition, the District Court had made an order enjoining Burton from making any use of a written agreement entered into between him and the bankrupt, on the ground that it was a collusive and fraudulent arrangement, for the purpose of securing to Burton a preference over other creditors, in respect of certain claims which had already been merged in a judgment, or barred by such judgment, and for which, so long as such judgment was in force, Burton had no security. But such order did not invalidate or impeach a previous reversal, which had been entered by consent, of that judgment, because it did not then sufficiently appear that such collusive and fraudulent arrangement was entered into prior to such reversal, or that such reversal was part of the scheme devised to secure to Burton a preference. Shortly after such reversal, the said written agreement was entered into between Burton and the bankrupt, which, if carried into execution, would have permitted Burton to prove all claims which he had or alleged against the bankrupt, in an action "on book," in which he had attached the bankrupt's property, and thus secure an apparent lien, and, possibly, an actual lien, for the amount due to him upon the said claims, for which, so long as the said judgment was in force, he had no security. The former order of the District Court left to Burton such right to prove the said claims, as the laws of Vermont might give to him. That order, this Court, on review, affirmed, but leave was given to the assignee to renew his application for other or further order in the premises, upon new or additional evidence. Thereupon, the present petition was presented to the District Court.

The suggestion, that the decision upon the former hearing was final and conclusive, as *res adjudicata*, is without foundation. Even in a formal suit in equity, the Court may qualify the decree, so that it shall not operate to prevent a new suit; and nothing is more common, in disposing of mo-

tions, than to give leave to renew, or apply, upon new or further evidence, for additional relief. The highly equitable and remedial powers conferred on the Court in bankruptcy are not less free from restriction, nor are they hampered by such technical rules as will prevent the doing of what is just and for the protection of the estate, even if it requires the revocation of an order once made.

(3.) The proceeding in question was not a formal suit, but was a summary proceeding. It does not conform, in the manner of its institution, the manner of its prosecution, or in its form, to a suit in equity. True, the facts stated and the relief sought were like, in some of their features, to bills for analogous relief in suits in equity; but that proves nothing. These same facts were the proper ground of a summary application, and for the relief which it was competent for the Court summarily to grant. If these proceedings are compared with the rules prescribed to the Courts of the United States in equity, relating to the commencement of suits, the form of bills, appearance therein, &c., &c., no question will, I think, remain on this point.

It would seem to follow, that the mode adopted to obtain a review of the order of the District Court, was not warranted. It will, however, be more satisfactory to the parties, if the case is disposed of upon grounds which import that no error was committed in the order appealed from, and, also, upon grounds alike applicable to the proceeding, if it were regarded as a suit in form; and I therefore consider the other points.

(4.) It was not ground for a reversal of the order, that the witnesses were orally examined before the Court. The rules of the Supreme Court have not taken away the power which the Court has, as a Court of equity, to have the testimony of the witnesses taken in open Court. That power is expressly reserved in the seventy-eighth rule, which implies its existence and its perpetuation. It is there left to the discretion of the Court.

(5.) I have, perhaps, already sufficiently expressed my views of the merits. The conclusions of the District Judge

In re Alanson M. Clark, a Bankrupt.

were, I think, warranted by the evidence. The power of the Court over the subject I have already stated. Independent of any question of actual corrupt design, the arrangement to remove the impediment of an actual adjudication, and bring the claims therein determined under the operation of the attachment in the action "on book," was an attempt to give an illegal preference in fraud of the bankrupt law. On that subject I have already expressed my opinion, on the former review, above mentioned. It is not enough to say, that, if the debt were permitted to be established in the pending action, the Court could control the execution of the judgment. I would not express any doubt of that; but it will save embarrassment, expense, and any apparent effect of a formal judgment, to be avoided by the assignee, to arrest the execution of the fraudulent scheme. And this is especially true, in view of the evidence of actual fraudulent collusion, which is deemed established.

The order should be affirmed.

In re ALANSON M. CLARK, A BANKRUPT.

The jurisdiction of the Circuit Court, to review summary proceedings in bankruptcy, is not limited by any measure of the value of the property involved.

A petition of review, in bankruptcy, merely reciting the proceedings in the District Court, and its decree, and alleging that the petitioner is aggrieved thereby, and praying a review and a reversal, without pointing out any errors, or supposed errors, in law or in fact, or specifying any ground or reason for such reversal, except that the petitioner is aggrieved, commented on, as loose practice, not to be sanctioned.

Where property comes to the possession of an assignee in bankruptcy, as part of the estate of the bankrupt, and is taken from his possession under a writ of replevin, issued from a State Court, in a proceeding to which the assignee is not a party, and in which the title of the assignee is not in question, the District Court is bound to see that such possession by the assignee is not forcibly displaced.

In re Alanson M. Clark, a Bankrupt.

A finding of fact, by the District Court, on the examination of witnesses in the presence of the Court, should not be reversed by the Circuit Court, without a very clear and decided conviction that it is erroneous.

The review given to the Circuit Court, by the 2d section of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 518,) is given to it as a Court of equity; and it is not bound to reverse upon strictly legal grounds, if satisfied that the facts are correctly found, and that no injustice has been done.

Declarations of the bankrupt, held to have been properly admitted in evidence, on the trial of a suit between the assignee and a third person, as to the title to certain property, as declarations made by him while in conspiracy with such third person to cover and conceal such property, and as part of the *res gesta*.

Where an assignee in bankruptcy proceeded, in the District Court, by petition, to recover certain property, as assets of the bankrupt, and the respondent answered the petition, and did not object to the form or substance of the proceedings, or to the jurisdiction of the Court, but submitted to its jurisdiction, and set up, by his answer, his own title to the property, and prayed that the Court would adjudge as to the title, between him and the assignee, and it did so adjudge, the Circuit Court, on review, will not consider the question as to whether a more formal suit would or would not have been proper.

(Before WOODRUFF, J., Vermont, January, 1872.)

WOODRUFF, J. Amos J. Samson, the assignee of Alanson M. Clark, in bankruptcy, applied, by petition, to the District Court, to compel the return to him of certain property, which he alleged to be part of the personal estate of the bankrupt, of which he had taken possession, and which had been taken from his possession, and delivered by the sheriff to William H. Blake, by virtue of a writ of replevin, issued in the name of the said Blake, against one La Crosse. Blake appeared, and, without objection to the form of the proceeding, answered the petition, denying that the property was in the possession of the assignee, averring title to the property in himself, denying, also, that the property was ever the property of the bankrupt, and praying the Court to adjust and settle the right to the said property, as between himself and the assignee, and to direct the assignee to interfere no further therewith.

A trial of the issues thus raised was had in the District Court, on which it appeared, that the assignee of Clark, after

In re Alanson M. Clark, a Bankrupt.

his appointment, entered upon a farm, of which the title, at the time of the adjudication in bankruptcy, was in the bankrupt, and which was occupied by one La Crosse, under an agreement with the bankrupt for the purchase thereof, but for which the consideration was to be paid at a future day, upon notes which had been given therefor by La Crosse. The property in question was upon this farm. La Crosse made no claim to this personal property, yielded the possession thereof to the assignee, as the property of the bankrupt, and agreed to take care of the same for him. After this, the property was taken by Blake, through the writ of replevin out of the State Court, to which La Crosse alone was made defendant. Evidence was given, tending to show that the personal property, prior to the proceedings in bankruptcy, belonged to the bankrupt, and remained on his farm. On the other hand, evidence on the part of Blake tended to show, that the property in question belonged to La Crosse, and that, prior to the proceedings in bankruptcy, an execution on a judgment against La Crosse was levied thereon, and the same was sold by the sheriff, and purchased by the said Blake. Other evidence tended to show that the sale on the execution, and the purchase by Blake, were part of a fraudulent scheme by the bankrupt, when wholly insolvent, and on the eve of the proceedings against him in bankruptcy, by the aid of Blake, to cover and conceal his property, by the form of legal proceedings, wherein the property was levied upon and sold as the property of La Crosse, though, in truth, belonging to Clark himself; that Blake bid off the property by the procurement of Clark; that the purchase money was furnished or repaid by Clark to Blake, the design being to prevent the property from being thereafter taken by his creditors; and that the possession of the property was not changed, but the same remained on the farm of Clark. The District Court found and adjudged, that the said Blake has not, and never had, any right, title, or interest in the property; and that the same was the property of the said bankrupt, until the filing of the petition against him in bankruptcy, and became vested

In re Alanson M. Clark, a Bankrupt.

in the assignee, and came lawfully into his possession; and the Court thereupon ordered and decreed the restoration of the said property to the possession of the assignee, or, in default thereof, payment by the said Blake of its value, \$178, with costs. The said Blake has brought this petition of review, stating the proceedings above detailed, and that it was adjudged and decreed by the District Court as also above recited, and then alleging, "that he is aggrieved by said adjudication and decree," wherefore he prays a review and reversal, and that this Court will make such adjudication and decree as shall seem meet, &c., &c., without pointing out any errors, or supposed errors, in law or in fact, or specifying any ground or reason for a reversal of such decree, except the sweeping statement that he is aggrieved. The respondent, the assignee, moved to dismiss this petition, on the grounds, that the value of the property is not sufficient to give this Court jurisdiction; and that the petition alleges no error in law, assigns no specific error in fact, and contains only an allegation that the petitioner is aggrieved. At the hearing, the Court reserved the consideration of this motion, and directed the argument to proceed on the merits.

I find no warrant for limiting the jurisdiction of this Court to review summary proceedings in bankruptcy by any measure of the value of the property involved; and no statutory provision, nor any decision of the Courts, was referred to, prescribing or affirming any such limitation. If, therefore, the proceedings below ought to be regarded as summary proceedings, this Court has jurisdiction to review them. If, on the other hand, though informal, they were, in substance, a suit, as upon bill and cross-bill, then no proper appeal was taken; upon which, however, it will not be necessary to rest any conclusion.

As to the other ground on which the motion to dismiss was urged, it is sufficient to say, that, although I shall dispose of this case when I hold that there is no sufficient ground for reversing the decree of the District Court, I do not desire to sanction so loose a practice as this petition of review pursues.

In re Alanson M. Clark, a Bankrupt.

Nevertheless, as the defect might be cured by amendment, and as no prejudice can come to the assignee or to the estate, under the conclusion which has been reached on the other branch of the case, it is better for all interested as creditors or otherwise, that no further delay should happen, through mere defect in the formal proceedings.

The proofs, I think, warranted the conclusion of the Court below, that the property in question came to the possession of the assignee as part of the estate of the bankrupt, and was in his possession when Blake took it by his writ of replevin. The District Court would have failed in its duty, had it suffered that possession to be forcibly displaced by a third person, although using the form of process of the State Court, to which the assignee was not a party, and in which the title of the assignee was not in question, but the property was to be subjected to such fate as a contest between two strangers to the proceedings in bankruptcy might involve. The District Court was open to the application of such third party, if he desired to assert title and claim a delivery of the property by the assignee to him; or, a suit at law or in equity, as the case might require, could have been brought against the assignee, by such third party, in that or in this Court.

As to the title to the property itself, that depended upon questions of fact, in respect to which there is no such preponderance of evidence against the conclusion of the District Court, as calls for a reversal. On the contrary, my own conviction concurs with that of the District Judge. If it were otherwise, a finding of fact, upon an examination of witnesses in the presence of the Court, where the opportunity for judging correctly of the credibility of the witnesses and weight of the testimony is better than can ordinarily be afforded by an inspection of the testimony when reduced to writing, should not be reversed without a very clear and decided conviction that it is erroneous.

• It was strenuously insisted, that error was committed in the admissions of declarations of the bankrupt in evi-

dence. On this point, these observations are pertinent: (1.) This review is given to the Court as a Court of equity; and there, on an enquiry into questions of fact, the Court, on appeal, are not bound to reverse upon strictly legal grounds, if satisfied that the facts are correctly found, and that no injustice has been done. (2.) The declarations in question were in aid, and in partial execution of, or, at least, while Clark was engaged in, the alleged scheme to cover and conceal his property, to which Blake was a party. They were, therefore, admissible, as a declaration of a co-conspirator in the attempt to defraud. (3.) For the reason last stated, they were properly regarded as a part of the *res gesta*, when title in La Crosse was set up by Blake, and the fraudulent sale and pretended purchase by Blake were relied on.

It was not objected, on the argument of this review, that the proceedings on the petition of the assignee were not regular and proper, or that the order or decree sought to be reviewed was not within the summary jurisdiction of the District Court. Blake, the petitioner in review, appeared in the District Court and answered the petition. He not only raised no objection to the form or substance of the proceeding, or the jurisdiction of the Court therein, but, submitting to the jurisdiction, he invoked its exercise in his own behalf, by filing an answer, in the nature of a cross bill in equity, alleging his own title, and praying the Court to adjust and settle the right to the said property, as between him and the assignee, to give to him the control thereof, and to restrain the assignee from interference therewith. Upon the issues of fact, the parties went to trial, and with the result above stated. This Court is, therefore, not called upon to consider whether the determination of the question of title to this property should have been sought by a summary proceeding in the District Court, or by a proceeding formally commenced by process. Jurisdiction of the subject-matter and question existed in the Court, and both parties submitted themselves to its exercise, and, indeed, invoked it in the form and manner stated. Nor does the petitioner in review raise any objection,

Hitchcock v. Tremaine.

in this Court, that there is any defect or error in the decree or order, founded on the mode of procedure in the District Court. Besides, the Court having found, as matter of fact, that the property was in the possession of the assignee, the Court had power to protect that possession against interference except by resort to a proper legal proceeding to which the assignee should be a party; and, therefore, when Blake, the claimant, by his cross petition, invoked the controlling power of the Court over the assignee, as its officer, and submitted to a trial of the questions which he asked the Court to determine, no question arises here whether a more formal suit would or would not have been proper.

The judgment or decree must be affirmed, with costs.

Reuben C. Benton, for Blake.

Edward J. Phelps, for the assignee.

ALONZO HITCHCOCK AND OTHERS

vs.

CHARLES M. TREMAINE AND WILLIAM B. TREMAINE. IN
EQUITY.

In a suit in equity for the infringement of a patent for a tremolo attachment to an organ, on taking an account of the profits derived by the defendant from dealing in such attachment, it appeared that the defendant dealt in musical instruments not having such attachment, as well as in those having it: *Held*, that a proper part of the general expenses of conducting the defendant's entire business, such as clerk hire, rent of store, and the like, ought to be assigned to the dealing in such attachments, such part to bear the same proportion to the whole of such general expenses, that the sales of such attachments bore to the sales in the entire business.

Hitchcock v. Tremaine.

Such general expenses ought not to be apportioned according to the amount of profits on sales.

The patented attachment being a revolving fan, not including the apparatus for moving the fan, the profits on such apparatus ought not to be allowed.

(Before WOODRUFF, J., Southern District of New York, February 1st, 1872.)

WOODRUFF, J. I think the estimate of the gains and profits which the master has reported to have accrued to the defendants from the infringement of the patent of the complainants, is erroneous, and unjust to the defendants. The complainants have seen fit to proceed against the defendants for the recovery of gains and profits, treating them as trustees in that behalf; and the recovery is to be for what the defendants have realized after deducting their expenses in dealing in the infringing article. The defendants are dealers in musical instruments, including pianos, melodeons, and organs with, and organs without, the tremolo attachment which has been decreed to be an infringement of the complainants' patent. (See *Hitchcock v. Tremaine*, 8 *Blatchf. C. C. R.*, 440.) The conduct of their business necessarily involves certain general expenses, which are as truly expenses of dealing in one class of goods as of dealing in another class. Such expenses as general clerk hire, rent of store, salary of book-keeper, if any, and the like, concern the entire business; and, in any estimate of gains and profits, are properly apportionable to the several kinds of business done or kinds of goods sold, when the profits of either are to be separately stated. For example, to ascertain how much profit is gained by dealing in pianos, let it be assumed, that, of the aggregate sales in the business, one-half in amount are sales of pianos. Besides such special expenses as are peculiar to the receipt, transportation, and other peculiar service, if any, which pertains exclusively to the dealing in pianos, the general expenses are to be taken into view, one-half of which belong to the sales of pianos, as truly as the other half pertains to the sale of the other goods. This would be quite obvious, if a dealer in goods of several kinds were liable to account to some

other persons, respectively, for the gains and profits which he had made by his dealing in each kind of goods. The gross proceeds of sales of each kind being ascertained, and a deduction from each being made, of such special or peculiar expenses as, in a *pro forma* account, would be chargeable to each, there would remain, for allotment to each account, its proportionate share of the general expenses incurred for the benefit of all, that is, for the maintenance and conduct of the business; and this distribution should be in the proportion of the several amounts of sales of each. It is not just to say, in respect to either, as is argued by the complainants here, that the general expenses are not increased by the presence of one class of goods, and would have been the same if the sales had been confined to the other classes. If that argument were supposed to prevail in an accounting for the profits of sales of one class, it would also prevail in each separate accounting, and so would be allowed in neither.

In the present case, the dealing in organs having the tremolo attachment was a part of the general business of the defendants. These were not sold without involving a part of the general expenses of the business. It may be true, that, in a given case, it costs the defendants no more to sell an organ containing the infringing attachment than it would have cost to sell an organ not containing the attachment; but, *non constat*, that, if the organ sold had not contained such attachment, it would have been sold at all. The complainants are here demanding the profits of that sale. They must take them burthened with the just allowance for those disbursements which enable the defendants to offer the attachments to the public in a saleable form, and to keep them in the market, before the eye and within the reach of customers, and generally to properly conduct the business of selling and keep due account thereof.

This no one would for a moment question, if the defendants had kept a store for the sole purpose of dealing in the infringing attachments. Suppose, then, that the defendants, after dealing for a time in attachments alone, to be applied to

Hitchcock v. Tremaine.

organs by the purchasers, had concluded that it would facilitate and increase the sale of the attachments, if they procured organs, and caused the attachments, to be applied, and sold both. This would not affect the principle of computation or allowance of the general expenses; though it would bring in another item of sales, to be brought into an apportionment. And yet, in that case, it might be said, as is said here, that it costs no more to sell an organ with the attachment, than it would to sell an organ without the attachment.

In this respect, the computation by the master in this case is erroneous. He should have permitted the defendants to prove the general expenses of their business, incurred alike to effect the sales of all goods—that is, not specially incurred in reference to any particular class or kind; and these should have been apportioned according to the amount of gross sales, charging the sales of attachments with its relative share.

On the other hand, the master very properly refused to apportion these expenses according to the amount of profits on sales. Whether the defendants made any profits on their whole business or not, is quite immaterial to these complainants. They are not to be deprived of the gains made by selling the infringing attachments, because the defendants made less profits, or even no profits, on the sale of pianos, or, as the case may be, of some other musical instruments. To allow this, would permit the defendants to violate the rights of the complainants, and use the profits thereby gained to cover their losses on other sales.

In regard to the refusal of the master to permit the defendants to show that a portion of the profits on the sale of attachments, as found by him, arose from the sale of certain two parts thereof, which are not embraced within the patent of the complainants, but are patented by other parties, there was, also, apparent error. It is doubtful, indeed, whether the defendants could have proved it, if permitted, but the principle upon which they claimed to make this proof is not doubtful. The patent is for a device by which the vibration of the air is

produced ; namely, a fan or other instrument, made to revolve and agitate the air after it has passed the pipes or reeds which cause the sound. The means of moving the fan or beater, the complainants do not claim to be within their patent. Their instrument may be rotated by any convenient means, "such means," according to the very terms of the specification, "constituting no essential part of the invention." It is the application of means to the musical instrument by which the air may be agitated to produce a tremulous note, as described, that is, after the air has passed the sound-producing mechanism, and the arrangement of the fan or agitator in the instrument, as described, which alone are claimed by the patentee. The motive power, whether pressure on a treadle, or other device, or the manner of applying the power, so as to cause the motion of the fan or agitator, are not claimed. This is the construction given to the patent by the Court. Now, it is only the profits arising from the sale of what is patented, that the complainants should be allowed. Obviously, the expense of the apparatus for moving the patented device is to be allowed as a deduction from the proceeds of sale of the whole attachment. That expense has been allowed, in the allowance for the whole cost of the attachment, as sold by the defendants. If the defendants can show that they received an enhanced price for the patented attachment, by reason of its connection, in their sales, with a peculiar mode of producing or regulating the motion, so that the profit, or difference between the cost and the price of sale, was enhanced thereby, that enhancement is not due to the complainants. But it does not follow that the profits on the whole are to be divided into three equal parts, or into parts proportioned to the cost of the several three parts. The patented improvement must, necessarily, be supplied with some apparatus for producing motion, that is, it must be adapted to use, and the cost of such adaptation necessarily goes into the account, in ascertaining the profit on the sale ; and, unless the defendants can show that the peculiar apparatus by which, in the instruments which they sold, the

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

motion was imparted or regulated, gave them an increased price, not due to the patented improvement however moved or adapted to use, then the cost of such apparatus alone is to be considered, as was done by the master in stating the account. And if, upon the proofs, it be found that the price realized from the attachment is due to the patented device for causing the vibration of the air, as described in, and claimed by, the specification, irrespective of any peculiarity in the mode of producing the motion thereof, then the profits are to be imputed to the complainants' patented device, and to be allowed to them, as was done by the master.

The report must be sent back to the master, to enable the defendants to make further proofs in accordance with these views, if they be able.

Frederic H. Betts, for the plaintiffs.

B. E. Valentine, for the defendants.

In re THE ALABAMA AND CHATTANOOGA RAILROAD COMPANY,
AN ALLEGED BANKRUPT.

A proceeding in involuntary bankruptcy, under section 39 of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 536,) may be prosecuted in the District in which the debtor has carried on business for the requisite time specified in section 11 of that Act, although he resides and may be found in another District.

A railroad company, incorporated by the laws of a State, for constructing and operating a railroad, cannot be proceeded against, in bankruptcy, in a District Court without the State or States where its railroad is, or is to be, built, maintained and operated, on the petition of a creditor, charging an act of bankruptcy.

Allegation and proof that such company kept an office in such District for six months next preceding the filing of the petition, where its officers acted and

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

its board of directors met, and where it contracted debts and made loans, purchases and payments, do not give such Court jurisdiction.

The business of a railroad company, within the meaning of the eleventh section of the said Act, can only be carried on where the railroad is, or is to be, constructed, maintained and operated.

Hence, the District Court for the Southern District of New York has no jurisdiction to adjudge an Alabama railroad corporation a bankrupt, on the petition of a creditor.

(Before Woodruff, J., Southern District of New York, February 1st, 1872.)

WOODRUFF, J. On the petition of a creditor, the respondent, a corporation created and organized under and by virtue of the laws of the State of Alabama, and owning and operating a railroad in the States of Alabama, Georgia, Mississippi, and Tennessee, was summoned to appear in the District Court for the Southern District of New York, to show cause why such corporation should not be adjudged a bankrupt. It was alleged in the petition, that the corporation owned property in the State of New York, and had, for the longest period of time within the six months next immediately preceding the date of the filing of the petition, had its principal office, place of business, and domicile in the city of New York, in which the corporation had transacted the ordinary moneyed, commercial and financial business of a railroad corporation.

The corporation pleaded or answered specially to this petition, that the District Court for the Southern District of New York had no jurisdiction to proceed against the said corporation, upon such petition, or to make any adjudication in bankruptcy against the respondent. After taking proofs touching the carrying on of the business alleged in the petition, by the respondent, within the said Southern District of New York, this plea was overruled, and the District Court then proceeded to adjudge, and did adjudge, the said corporation a bankrupt. The respondent, the corporation, now seeks a review and reversal of that adjudication; and it was stated by counsel, on the argument, that the question to be considered on the review is this: Had the District Court jurisdiction to proceed against this railroad corporation, upon a petition *in invi-*

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

tum, because such corporation transacted, within this District, the business alleged in the petition in this case?

If I were charged with the duty of legislating upon this subject, I should hesitate long before I exposed a corporation incorporated in Alabama or California, for the construction of a railroad in those States, and for maintaining and operating the same there, to a proceeding in a distant District, for the settlement of its affairs, the disposal of its property, and the distribution of the proceeds, (operating practically as a dissolution thereof,) as a bankrupt. It would seem to me most inconvenient and disadvantageous to its creditors, most unsuitable, though not wholly impracticable, in respect of the closing of the estate, collecting, managing, and disposing of the assets, and transferring them, under the direction of the Court, which ought to be conveniently accessible to all who are interested, needlessly, but inevitably, most expensive, and, presumptively, bringing the parties ultimately interested in its affairs, whether as creditors or stockholders, to a great distance, to protect their respective interests, following to this District the proceeds of the railroad and its equipment, which might well be administered at home. Difficulty will ordinarily exist, also, in effectively reaching the officers, to compel their furnishing accounts and details which the law requires for the settlement of the estate; and, even if they can be compelled to send such information here, or to attend here in person to give it, this must be needlessly expensive, troublesome and vexatious, and, in case of resistance, will, in general, be very unsatisfactory in the mode of proceeding, and in its results. Presumptively, at least, the property of such a corporation is invested in its railroad, and its equipment, and means of conducting the business for which it was incorporated, which are in the State or District where its railroad is built and is to be operated, under its charter; and it seems to me wholly unfit, that the District Court for the Southern District of New York should have the duty imposed upon it, of administering the affairs of such a distant corporation. When the fact is recalled, that, probably, no railroad company

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

exists in the United States, which does not habitually transact some business in the city of New York, the burthen and inconvenience of such a jurisdiction, liable to be invoked by any one creditor, on a charge of bankruptcy, becomes apparent, to a degree that makes it incredible that such a jurisdiction, and the consequent duty to exercise it when invoked, have been imposed upon that Court.

It is, however, no part of the duty of this Court to legislate, but only to ascertain and apply the law as it is; and these suggestions can serve no purpose, unless they shall aid in interpreting the statutes under which the proceedings have been instituted, and which are claimed to sustain them.

The 48th section of the bankrupt law of March 2d, 1867, (14 *U. S. Stat. at Large*, 540,) declares, that the word "person," in that law, shall include "corporation." This must, of course, be qualified, in any of the provisions which are necessarily inapplicable to a corporation, and by any provisions that are specially and expressly made for corporations only, if any such there be. But, in respect of the question now before me, I find no such qualification, either express or implied, since no claim is made that the language of the 37th section of the Act prevents its application to a railroad corporation, as has sometimes been contended. The 11th section, providing for voluntary bankruptcy, may, therefore, be read as if the words "moneyed, business or commercial corporations and joint stock companies" were inserted therein, and it will then provide, that such corporation, owing debts, * * * may apply by petition, addressed to the Judge of the judicial district in which such debtor has resided or carried on business for six months, or for the longest period during the six months, next immediately preceding the time of filing such petition; and jurisdiction is given to proceed, on such petition, to adjudge the petitioner a bankrupt. Nevertheless, it is clear, that a corporation can have no residence out of the State by whose laws it was created, and that, therefore, in virtue of residence, no jurisdiction can be acquired by any District Court outside of such State. And, in

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

construing the words "carried on business," it may be proper to consider what, as applied to a corporation, they reasonably import. Again, the 37th section declares, that, upon the petition of any creditor or creditors of such a corporation as is therein mentioned, * * the like proceedings shall be had and taken as are, in the Act, afterwards provided in the case of debtors. This, in terms, subjects the corporations named to a proceeding *in invitum* for an adjudication of bankruptcy, as fully as other debtors are subjected thereto by the subsequent provisions of the Act. Following the Act to its subsequent provisions, we find, that, by section 39, any person—and, of course, any such corporation as is before mentioned—who commits any of the acts specified, shall be deemed to have committed an act of bankruptcy, and, subject to the conditions thereafter prescribed, shall be adjudged a bankrupt, on the petition of one or more of his creditors, &c.

Neither in the 37th nor the 39th section, nor in any other section relating to involuntary bankruptcy, is there any express designation of the Judge or Court to whom the petition shall be presented, or who shall have jurisdiction thereof. The first section of the Act makes the several District Courts of the United States Courts of bankruptcy, and confers on them jurisdiction in all matters and proceedings in bankruptcy, in their several Districts. In which of the District Courts, then, may proceedings be taken by a creditor, whether against a corporation or an individual? No express terms of the statute give an answer to this question. Certainly, it ought not to be open to creditors, or to a creditor, to select any District Court of the United States, at his or their option. It must be such Court as, upon the general rules governing the jurisdiction of the District Court, can acquire jurisdiction, or such Court as may seem to have been intended by Congress, in analogy to the jurisdiction given where the proceedings are voluntary. The latter would seem to be the generally received opinion; and, in this District, it has, I believe, been the practical construction of the Act. The Act having assimilated the proceedings in involuntary bankruptcy, after the respondent has been adjudged a bankrupt, to the proceedings in vol-

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

untary bankruptcy, it is not unnatural to infer, that, when Congress, by the 39th section, authorized an adjudication upon the petition of a creditor, they meant, upon a petition addressed to the Court which, by the previous 11th section, was authorized to adjudge a debtor a bankrupt on his own petition. The Supreme Court of the United States, in framing the sixteenth of the General Orders in Bankruptcy, seem to have acted upon this construction of the Act, in providing for the contingency of two or more petitions against the same individual, in different Districts.

My own unaided examination of the Act would have suggested the doubt, whether, although Congress had given to the debtor the opportunity to apply to the Court of the District wherein he resided, or to the Court of the District in which he carried on business, they had not, when they provided for a hostile proceeding against him, intentionally omitted a similar provision, and, in that respect, intended that the proceeding should conform, by analogy, to the 11th section of the Judiciary Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 78, 79,) which forbids that any civil suit shall be brought, in either the District or the Circuit Court, by original process, against an inhabitant of the United States, except in the District whereof he is an inhabitant, or in which he may be found when served with process. All the provisions of the Act concerning involuntary bankruptcy may be harmonized with this construction. If he reside within the District, then he may be served personally, or by leaving at his place of abode; or, if he have absconded, or be concealed, or his place of residence cannot be ascertained, then by publication, (*section 40.*) Although it was the design of Congress to enable creditors to compel a debtor who has committed an act of bankruptcy to do that which, in a state of insolvency, he ought to do voluntarily, agreeably to the 11th section, it does not follow that they intended to enable creditors, or a creditor, to call the debtor, on a charge of having committed such an act, thousands of miles from his residence, to contest the charge, merely because he had carried on some business at such remote point. The great hardship of such a

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

call is manifest; and the general tenor of the 40th section indicates, that it is where the debtor resides that the proceeding is, in general, to be conducted, his not being found, by reason of his absconding, or being concealed, or having no known residence, being the excepted cases of service by publication. It does not occur to me that there is any greater fitness or propriety in compelling an alleged debtor to go to a remote District to contest, in the Court of bankruptcy, the claim of, or the alleged indebtedness to, a pretended creditor, as well as the truth of the charge of bankruptcy, (for both of these may be involved in the litigation,) than there is in compelling such supposed debtor to go to a remote District to defend an ordinary suit by the same party, under precisely the same circumstances, which, by the Judiciary Act, is expressly prohibited; and, there being no express provision of the bankrupt law to this effect, I should have been reluctant to indulge in construction not necessarily required by what is expressed, so as to produce a result quite in conflict with the former law. In view of the general construction given to the Act, and the sanction such construction has received from the deliberate action of the Supreme Court of the United States, I do not feel at liberty to dispose of this case by giving weight to the doubt which I have thus expressed. I must yield that doubt and hold, until otherwise advised, that a proceeding in involuntary bankruptcy may be prosecuted in the District in which the debtor carries on business, although he resides and may be found in another.

The further conclusion above stated—that a corporation included in the provisions of section 37 is in the like condition, in this respect, as a natural person—leaves only one question open—When applied to a railroad corporation, what do the terms, “in which such debtor has resided or carried on business,” mean?

(1.) A corporation has, and can have, no residence, except in the State by whose laws it exists. It cannot, of its own mere motion, change its residence. This has often been decided by the Supreme Court. This is claimed here by the

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

counsel for the corporation, and it is conceded by the counsel for the creditor. Hence, also, it is well settled, that a corporation created by the laws of one State, cannot be found in another judicial District of the United States, to be served with process, through its officers, in an action in the Federal Courts of such last-named District. Jurisdiction for the District Court cannot, therefore, be maintained in this case on the ground of residence of the debtor, nor on the ground that the debtor, being a corporation under the laws of Alabama, was found in this District.

(2.) Do the facts here show that the corporation, the alleged debtor, carried on business in this District, within the meaning of the said eleventh section of the bankrupt law? In its broadest sense, the term "business" includes nearly all the affairs in which either an individual or a corporation can be actors. Indulgence in pleasure, participation in domestic enjoyment, and engagement in the offices of merely personal religion, may be exceptions, in the case of an individual. But the employment of means to secure or provide for these would, to him, be business; and, to a corporation, these exceptions can have no application. The conduct of any and all of the affairs of a corporation is business. Does, then, the doing of any acts whatever pertaining to the affairs of a railroad corporation constitute "carrying on business," in the sense of the Act? Has the term, "carrying on business," the same meaning as "transacting any of its business"? If the necessities or interests of a railroad company require that an agent should be sent to a timber region to purchase or otherwise procure (*e. g.*, by cutting, sawing, &c.) materials for its superstructure, is that carrying on business there? If it send an agent or agents to a city, the centre of capital, to negotiate its bonds and raise money in aid of the construction of its road, and such agency be continued for that purpose, and for receiving subsequent remittances and making payments of interest or other indebtedness, at an office provided therefor, is that carrying on business in such city, within the meaning of the Act? I am constrained, not

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

only by considerations already suggested, but by what, upon the words themselves, should be deemed their proper interpretation, to answer these questions in the negative. There are, in the carrying on of a business, many affairs which are merely incidental, and which may be, and often are, transacted elsewhere than at the place where the business—that which is the real design and purpose or object in view—is located; and such transactions may be of such frequent, or even daily, occurrence as to require an agency of considerable duration. It would seem to me greatly unjust and unreasonable to regard such transactions as a carrying on of business, in the sense of the law. “Carrying on business” looks to the scheme and purpose to which such transactions tend, and not to the incidental transactions themselves. Thus, the business of a railroad corporation is, by its charter, the construction, maintenance, and operation of a railroad. That is its business. In aid thereof, it may be necessary or expedient to employ agents and agencies—since it can only act by agents—in other places than those in which its business of constructing, maintaining, and operating the road can be done. But, the transactions of such agents are only collateral or incidental. They do not, in a just sense, constitute the business of the railroad company. That business cannot be removed. The company itself cannot transfer it. Agents, or officers who are agents, and only agents, may, from a distance, advise therein, give rules or directions to other agents for its management; but the business of the railroad company can only be done where the railroad is, or is to be, constructed, maintained, and operated.

The petition herein states, that the alleged bankrupt corporation has had its principal office, place of business, and domicile, in the city of New York—in part, at least, a legal impossibility—in which place, and during, &c., such corporation has transacted the ordinary moneyed, commercial, and financial business of a railroad corporation. There was evidence that what the officers of the corporation called its general office was in New York; that its officers were there, and

In re The Alabama and Chattanooga Railroad Company, an alleged Bankrupt.

its board of directors were accustomed to meet at such office ; that there the records and various accounts of its affairs and business were kept ; and that there the corporation procured loans, or made purchases, in aid of the construction of its railroad and its equipment. Here is but an agency, whether it be minor or major, special or principal. It does not affect the present enquiry, that the agents embrace more or less in number or in authority. It is not here that the business is done, or can be done, for which the company was created, although here are business transactions, within the power of the corporation, it may be, but only in aid of its substantive business, and incidentally necessary, perhaps, to its accomplishment.

Further illustrations might be drawn from the existence of very numerous banks, and manufacturing and other corporations, in the various States of the Union, which, although carrying on the business for which they are incorporated within the States where they are created, nevertheless have, for very important and necessary incidental transactions, continuous agencies in one or more of our principal cities. It was not intended, by reason of such transactions, to subject them to proceedings in bankruptcy where those agencies were maintained, whether there conducted by agents under one name or another, either officers, clerks, or by whatever name or official relation designated.

In view of all the considerations which I have suggested, I am of opinion, that, in reference to a railroad corporation created by the State of Alabama, for the building, maintaining, and operating a railroad in that State, a construction of the Act which subjects it to proceedings in bankruptcy in this District is not reasonable, not required by the language of the statute, and not according to its intention. I do not fail to see, that the contrary may be plausibly argued, as, in fact, it has been, plausibly and ably, by the counsel for the creditor. But the corporation cannot itself remove to this District. It cannot, in this District, carry on the business for which it was created. It can only, out of sufferance, do

Smith v. Elliott.

here such collateral or incidental things as are not its substantive business, but only aids thereto, or which facilitate its accomplishment.

It follows, that the objection to the jurisdiction of the District Court for the Southern District of New York should have been sustained, and the petition of the creditor dismissed. The adjudication declaring the company a bankrupt is, accordingly, reversed.

Clarence A. Seward, for the railroad company.

Enoch L. Fancher, for the creditor.

WILLIAM SMITH

vs.

HENRY ELLIOTT, AS EXECUTOR OF JOSEPH T. WHITEHOUSE.
IN EQUITY.

The reissued letters patent granted to William Smith, June 30th, 1868, division B, for an "improvement in corded elastic fabrics," the original letters patent having been granted to him April 5th, 1853, and subsequently extended, are void for want of novelty.

The claim of such reissued patent, namely, "The corded fabric, substantially as hereinbefore described, in which the cords are elastic, and are held between the upper and under weft threads, and separated from each other by the interweaving of the upper and under weft threads with the warp threads, in the spaces between the cords, and only there, substantially as above shown," is anticipated by a like fabric which existed before, although not woven of a width, or fineness, or elasticity, suitable to be used for the gores of boots, and not so used, and although the fabric introduced by the patentee possessed the

Smith v. Elliott.

qualities which fitted it to be used for the gores of boots, and it was so used, and displaced other elastic fabrics before used for that purpose. The fabric not being new, its application to a new use was not invention.

(Before WOODRUFF, J., Southern District of New York, February 7th, 1872.)

WOODRUFF, J. This case and seven other cases, brought by the same complainant against different defendants, were argued and submitted together, upon like pleadings and upon the same proofs, under a stipulation that the proofs taken in either should be read or used in all. The bills of complaint are filed to restrain the respective defendants from infringing a patent granted to the complainant, April 5th, 1853, and subsequently extended and twice reissued. The patent was last reissued to the complainant in 1868, in three divisions:—one, described as for “improvements in weaving,” in which the process is claimed; another, entitled, “improvements in looms for weaving,” wherein a certain part of the loom, in combination with mechanism, is claimed; and a third, in which the specification is entitled, “improvement in corded elastic fabrics,” in which the fabric is claimed by the complainant as his invention. The bills allege, that the defendants, respectively, have infringed the last named division of the reissued patent, for the new fabric, which is dated June 30th, 1868, and is called, “division B”; and they pray an injunction and an account. Without setting out the answer, it is sufficient to say, that the defendants rest their defence on the denial of the novelty of the invention, and upon proofs tending to establish that a fabric answering fully to the description of the fabric described and claimed in the complainant’s specification, was made by many persons, and was in public use and on sale in this country, several years before the alleged invention by the complainant.

The description in the specification first gives the loom in which the fabric is made, and its operation, then mentions the manner in which corded fabrics have theretofore been produced, and the peculiarities of such fabrics, and then proceeds to describe the fabric claimed to be new. Modified by

a disclaimer, made pending these suits, the description is as follows: "The features which distinguish my improved corded fabric, from all others before known, are as follows, viz.: The cords are longitudinal, and may be termed cord warps. They are separated from each other by the interweaving of the warp threads and weft threads, * * * between the cords only, and not over and under the cords; and the cords are covered on both surfaces by weft threads only. The weft threads are not interwoven with the cords, * * * * but each weft thread passes either over or under all the cords, instead of passing first under one cord, and then over the other, and so on across the fabric; and it is interwoven only between the cords, and only so interwoven with the warp threads. The fabric being so constituted at every part of the length, the cords are gripped between two weft threads, one above and the other below, which two weft threads are drawn each half way around each one of all the cords, by being interwoven with the warp threads, in the several spaces between the cords." Then, proceeding, in terms, to limit himself to such fabrics when the "cords" are elastic, the patentee states his claim thus: "What, therefore, I claim as my invention, in this subdivision of my patent, is, the corded fabric, substantially as hereinbefore described, in which the cords are elastic, and are held between the upper and under weft threads, and separated from each other by the interweaving of the upper and under weft threads with the warp threads, in the spaces between the cords, and only there, substantially as above shown."

The proofs herein indicate, that the plaintiff, at or about the date of his patent, produced a woven elastic fabric of great utility, adapted to purposes for which no similar fabric before made in this country was suitable, possessing a beauty of finish and texture most desirable and attractive, and having firmness and durability combined with great elasticity, to a degree not before found in any fabric in the market. Although the purposes for which it might be used were several, its most important use was for gores inserted in the tops of

gaiter boots, to be stretched in drawing on the boot, and, by contraction, binding the top of the boot firmly around the ankle, after the boot was drawn on. Made of silk, or silk and cotton, warp and weft, the latter covering elastic cords, (india rubber being, in practice, used therefor,) the threads of silk or cotton being of great fineness, the fabric has a fine glossy appearance. The cords lying very close to each other, the whole is not greatly unlike very rich, heavy, corded silk goods found in the stores. The manner in which the weft threads are tightly bound upon the enclosed elastic cords, by the interweaving of the warp threads therewith, holds the cords so firmly that they cannot slip or slide; and, hence, the fabric can be cut, and its cut edge may be attached, by sewing, to leather or cloth, &c., without any withdrawing of the elastic cords, when stretched in use. By reason of its excellence in these and, perhaps, other respects, the fabric has gone into extensive use; and it is alleged that it has occupied the market, and, for the especial purpose of elastic gores in gaiter boots, is the only fabric now used.

The complainant being the meritorious cause or agent in such a result, whether the same is due either to his industry as a laborer, his skill as a weaver, his judgment as an observer and experimenter, or his invention as an originator of either machinery, process or product, he is entitled to very favorable consideration; and a certain sense of justice would seem to require that, if possible, an adequate reward for the benefit derived therefrom by the public should be secured to him. The law, however, gives no monopoly to industry, to wise judgment, or to mere mechanical skill in the use of known means, nor to the product of either, if it be not new. These are within the proper field of competition, and open to all. In general, they will, in that competition, be justly appreciated, and will command their proper remuneration, if usefully employed. It is invention of what is new, and not comparative superiority, or greater excellence, in what was before known, which the law protects, as exclusive property; and it is that alone which is secured by patent. Whether the

results attained by the complainant, above mentioned, are due to improved machinery invented by him and secured to him by patent, or are due to a peculiarity in the process of manufacture invented by him and patented, it is unnecessary, in this case, to enquire. For aught that appears here, either of these may be true; but the defendants are not charged with violating his rights as an inventor of either machine, loom, or process, but only as invading his alleged exclusive title to the product itself.

On that subject, it should be observed, that there are many changes which may be suggested by the judgment or taste of the manufacturer, or by the particular uses to which the article produced is to be applied, which are not invention; and many exhibitions of superior skill, in producing an article of greater excellence, which are not invention. Thus—if a fabric be already known and in use, change of color, change of mere material, change in its degree of fineness, or in the fineness of parts thereof, if these changes involve nothing new in construction, in the relation of its parts, in the office or function of either part or of the whole, do not constitute invention, although, for many purposes, these may constitute the greater excellence of the fabric. Indeed, in the present case, not even such changes are claimed, in the complainant's specification, to have been made; and yet the argument submitted on his behalf dwells largely on peculiarities in the complainant's fabric, as it has actually been made and used, which are of this character only, and largely, also, on the special use to which it has been applied, namely, to the making of gores for boots, and its fitness for such use. But the complainant, in his specification, claims nothing on this ground. In practice, for the making of the fabric, the elastic cords now used are made of vulcanized india rubber, for greater elasticity and, perhaps, greater durability; but the claim of the patent is for any elastic cord, of whatever material; and it is by no means clear, that, when the complainant received his patent, he used vulcanized rubber himself. In practice, for the making of the fabric for shoe gores,

Smith v. Elliott.

silk, upon the upper surface of the fabric, is used, and, no doubt, is required, in order to the beauty and finish desired for that use, and, it may be, for other uses; but the claim of the patent is for any warp threads and weft threads, and this will embrace any fibrous materials from which such threads may be wrought. In practice, the threads used for warp and weft are very fine, by which, first, the cords are permitted to lie very close to each other, and, second, their covering by the weft is very smooth, and so the whole fabric has an evenly and compactly corded surface; but the claim of the complainant embraces warp threads and weft threads of whatever quality or fineness, only limited by the practicability of weaving them in the manner pointed out. In practice, few threads of warp are woven or interlocked between the cords; but the claim of the complainant includes warp threads interwoven with weft threads between the cords, whether such warp threads be few or many. In practice, when such fabric is intended for goring for boots, it is woven of a width corresponding with the length of the gore; but the claim of the complainant makes no discrimination in respect of the width of the fabric claimed. In fact, it is made, for other purposes, exceedingly narrow, and, within the description in the patent, it may be made of any width desired, and for any purpose. In practice, its special adaptation for gores of boots, and its value for that use, is illustrated in the particulars wherein they require fineness, smoothness, finish, durability and, especially, very great elasticity; but the claim of the complainant is not for any peculiarities in these respects, nor is it for an improved gore at all. If it were conceded that the complainant might have obtained a patent for an improved elastic gore for boots or shoes, founded upon facts appearing in the proof herein, it would, for the purposes of this case, be necessary to say, that he has not done so.

Once more, if the fabric be not new, the application of it to a new use is not invention, when nothing novel is required for its adaptation. If the complainant had first invented the combination of an elastic gore with the other parts of a boot

Smith v. Elliott.

or shoe, there might be therein something which was the proper subject of a patent; but this has no bearing on the question, whether the elastic fabric of which the gore is made is the complainant's exclusive property.

Aided by the foregoing observations, how stands the present case, upon the proofs? The complainant must abide by the specification and claim which he has made. If he has rights which, under that specification and claim, are not protected, the Court cannot aid him. The question here is—Was the fabric, which he has described and claimed to be his invention, new?

The claim is, for "the corded fabric, substantially as hereinbefore described, in which the cords are elastic, and are held between the upper and under weft threads, and separated from each other by the interweaving of the upper and under weft threads with the warp threads, in the spaces between the cords, and only there, substantially as above shown." This claim is, of course, to be construed with reference to the preceding specification; and above I have stated what is material to its full meaning. Width of fabric is not of the substance of this specification or claim. They embrace all widths. Degree of elasticity is of no significance, nor is fineness or coarseness of threads, nor the material of either the threads or cords, nor the number of weft threads, nor the number of warp threads between each cord. All these may be varied indefinitely, and yet be within the specification, and within this claim; and the uses to which the completed fabric is adapted is in no wise suggested as any test of its likeness to what is claimed, or as at all entering into the complainant's alleged invention.

It is shown, on the part of the defendants, that, several years prior to the alleged invention, a fabric was made extensively, and was in general use, which answers in every particular to this claim of the complainant. It was chiefly used for suspenders, braces, garters, and the like. It was generally made of cotton warp and weft threads, and cords of native india rubber. True, it was not, in general, of either a

Smith v. Elliott.

color, fineness, width or finish which was suitable for the gores of boots. But it was a "corded fabric," in which the cords were "elastic," in which the cords were "held between the upper and under weft threads, and separated from each other by the interweaving of the upper and under weft threads with the warp threads," and in which this interweaving was "in the spaces between the cords, and only there." The testimony of the witnesses is to complete identity, in these respects, with the fabric claimed. A careful examination of the fabrics fails to disclose any difference in the crossing of the threads, in the interweaving, or in any other respect, which discredits or contradicts the witnesses; and they are uncontradicted, in fact, on these points, by other testimony. A short mode of disposing of this evidence was repeatedly suggested by the complainant, in the conduct of the examinations before the examiners, namely, by imputing to witnesses fraud and perjury—conduct, on his part, in the course of such examinations, deserving severe reprehension; and it may be added, that the proceedings before the examiners are returned to the Court abounding in improper remarks, prolix statements touching the conduct of counsel, officers of the Patent Office, witnesses, and others, which are not proof, and which ought to have been expunged at the cost of the complainant, before the case was brought to a hearing, or the proofs printed for the use of the Court.

The Court must deal with the uncontradicted testimony according to the ordinary rules by which evidence is to be weighed; and it is quite clear, that the defendants have established the facts above stated. True, these fabrics do not appear to have been woven of a width sufficient for gores of boots. The material does not appear to have been of suitable fineness to render the fabric attractive for that purpose, although there is some evidence which may qualify this observation. Such a use does not distinctly appear to have been made of those fabrics, until the complainant commenced the manufacture. It is, at least, doubtful, whether those fabrics had the elasticity which is required for shoe gores;

Smith v. Elliott.

and, in other particulars, there were differences, not in construction or kind, but only in degrees and qualities, not of the substance of the invention claimed.

If the complainant's patent had been prior in date to the manufacture of these fabrics, and was otherwise valid, there is not a doubt, there can be none, that these fabrics are directly within the claim of the complainant, and would have been plain infringements of his patent. This is a rational and, in general, when they include the whole of an alleged invention, a conclusive test of the originality of the latter.

It would be a work of supererogation, as well as of great labor, to recite the testimony which establishes that such fabrics were made before the complainant even began his experiments. It runs through the mass of the testimony given by the witnesses examined by the complainant as well as those examined by the defendants. Those fabrics were made in various colors, and with various differences in ornamentation; some with a large number of threads of warp between the cords, so interwoven as to produce cloth in the intermediate spaces, and some with few threads binding the upper and lower weft threads together; some with a selvage like the complainant's and some with around-corded selvage, and some with a cloth edge, which, when it was contracted, formed a ruffle. But the whole substance of the complainant's alleged invention is there, sometimes in its simple and literal exactness, and sometimes with accessories.

I am compelled to say, that the fabric, as claimed by him in the specification annexed to his patent, was not new, and that these actions cannot be maintained.

The bills of complaint must, therefore, be dismissed.

Thomas A. Jenckes, for the plaintiff.

George Gifford, Benjamin Dean and William C. Witter,
for the defendants.

In re The Boston, Hartford and Erie Railroad Company.

In re THE BOSTON, HARTFORD AND ERIE RAILROAD
COMPANY.

The principles decided in *In re The Boston, Hartford and Erie Railroad Co.*, (ante, p. 101,) affirmed.

Under the bankruptcy Act of March 2d, 1867, (14 U. S. Stat. at Large, 517,) where petitions for adjudication are filed in two or more District Courts, each having jurisdiction, the Court in which the petition is first filed ought to be accorded exclusive jurisdiction over the case.

An adjudication in bankruptcy was signed by the District Judge in New York on March 1st, but was not made known, or promulgated, or filed, until March 3d. On March 2d, the District Court for Massachusetts made a decree adjudging the same debtor a bankrupt: *Held*, that the adjudication in Massachusetts was the prior adjudication.

(Before WOODRUFF, J., Southern District of New York, February 15th, 1872.)

WOODRUFF, J. On the 21st of October, 1870, Seth Adams, a creditor of the Boston, Hartford and Erie Railroad Company, filed his petition in the District Court for the District of Massachusetts, alleging that the said company had committed an act of bankruptcy, and praying that it be adjudged a bankrupt, &c. On the 20th of December, 1870, James Alden, also a creditor, presented his petition, with a like allegation and prayer, to the District Court for the District of Connecticut. On the 31st of December, 1870, the said James Alden presented his like petition to the District Court for the Southern District of New York. To these several petitions the company appeared and answered, resisting the application for such adjudication. Pending the petitions, Seth Adams, the petitioning creditor in Massachusetts, applied, both in New York and Connecticut, for leave to intervene and oppose the said applications there made. On the 28th of February, 1871, the company withdrew its answer in each of the said Districts, and on the 2d of March, 1871, the District Court for Massachusetts adjudged the company bankrupt, by a formal decree of the

In re The Boston, Hartford and Erie Railroad Company.

said Court, and issued its warrant to the Marshal of that District, in accordance with the statute.

This decree was shown to the District Court for Connecticut, by the supplementary petition of the said Adams; but, notwithstanding such decree, the District Court for Connecticut refused leave to Adams to appear to resist the proceeding in that Court, and dismissed his petition, and thereupon proceeded to adjudge, and did adjudge, the company bankrupt. On a petition of review, presented by Adams to the Circuit Court, it was held, (*In re The Boston, Hartford and Erie Railroad Co.*, ante, p. 101,) in September, 1871, that he was entitled to be heard in the District Court, and that his petition ought not to have been dismissed. The Circuit Court thereupon proceeded, upon the facts alleged in his petitions, which were not controverted, to direct that all further proceedings in the District Court for Connecticut be stayed, in order that the District Court for Massachusetts might thereafter exercise exclusive jurisdiction, for the closing of the estate and distributing the same among the creditors of the corporation.

The like petition of Adams was brought to a hearing in the District Court for the Southern District of New York, on the 25th of February, 1871, and the District Court decided, on the 27th of February, 1871, that Adams had no standing in Court, in that stage of the proceeding, prior to an adjudication of bankruptcy, and that he ought not to be permitted to intervene to resist or stay the proceedings pending in this District; and an order denying his motion was made. But, on the 2d of March, on the application of the counsel for the Adams, the Court allowed a re-argument, and such re-argument was had on the 3d of March. On the re-argument, and in further support of his claim of title to intervene, the counsel for Adams produced and read in evidence the decree of the District Court for Massachusetts, adjudging the company a bankrupt. At the close of the re-argument, the Court refused to permit such intervention, and then the following facts appeared, namely, that, after the withdrawal (on the

In re The Boston, Hartford and Erie Railroad Company.

28th of February) by the railroad company of its answer to the petition of Alden, praying that the company be adjudged a bankrupt, an order or decree adjudging such bankruptcy was drawn and delivered to the District Judge; that, on the 1st of March, he signed the same, but retained it in his personal keeping until after the said re-argument, without any notice to either of the parties, or their attorneys or counsel, or to the clerk of the Court, of the fact of such signing, and that he endorsed upon such order or decree the words, "Filed, March 1st, 1871. S. B." On denying the application of Adams, after such re-argument, the District Judge announced these facts in open Court, and delivered the said order or decree, adjudging the company a bankrupt, to the counsel for Alden, the petitioning creditor, and the same was by him delivered to the clerk of the Court, to be entered in the minutes and records of the Court. Adams thereupon presented his petition to this Court, praying a review and reversal of the said proceedings of the District Court, and that all proceedings in bankruptcy against the said company, in the said Court, might be stayed, and for other or further relief.

Though not material to the questions considered on the review, it is proper to state that the Adams Express Company had, by leave of the District Court, become a co-petitioner with Alden, and the proceedings of Adams had, by supplemental petition, been made to apply to the proceedings of both of such petitioning creditors.

It is unnecessary, in disposing of this review, to repeat the observations which were made on deciding the very similar review of the proceedings between the same parties in the Circuit Court for the District of Connecticut. Considerations were then suggested, tending to show the embarrassment, inconvenience and unsuitableness of an endeavor to administer the estate of the Boston, Hartford and Erie Railroad Company, as a bankrupt, and bring the same to a close by collecting and disposing of its assets and distributing its effects among its creditors, by proceedings in several

In re The Boston, Hartford and Erie Railroad Company.

District Courts, and, as the case may be, through the instrumentality of different assignees, appointed by these Courts; the impracticability of bringing the fund together for one general distribution; the possible, not to say probable, conflict of title between the assignees, the title of each of whom, if valid, must be recognized in all Courts; the possible different results of contests in the several jurisdictions respecting debts offered to be proved by creditors whose claims may be disputed; the useless and vexatious trouble and annoyance to creditors, if they be required to go into each jurisdiction and prove their claims; the useless and extraordinary expense and waste of the estate, by subjecting its administration to such multiplied proceedings; the unfitness and unreasonableness of continuing proceedings in more than one District, and that the case is eminently proper for the application of the general rule, in Courts of equity, among Courts of co-ordinate jurisdiction, that, when one has first obtained jurisdiction of the subject matter and of the parties, other Courts should stay their hand and permit such Court to carry the proceeding to a consummation and final disposition of the matter in question—all these and, perhaps, other like considerations, were suggested in the opinion delivered on the review had in Connecticut. Nothing is, I think, more certain, than that Congress, in enacting the bankrupt law, did not contemplate any such complication, and, I deem it equally certain, that nothing in its provisions produces any such necessary result. The several District Courts of the United States are not acting under authority derived from separate sovereignties; they are not administering separate systems of laws; they are not charged with a duty to afford special protection to the residents within their local jurisdiction—all which circumstances sometimes lead to conflict of jurisdiction between tribunals of different States, and operate to secure unequal results among parties interested, but residing in different States, domestic or foreign. The District Courts act by one authority; they execute the same law; each, in the administration of the estate of a bankrupt, will do precisely

In re The Boston, Hartford and Erie Railroad Company.

what each other District Court will do, governed by the same rules and to the same end.

In the opinion referred to, the bankrupt law was examined, and the general orders in bankruptcy, made by the Supreme Court, were considered, to ascertain, first, whether such proceedings must necessarily, if begun, be continued in more than one District Court; if not, then, which District Court should be deemed to have priority of jurisdiction and be permitted to go on and complete the administration; and, finally, if the bankrupt, with a view to hinder and embarrass the winding up of the affairs, should lie by silently, or, colluding with one or more of the parties, to produce such embarrassment, would not take any measures to prevent the action of either Court, nor call to the attention of either the fact that prior proceedings were pending in another District, whether a creditor could bring the matter to the attention of the Court, and ask that the proceedings subsequently commenced, be stayed, in order to avoid the expense, embarrassment and litigation about to arise to the prejudice of creditors, and to the waste of the fund which creditors have a right to share.

The Court did not affirm the broad proposition, that, whenever a creditor filed a petition against his debtor, for a decree declaring such debtor a bankrupt, any other creditor was at liberty, and as of course, to appear and claim a right to oppose such adjudication; but it was held, that the Court was not hindered from entertaining the application for leave to oppose, by rigid technical rules, governing actions at law *inter partes*, and that cases might exist in which a creditor should be heard, and, on sufficient grounds, his intervention might properly be effective. It was, accordingly, held, that, it appearing to the District Court in Connecticut, on the petition of Adams, that he was the petitioning creditor in the District Court in Massachusetts, that his petition was there filed on the 21st of October, 1870, that the petition in Connecticut was filed on the 20th of December, 1870, and that the District Court for the District of Massachusetts had, on

In re The Boston, Hartford and Erie Railroad Company.

the 2d of March, 1871, decreed the company a bankrupt, and issued its warrant to the marshal, as required by the Act of Congress, the District Court for Connecticut ought to have received the petition of Adams and stayed its further proceedings. Subsequent reflection, aided by the argument of the review here pending, has deepened the conviction, that the order made in Connecticut was right and proper. The only question, therefore, which is open here, is, whether the District Court for Massachusetts should be accorded, either as matter of strict right, or in conformity to the practice of Courts of equity having co-ordinate jurisdiction, above adverted to, the same priority of jurisdiction over the District Court for the Southern District of New York, which was yielded by the Court for Connecticut.

In partial review of some of the reasons for the former decision, it is suggested, that there is no express provision of the bankrupt law assigning to either Court priority, when two or more petitions are filed against a corporation debtor; and that the sixteenth of the general orders in bankruptcy does not apply to corporations at all, but only to individual natural persons, and co-partnership firms composed of individuals. If this were conceded, it would not prevent the conclusion which was there reached, for three reasons: first, all the considerations which should dispose the Court to accord to the tribunal which first obtained jurisdiction of the subject matter and of the parties, the continuance of the proceeding to its close, would require, that the District Court for Massachusetts, in which the petition against this bankrupt was first filed, should be permitted to have the exclusive administration, without the interference of any other District Court; second, by the express provision of the bankrupt law, (§ 14) the appointment of an assignee, and the transfer of the assets to him, relate back to the commencement of the proceedings, that is, to the filing of the petition, and, thus, the filing of the petition operates not only to render acts done at an earlier period—within six months preceding, (§ 39,)—grounds of adjudication, which would not avail in the other Courts,

In re The Boston, Hartford and Erie Railroad Company.

but it also enables the assignee to impeach earlier transactions—within six or four months (§§ 14, 35, 39,)—as preferences to creditors, seizures on attachment, executions, &c., and other conveyances, which could not be impeached under later proceedings, and, consequently, the estate to be divided to creditors may be very greatly less, or even swept beyond their reach, if the Court in which the petition is first filed be not permitted to administer the estate; and, third, in the only instance in which the Act of Congress itself appears to contemplate the possibility of proceedings being begun in two different District Courts, (§ 36)—where proceedings are instituted in different Districts against co-partners residing in such different Districts—it directs, unqualifiedly, that the Court in which the petition is first filed shall retain exclusive jurisdiction over the case. It would, in the absence of express provision, be altogether fitting to regard this as a proper rule, by analogy, whenever petitions are filed in two or more District Courts, each having jurisdiction.

It was insisted, on behalf of Adams, that the sixteenth of the general orders in bankruptcy does apply to a corporation, and to this corporation, either as if it were an individual natural person, or as a joint debtor in the nature of a firm, it being incorporated in several States, and yet having a common stock, common property, common interests, and owing the same debts, by force of the same obligations; but, that the bankrupt was not a corporation, by the laws of the State of New York, and the District Court here could have no jurisdiction to proceed against the bankrupt, except on the ground that it carried on business in this State, having its residence or domicile in the State or States by which it was incorporated.

The bankrupt, by an Act of the legislature of the State of New York, passed April 25th, 1864 (*Sess. Laws of N. Y., chap. 385*), was authorized to purchase the franchise and property of certain corporations organized under the general railroad laws of the State of New York, to construct a railroad in this State, from the town of Fishkill to the boundary

In re The Boston, Hartford and Erie Railroad Company.

of Connecticut, and the Act declared that the sale and conveyance should be effectual in law to pass title to the franchise and property sold, and that, on the filing and record of the certificate of sale and conveyance, the said Boston, Hartford and Erie Railroad Company should become possessed of the rights of charter and property sold, conveyed and described, and might have, hold and use the same, in their own right, as a portion of their railway line and property, and have all the rights the corporation making the sale and conveyance had, at the time of such conveyance, to construct and operate a railway within the terminal points designated in the charter of the company making the conveyance, and subject to the laws of this State, passed, or that may be passed, concerning railroad corporations. The purchase and conveyance contemplated by this Act were made, and the certificate of conveyance appears to have been filed, and the respondent is alleged to have carried on business in this State in pursuance of the said Act.

If the case of such a corporation is not provided for, either in the terms of the Act, or by the general orders in bankruptcy, the propriety of giving to the Court, in which the petition is first filed the administration of the estate, has been sufficiently indicated. If the sixteenth of the general orders in bankruptcy should be construed to apply, then also; so far as the proceedings here proceed upon the carrying on of business in this State, as the ground of jurisdiction, the rule requires, that the first hearing shall be had in the District in which the debtor has his domicile; and, if the peculiar fact of incorporation in more than one State creates an analogy to a firm or copartnership, then, also, the petition first filed must be first heard. In either aspect of the case, neither the general orders in bankruptcy, nor the general principles governing like subjects, nor the fitness or propriety of the thing, requires or permits the continuance of two distinct proceedings and the consequent double administration of the bankrupt's estate. And, once more, if, instead of regarding the Act of the legislature of the State of New York as a permis-

In re The Boston, Hartford and Erie Railroad Company.

sion given to a corporation created by the States of Massachusetts and Connecticut to construct, maintain and operate a railroad in this State, it be held that the Act and the conveyance in pursuance thereof operated to make the Boston, Hartford and Erie Railroad Company a corporation in New York, and liable to be treated as a corporation created by the laws of New York, then the case now under review is the same in these respects as the case which was under review in the Circuit Court for Connecticut, for, the company was, in the very terms of the Acts of the legislatures of Connecticut and Massachusetts, a corporation in each of those States.

There remains, therefore, no ground for withdrawing the case under review from the operation of the case already decided, unless what took place in the District Court in the Southern District of New York, prior to the 2d of March, 1871, gives to the District Court last named priority and precedence of the District Court for Massachusetts, by which, on that day, the respondent was adjudged a bankrupt. Without here enquiring, in view of all that has been suggested in this or the former opinion, whether, if it be regarded as amounting to an earlier adjudication of bankruptcy, it should have the effect last above mentioned, it may be sufficient to consider the prior question: Was it an adjudication of bankruptcy, in any legal sense, which gives such priority?

My conclusion upon this branch of the subject is, that it was not an adjudication prior, in legal effect and operation, to the adjudication in Massachusetts, if that were the sole test by which this review must be decided. This conclusion rests upon two grounds: first, that it had no legal operation or effect until after the adjudication in Massachusetts; and, second, that, if it could be deemed of any significance that the District Judge had set his signature to a decree, retaining it within his sole knowledge, possession and control, that significance was wholly suspended and rendered inoperative by the granting of a reargument of the application of the petitioner herein, for leave to appear and oppose any adjudication in the District Court.

In re The Boston, Hartford and Erie Railroad Company.

(1.) In the progress of proceedings in bankruptcy, and in proceedings in formal suits, both at law and in equity, it is a common practice for the Judge to receive the papers on a motion or on a final hearing, for consideration. It is not to be held, that if, on such consideration, he should, in the first instance, in the privacy of his chambers, or in his library, set his hand to the form of an order or decree, his power over the subject is *ipso facto* gone, and that act is final. On the contrary, he may—beyond all question, Judges often do—prolong his consideration; and, if he find reason to conclude that his first impression was erroneous, he may make the final decision conform to the result of his most full and deliberate examination and reflection. This alone, if correct, shows, that such mere subscription is not, *per se*, an adjudication of the matter.

Nor can it be sustained as an adjudication, by the suggestion, that it is an adjudication which, if he does not change his conclusion, operates, by relation, back to the date of the signing, or, in other words, that it may be regarded as a provisional adjudication, to stand, if no sufficient reason occurs to the Judge for changing it. Some observations pertinent to this question, in both aspects, may be found in the opinion in *The American Wood Paper Company v. The Glen's Falls Paper Company*, (8 *Blatchf. C. C. R.*, 513,) in which an attempt was made to give a precedent effect to a judicial determination by the Acting Commissioner of Patents, because, as he testified, he had made up his mind and endorsed and signed a decision, which he retained to abide the result of further consideration, if a further opposing argument should be presented.

A fair and just test of the question may be suggested, by enquiring—when does the time to appeal begin to run, where it is limited to a specific period after the order or decree? If the adjudication were to be deemed operative from the signing by the Judge, and while all knowledge thereof was confined to the breast of the Judge himself, the whole time to appeal might elapse while he held the order or decree in his

In re The Boston, Hartford and Erie Railroad Company.

own possession, and the right of appeal be thereby wholly defeated.

I have no hesitation in saying, that the draft of an order, though signed, remaining in the sole possession and knowledge of the Judge, whether for the purpose of further consideration, or for any other reason, is subject to his control; it is not final, so as to conclude him; and, until it is, in some manner, notified to the clerk of the Court, or to one of the parties, in such wise that his decision can properly be said to be promulgated or announced, it concludes no one. Decisions of Court, announced in open Court, are often and properly held to affect parties charged thereby, although the formal order or decree has not been entered; but decisions lying in the breasts of the Judges can have no such effect, and the mere fact that the latter have been set down on paper ought to give them no different operation. This is not to be taken to import that all orders must be announced formally in open Court, or that orders which may be made out of Court must be formally proclaimed, but there must be something tantamount to promulgation or delivery, something of which the parties to be affected can have or can obtain knowledge, before their rights can be said to have received adjudication, something which completes and authenticates the judicial act.

(2.) The practical construction given by the District Court to this act of signing the order, given while the order remained within the sole knowledge and possession of the Judge, was in conformity with the view last above suggested. A re-argument of the application of this petitioner was ordered. This can have but one meaning. The application of the petitioner was for leave to appear and oppose the proceeding of the District Court to any adjudication touching the bankruptcy of the company. Now, whether he had or had not sufficient grounds for his application, the re-argument proceeded wholly on the idea that, as yet, no such adjudication had been made.

(3.) The rehearing operated to take away any possible significancy, in this respect, from such private signing of an order. Even when a final decree has been promulgated and

In re The Boston, Hartford and Erie Railroad Company.

entered, a rehearing was held, in *Brockett v. Brockett*, (2 How., 238), to suspend its operation, and an appeal taken within ten days after the refusal, on the rehearing, to open such decree, was, on that ground, held to operate as a *supersedeas*. In a Court of equity, the granting of a rehearing operates to open the decree for further examination, in whole or in part, according to the nature and extent of the grounds for rehearing. (*Consequa v. Fanning*, 3 Johns. Ch. R., 587, 594, 595; *White v. Carpenter*, 2 Paige, 217, 262, 263; *Ferguson v. Kimball*, 3 Barb. Ch. R., 616.)

The result is, that there is nothing in the case presented upon this review which withdraws it from the operation of the decision heretofore made, as above stated, in the District of Connecticut.

In that District it was not deemed necessary to reverse the adjudication of bankruptcy which had been made. The same assignees who had been chosen and approved in Massachusetts had also been chosen and approved in Connecticut, and such double sanction could work no prejudice to any party in interest. It was deemed sufficient to stay any further proceedings. Here, as I am informed, an additional assignee was appointed. That appointment does not appear by the papers before me. But that appointment would, of course, fall with a reversal of the adjudication in bankruptcy. I have no doubt of the power of the Court to make such order herein as may best secure all interests, and, if the facts occurring are not admitted, to make a proper enquiry to ascertain them. It will be sufficient to reverse all proceedings subsequent to or founded upon the adjudication of bankruptcy, and stay all further proceedings in the District Court.

Joseph H. Choate, for Adams.

Clarence A. Seward and *Charles M. Da Costa*, for Alden and The Adams Express Company.

J. Langdon Ward, for the bankrupt.

BENJAMIN C. TILGHMAN

vs.

GEORGE F. MORSE. IN EQUITY.

The letters patent granted to Benjamin C. Tilghman, October 18th, 1870, for an "improvement in cutting and engraving stone, metal, glass, &c.," are valid.

The use, for ornamenting the surfaces of glass and metal, of the process described in letters patent granted to George F. Morse, November 21st, 1871, for an "improvement in the ornamentation and dressing of the surfaces of glass and other substances," is an infringement of the first claim of the said patent to Tilghman, which is, "The cutting, boring, grinding, dressing, engraving, and pulverizing of stone, metal, glass, pottery, wood, and other hard or solid substances, by sand used as a projectile, when the requisite velocity has been artificially given to it by any suitable means."

The word "artificially," in such claim, and throughout the specification of the Tilghman patent, covers the falling of sand through a vertical tube, high enough to enable the sand to acquire sufficient velocity to do its work.

Such claim is a claim for a process or art.

The invention of Tilghman consists in the discovery, that a stream of sand, driven with sufficient velocity to cause the grains of sand, through their own velocity and momentum, to act as projectiles against the article to be cut or dressed, will do the work effectually, without any vehicle to carry the sand into contact with the article, and without any contact between anything and the article, except the sand.

Such invention was not anticipated by a process in which sand or emery was rubbed against the surface of glass by the wires of a rotating wire brush; or by the use, on a locomotive engine, of a stream of sand, combined with a jet of steam, to drive cows from the track of a railroad.

(Before BLATCHFORD, J., Southern District of New York, February 17th, 1872.)

BLATCHFORD J. This is a motion for a provisional injunction, founded on letters patent granted to the plaintiff October 18th, 1870, for an "improvement in cutting and engraving stone, metal, glass, &c." The specification says: "My invention consists in cutting, boring, grinding, dressing, pulverizing, and engraving stone, metal, glass, wood, and other

hard or solid substances, by means of a stream of sand or grains of quartz, or of other suitable material, artificially driven as projectiles rapidly against them by any suitable method of propulsion. The means of propelling the sand which I prefer is by a rapid jet or current of steam, air, water, or other suitable gaseous or liquid medium; but any direct propelling force may be used, as, for example, the blows of the blades of a rapidly revolving fan, or the centrifugal force of a revolving drum or tube, or any other suitable machine. The greater the pressure of the jet, the higher will be the velocity imparted to the grains of sand, and the more rapid and powerful their cutting effect upon the solid substance. At a high velocity of impact, the grains of sand will cut or wear away substances much harder than themselves. Corundum can thus be cut with quartz sand, and quartz rock can be cut or worn away by small grains or shot of lead. I have sometimes used iron sand, composed of small globules of cast iron. By the term sand, in this specification, I mean small grains or particles of any hard substance, of any degree of fineness, of which common quartz sand is a type. The hardest steel, chilled cast iron, or other metal, can be cut or ground by a rapidly-projected stream of quartz sand. Articles of cast or wrought metal may have their surfaces thus smoothed and cleaned from slag, scale, or other incrustation. The surfaces of wrought stone in buildings or elsewhere can thus be cleaned and refreshed. By means of stencil plates, screens, or suitable covering substances, letters or designs can thus be cut or engraved upon hard substances. By varying the shape, number, and direction of the projected streams of sand, and by giving to them and to the articles treated suitable movements by means of lathes, planing, or drilling machines, or other known mechanical devices, cuts or holes may be made of any shape or size. When sand of a brittle nature, such as quartz or emery, is very rapidly projected against a hard material, the grains are broken by the shock into fine powder, and the process may thus be used as a method of pulverization. Where a jet of water under

heavy pressure is used, as in hydraulic mining, the addition of sand will cause it to cut away hard and close-grained substances, upon which the water alone would have little or no effect. Pebbles or stones of size and weight as great as can be rapidly projected by the jet of water used will have a battering, penetrating, and dislocating effect, which will assist the disintegrating and scouring action of the water. Heretofore, when sand has been used as a grinding or cutting material, it has been applied between solid substances, moved over each other under heavy pressure, so as to make a series of scratches, as in the ordinary cutting of stone and glass, or else in a solidified form, as in a grindstone or sandpaper, or sometimes in a semi-fluid state, as when a body is rubbed or moved in a mass of sand. The peculiar feature of my invention, which distinguishes it from other methods of cutting and grinding, is, that each grain of sand acts, by its own velocity and momentum, like a bullet or projectile, and pulverizes, cuts, or indents the object it strikes. From this peculiarity of action, it results, that some substances, which, though comparatively soft, are also tough, or malleable, or elastic, and not pulverizable by a blow, such as copper, lead, paper, wood, or caoutchouc, for example, are less rapidly cut and ground by the sand blast, particularly at moderate velocities, than some much harder substances which are brittle or pulverizable, such as stone, glass, or porcelain. Another peculiarity of the sand blast is, that the grinding or cutting action takes place upon irregular surfaces, cavities, corners, and recesses hardly accessible to ordinary methods. I believe that steam will generally be found the most convenient impelling jet, particularly for high velocities, but, in some localities, air or water may be cheaper." The specification then describes, with references to a drawing annexed, a method of carrying the invention into effect, for cutting stone by means of quartz sand projected by a jet of steam. It then proceeds: "For purposes where only a small quantity of material is to be cut or ground away from the surface of a hard substance, and where only a moderate velocity of the sand is required,

Tilghman v. Morse.

I have found the current of air produced by the ordinary rotary fan to be convenient. I have used this method for grinding or depolishing glass, china, or pottery, either on entire surfaces, or on surfaces partially covered and protected, so as to produce an engraving of letters, ornaments, or designs. In engraving designs, air is more convenient than steam as an impelling jet, in this respect, that the sand keeps dry and rebounds, leaving the pattern clear, while with steam the sand becomes damp, and is apt to adhere to and clog the fine lines and corners. The sand, being fed into the fan, is carried along, by the currents of air, in a tube or close trunk, and strikes upon the glass, which is held or moved opposite the mouth of the trunk, and cuts, grinds, or stars its surface. One arrangement, which I have found convenient for flat glass, is, to cause the air current from the fan to descend in a narrow vertical tube of a cross section about three feet long by one inch wide, into the top of which the sand is evenly introduced by numerous small pipes, at the rate of about twenty cubic inches per minute for each square inch of cross section. A travelling apron carries the sheets of glass gradually and regularly beneath the sand blast, at about one inch distance. The finer the sand used, and the less the pressure of the blast, the finer is the grain of the depolished surface. Also, the finer the sand used, the more weak and delicate may be the texture of the covering substance used to produce the design. Good results have been obtained with designs cut in a layer of wax, and with paper or lace pressed close to the glass, and using sand which passed through a sieve of fifty wires per inch, and an air blast of the pressure of about one inch of water. With sand reduced to very fine powder, and an air blast of a pressure of eight or ten inches of water, a very delicate depolishing of the surface of glass has been produced. Numerous processes are known and used in the arts for producing, painting, or transferring designs on surfaces. Any of these processes by which a design can be produced or transferred in a sufficiently tough and resistant medium, may be used to prepare a surface for

being engraved by the sand blast. Many natural objects, such as plants, leaves, insects, &c., which can be fastened flat upon a surface, have sufficient strength and resistance to a blast of fine sand to admit of their outline being thus engraved. Glass colored by a thin stratum of colored glass on one surface, may be ornamented by designs cut or ground through its colored stratum. Designs engraved by the sand blast to a sufficient depth, either in relief or intaglio, on a smooth surface, slate or glass, for example, can be reproduced by known processes of printing. When the sand blast, at moderate velocities, is directed upon a metallic surface, it removes but little of the metal, but the grains of sand make innumerable small indentations of the surface, and produce a frosted, dull mat or dead appearance. By using suitable stencil plates, or covering substances, designs or devices can thus be engraved on metallic surfaces. If desired, the sand may be propelled by a current of air produced by suction, or a partial vacuum made in any convenient manner, as by a fan or steam jet, or any other known machine; or the sand may be impelled by a mixed current of steam and air, produced by a steam jet in the ordinary manner. I have produced some cutting and grinding effects by sand impelled by the force of gravity. A stream of sand fed into the top of a high vertical tube, at first falls slowly, but, after the air in the tube is set in motion, the sand gradually falls more rapidly, and can finally acquire velocity sufficient to grind or depolish glass. I have described above several arrangements for projecting the same with the requisite velocity, but I do not mean to confine myself thereto. Any method or arrangement may be used by which sufficient velocity can be artificially given to the sand to enable it to cut or grind the object." The claims of the patent are seven in number. The first claim is the only one which it is proposed to consider in this case, and is as follows: "The cutting, boring, grinding, dressing, engraving, and pulverizing of stone, metal, glass, pottery, wood, and other hard or solid substances, by sand used as a projectile, when the requisite velocity has been artificially given to it by any suitable means."

Tilghman v. Morse.

The defendant is using, for ornamenting the surfaces of glass and metal, the process described in letters patent granted to him November 21st, 1871, for an "improvement in the ornamentation and dressing of the surfaces of glass and other substances." The specification of that patent states, that "the surfaces of the glass or other substances to be ornamented or dressed, which surfaces may be of plain, curved or other form, are subjected to the action of a falling or gravitating mass of corundum and emery, which compound constitutes the dressing material, substantially in the manner hereinafter described. The mechanism which I employ consists substantially of one or more hoppers or receptacles for receiving the dressing material, and one or more tubes connecting with the receptacles, for conveniently directing the said material, during its gravitation, upon the glass or other substance to be dressed." The specification then describes, with references to a drawing annexed, the machine to be used. A longitudinal box is divided, by means of partitions, into a series of hoppers, into each of which a mass of the dressing material is placed. Pendant from the centre of each of the hoppers is a small tube about eight feet in length, through which the dressing material descends by gravitation, until it is discharged through the lower end of the tube. The upper extremity of each tube is provided with a slide valve, by which the quantity of dressing material which falls through the tube may be regulated or wholly shut off. A shallow tray under each tube receives the dressing material as it is discharged. In each tray is a cushion on which the workman rests the glass plate or other substance to be dressed. The dressing material is a compound of corundum in powder and emery in powder. These substances, having been intimately mixed, are placed in the hoppers, the glass plates, or other substances, to be ornamented or dressed, are then held beneath the lower extremities of the tubes, and the slide valves are opened so as to allow the dressing material to descend by gravitation and fall upon the surface of the glass or other substance. The specification says: "The effect of this dressing material is to

cut the surface of the glass or other substance, giving it a grained appearance of beautiful hues, even texture, very ornamental and desirable. In order to produce designs of any desired pattern upon the glass or other substance, I place upon the surface thereof a pattern, cut out either in paper, cloth, textile material, metal, paper gelatine, parchment, rubber, gutta percha, or collodion film, or any other film or suitable substance having such a nature that it will throw off or resist the action of the dressing material, and, when the aforesaid patterns are applied to the glass or other substance, and subjected to the action of the dressing material in the manner described, the glass or substance will be dressed or cut only in the open parts or interstices of the pattern, while the parts of the glass or substance that are protected by the pattern will not be cut or acted upon by the dressing material, and thus some portions of the glass or substance will be cut or dressed, and the other portions left in their original condition, and the contrasts thus produced will form an ornamental configuration or dressing upon the surface of the glass or other substance. By continuing the action of the dressing material upon the surface of the glass or other substance for a sufficient length of time, in connection with patterns of suitable nature, as described, I form raised patterns having almost any desired degree of relief. In the same manner, I also produce intaglio patterns or depressions to almost any desired degree, in the surface of the glass or other substance. The dressing material, as fast as it is discharged from the hoppers, is to be replaced in them again, either by attendants or by suitable mechanism. * * * I am aware of the patent granted to B. C. Tilghman, October 18, 1870, for cutting or dressing with sand projected against the object which is to be dressed or ornamented, and desire to disclaim all that is therein shown and described." The specification states that Morse's invention consists in the machine and in the compound described in the specification and pointed out in the claims. The claims are to, first, one or more hoppers and tubes, combined, as described, with a suitable receptacle

Tilghman v. Morse.

thereunder for the article to be dressed or ornamented, as and for the purpose set forth ; and, second, a compound formed of coarse particles of corundum and emery intimately mixed and applied, as and for the purpose set forth.

There can be no doubt of the great merit and utility of the plaintiff's invention. It has been extensively applied to practical use. The defendant, in his patent, disclaims having been the inventor of any thing shown and described in the plaintiff's patent, and confines his claims to the mechanical arrangement of a hopper, a tube and a cushion in combination, and to the use of the mixed compound of corundum and emery.

It is set up, in defence, that it has, for many years, been customary to deaden or roughen parts of the surface of articles of smooth glass, by covering over certain portions with thin sheets of metal, or other material, cut out into such shapes as to form or leave patterns or designs, and then subjecting the exposed surface of the glass to the frictional action of some suitable material, produced by such material striking against the exposed portion of the glass. It is not alleged that, prior to the invention of the plaintiff, a simple stream of falling sand or granulated substance was used to wear away or roughen the exposed portions of glass, but it is alleged that it was always known that any solid or liquid material, falling continually on any surface, would wear away the latter, such as a water drip, or jets of falling water, perforating stone. There is nothing in all this that touches the plaintiff's invention. His invention consists in the discovery that a stream of sand, driven with sufficient velocity to cause the grains of sand, through their own velocity and momentum, to act as projectiles against the article to be cut or dressed, will do the work effectually, without any vehicle to carry the sand into contact with the article, and without any contact between anything and the article, except the sand.

This view disposes of the apparatus or process described in the provisional specification of John Robinson, in England, of December 13th, 1866, for "improvements in ornamenting

glass," so as to produce a bright pattern or design on a rough or dead ground on the surface of the glass, or a dead pattern or design on a bright ground, and thus ornament globes or glasses for lamps, and dishes, decanters, and articles of glass in general, and flat or curved sheets or plates of glass. Robinson says, that, in ornamenting the glass, he applies, and secures to the glass, plates of metal having the form of that portion of the design which it is intended shall be bright, and then subjects the surface of the glass "to the action of a rotating wire-brush fed with emery or sand and water, or other material capable of roughening or deadening the surface of the glass," and that the surface of the glass is thereby roughened or deadened, except at the parts protected by the metal plates, "the said parts being unoperated upon by the wire brush," and being left bright. He states, that if the protecting plates have a pattern cut out of them, a roughened or deadened ornament or pattern on a bright ground is produced. It is urged, that this process of Robinson produces an action and effect very similar to that produced by the defendant in the use of a concentrated stream of granulated material falling or poured upon the article to be operated upon, at about right angles to its surface, where there is a greater or less accumulation of the material all the time, and where, during the displacement of the particles, a continuous friction and rubbing on the surface being operated upon is kept up; that the action and effect so produced by the defendant are not similar to what occurs in projecting, at a high velocity, a very small stream of sand against a surface obliquely; and that the process of Robinson is not a grinding process, but is one in which, by the action of the wires of the brush, the exposed surfaces are deadened or roughened, just as they are deadened or roughened, and not ground away, in the defendant's process. Whether the process of Robinson was practically of any use is not shown, and is left to conjecture. But, even if useful, in its employment, the surface of the glass was subjected "to the action" of the wire brush, and the parts roughened or deadened were put in that condition by being

Tilghman v. Morse.

operated upon by the wire brush, as Robinson expressly states. It is true, that the brush was "fed with emery or sand and water." What part the emery or sand fulfilled is not stated—whether it, by means of the water, was held to the points of the wires in the brush, and was brought into contact with the surface of the glass, as such points revolved, or whether it formed a bed, kept fed, on the surface of the glass, such surface being maintained as horizontally as possible, and the particles of emery or sand were rubbed by the revolving points of the wire brush against the glass. Robinson states that the emery or sand is capable of roughening or deadening the surface of the glass. But his process, so far as it can be understood, is to rub the emery or sand against the surface of the glass, by means of the rotating wire brush. There is no suggestion that the work is done by using the grains of emery or sand as projectiles, through the velocity and momentum imparted to them. If the rotation of the wire brush would make projectiles of the grains of emery or sand, by a velocity of rotation sufficient to overcome their adhesion, through the water, to the wires of the brush, it would be a pure matter of accident whether those projectiles would strike the glass. It seems probable that the sand and water were fed to the surface of the glass, and that the wire brush was used to scratch the grains of sand against the glass. The description is very vague. Whatever the process was, it would suggest to no one the plaintiff's invention, or the process used by the defendant.

Grave reference is made, on the question of novelty, to patents granted for projecting a stream of sand combined with a jet of steam, from a locomotive engine, for the purpose of driving cows from the track of a railroad, and the learned expert who makes an affidavit on the subject says, with great truth, that the only difference between such use, in combination, of a jet of steam and a stream of sand, and the use by the plaintiff of the combination of a jet of steam with a stream of sand, is, that, in the former case, the sand, after having had velocity imparted to it, came in contact with cows, while,

Tilghman v. Morse.

in the latter case, it comes in contact with glass, stone, &c. This is the only difference, but in this difference lies the distinction between the two. No one, from observing the temporary operation of the process on the animal, would infer that he could, by the same means, produce the results which the plaintiff describes. Nor is there any resemblance in kind between those results and the result produced on the animal.

It is urged that the plaintiff, in his first claim, claims the cutting, &c., of stone, &c., by sand used as a projectile, only when the requisite velocity is "artificially" given to the sand; that this confines him to a mode of propelling the sand such as he describes, or equivalent means; that, notwithstanding what is said in the specification about "the force of gravity," the first claim does not allude to or cover the natural velocity acquired by the falling of a body; that such claim covers only velocity artificially given; that, in the defendant's process, the requisite velocity is not artificially given to the sand; and that, therefore, the defendant does not infringe the first claim of the plaintiff's patent. The plaintiff, in his specification, not only states that he has produced some cutting and grinding effects by sand impelled by the force of gravity, and that a stream of sand fed into the top of a high vertical tube at first falls slowly, but, after the air in the tube is set in motion, the sand gradually falls more rapidly, and can finally acquire velocity sufficient to grind or depolish glass, but he speaks of causing an air current, created by a fan, to descend in a vertical tube into the top of which sand is fed, against flat glass held about one inch below the bottom of the tube. The process used by the defendant is fully described in the plaintiff's specification. The word "artificially," in the first claim of the plaintiff's patent, and throughout the specification, covers the falling of sand through a vertical tube high enough to enable the sand to acquire sufficient velocity to do its work. The work is done because the sand falls through a tube. It would not be done if the sand fell unconfined and unguided by a tube, not only because the tube concentrates the sand and makes a stream of it, which can be directed

effectively against a given space on an object, but because, as the plaintiff's specification states, the falling of the sand in the tube, which is at first slow, sets the air in the tube in motion, and then the sand gradually falls more rapidly until it finally acquires sufficient velocity to do the work. There is thus produced an artificial current of air. The air would have no current, if not set in motion by the falling of the sand through the high vertical tube. This current of air gives an artificial velocity to the falling sand, greater than the natural velocity which, as a falling body, it would have outside of the tube. Such artificial velocity grows to be the requisite velocity. The requisite velocity is thus artificially given to the sand. The artifice is the confinement of the falling sand in a high vertical tube, into the top of which it is fed, with free access of air to the tube.

The first claim of the plaintiff's patent is for a process or art, and is valid. It is infringed by the defendant. There is no doubt as to the novelty and utility of such process. The fact that the plaintiff has extensively applied it to practical use, and has been, and but for the infringement committed by the defendant would still be, in the undisturbed possession, use and enjoyment of the exclusive privileges secured by the patent, and in receipt of the profits of the same, as averred in the bill, is not contradicted. An injunction must, therefore issue, as prayed for.

George Harding, for the plaintiff.

Charles B. Stoughton, for the defendant.

The United States v. The Steamship Missouri.

THE UNITED STATES

vs.

THE STEAMSHIP MISSOURI.

Under § 8 of the Act of July 18th, 1866, (14 *U. S. Stat. at Large*, 180,) which declares that a vessel shall be holden for the payment of the penalty imposed upon her master by § 24 of the Act of March 2d, 1799, (1 *Id.*, 646,) where goods are brought into the United States by her, which are not included or described in the manifest of her cargo, the vessel may be proceeded against *in rem*, in the Admiralty, to enforce such lien against her.

The manifest of the cargo of such vessel, filed in the custom-house, is competent evidence on the question as to whether such goods were entered on the manifest of her cargo.

It is not necessary to the liability of the master to such penalty, that it should appear he had knowledge that the goods were on board of the vessel.

If the absence of such knowledge is to be of avail, it must be proved as a defence.

(Before WOODRUFF, J., Eastern District of New York, February 23d, 1872.)

WOODRUFF, J. There is, I think, some doubt, whether the Act of July 18th, 1866, § 8, (14 *U. S. Stat. at Large*, 180,) which declares, that the vessel shall be holden for the payment of the penalty imposed upon the master, (where goods are imported or brought into the United States, which shall not be included or described in the manifest of the cargo,) by the Act of March 2d, 1799, § 24, (1 *U. S. Stat. at Large*, 646,) authorizes a proceeding in Admiralty for the enforcement of the lien thereby declared. Its language is, that "such vessel * * * may be seized and proceeded against summarily, by libel, to recover such penalty, in any District Court of the United States having jurisdiction of the offence." The use of the term "libel," in the Act, is not claimed to be conclusive. Indeed, the proceeding in this case is, in very form of words, an information, which is apt to indicate

The United States v. The Steamship Missouri.

a proceeding to enforce a forfeiture based upon a seizure under the revenue laws of the United States; and, in these proceedings, it is styled, a "libel of information." It is plausibly argued, that the Act which gives the United States the right to hold the vessel for the payment of the penalty imposed on the master, contemplates a seizure in the first instance and a libel founded thereon; that such a proceeding is a proceeding at law, in which the owners are entitled to a trial by jury; that the very basis of the proceeding is, that the master has incurred a penalty; that, for the recovery of such a penalty, an action at law, to be tried by a jury, would be necessary; that the proceeding can only be conducted in the District Court having jurisdiction of the "offence"; that the master could only be pursued at law for the penalty of the offence; and that it ought not to be deemed the intention of the legislature to authorize a proceeding against the vessel in a form which deprives the owners of that mode of trial. To hold, therefore, that, under the Act, a seizure was necessary in the first instance, and that the Act contemplated a libel of the vessel so seized, and an intervention and issue thereupon at law, to be tried by a jury, as in ordinary seizures under the revenue laws, would do no violence to the statute. But, upon reflection, my conclusion is in accordance with the opinion of the District Judge upon this point, (3 *Benedict*, 508,) and with that of Judge Blatchford in the case of *The Queen*, (4 *Benedict*, 237.)

The facts seem to me established in conformity with the claim of the libellants. More than 200 boxes of cigars were brought into the United States, on board of the steamship Missouri, which were not entered on the manifest of the cargo, but were found secreted on board. The intent to introduce them clandestinely, without the payment of duties, was plainly indicated by the circumstances.

The objections to the evidence by which the facts are established are untenable. The manifest, and only manifest, of the cargo filed in the custom house, is either proof that these goods were not on the manifest of the cargo, or that no

The United States v. The Steamship Missouri.

part of the cargo was entered upon any manifest; for, the proof is, that no other manifest was filed.

The officers who found the cigars testify to the fact, and they identify and prove the original entry of such finding, and the seizure of the cigars thereupon; whether as official documents, or contemporaneous memoranda made by the witnesses, which they verify, is immaterial. It is enough that they are entries subscribed by them, in the discharge of their official duty, to the truth of which they now testify. All certificates of seizure not established by express proof, the District Court rejected, and, in consequence, a large quantity of cigars mentioned in the libel were not included in the estimate of value awarded in this case.

A decision of the Circuit Court in the third Circuit, (*United States v. The Stadacona*, 14 *Int. Rev. Record*, 147,) is cited to me, which seems to proceed upon this construction of the statutes—that, in order to charge the master of the ship with the penalty imposed by the Act of 1799, it must appear that he had knowledge that the goods were on board of the ship. It would, of course, follow, that, if the master is not liable to the penalty, the vessel cannot be charged, under the Act of 1866. In the opinion, it is, nevertheless, declared, that the goods were properly condemned and forfeited. It would be preferable to suggest, that the precise circumstances mentioned in the Act of 1799, which create the forfeiture of the goods, are accompanied by the declaration, that the master shall forfeit and pay a sum equal to the value, and it is not entirely obvious that one of these forfeitures is incurred if the other is not also. But, if the decision of the Circuit Court was correct in that case, it will not avail the claimants in this. There, it was proved, that the steward of the vessel had, without the knowledge of the master, secreted on board certain pieces of silk, in a place which was boarded up and covered with tin. The space thus inclosed was apparently wholly inaccessible, and the master was not aware that it had ever been opened. It was, therefore, deemed by the Court impossible for the master to enter the goods upon the mani-

fest, when he had no knowledge that they were on board, and could not, by the exercise of any ordinary diligence, have obtained such knowledge; and the Court, not without much reason, founded in a sense of justice to the master, deemed, upon a construction of the whole Act, that goods so secreted were not a part of the cargo, in such a sense that the master was punishable if he did not enter them on the manifest. I greatly doubt that the Court intended to adopt the broad proposition, that a master could, in all cases, protect himself from the penalty, and save the vessel from liability, by proof that he had not actual knowledge that the goods were on board. Such a construction of the Act would go far to destroy its efficiency for any purpose. But, even such a construction would not avail in this case. It would be necessary to hold, not only that want of knowledge by the master would save him and the vessel from the forfeiture imposed by the Act, but to hold, also, that the libellants must affirmatively prove such knowledge. This, it is certain, I think, cannot be required. If want of knowledge will avail, it must, under these statutes, although a negative, be proved as a defence. The statute makes no qualification. It declares, that, if the goods are imported or brought in, and do not appear in the manifest, the forfeiture is incurred. It is a presumption, upon which the statute manifestly proceeds, that the master has entire control of the vessel and its lading; that he has power to exclude all goods which are not properly brought and subjected to entry on the ship's papers; and that he is to be presumed to know what goods are on board his ship; and, if we admit that he may, in a case such as that referred to, show that his apparent power was evaded and his presumptive knowledge avoided, and that the goods were secretly gotten on board and brought, by a fraud or deception practised on himself, which no ordinary vigilance would prevent, the Government may, nevertheless, proceed, in the first instance, upon the fact, that the goods were brought, and put him, or the owners of the vessel, to an explanation. In the present case, the goods were of very considerable bulk; they

The United States v. The Steamship Missouri.

were deposited in not less than five or six different places on board; they could, apparently, have been discovered by very little diligence in examining the ship; and they were very readily found by the officers of the revenue. Surely, this was sufficient to put the owners of the vessel to some explanation; and they might have examined the master himself, if he could testify to any want of knowledge that the goods were on board. As the case stands, the proof is, that the goods were imported without entry on the manifest, and the inference is warranted that the master knew it.

But, the provisions of the Act of 1799 itself seem to me to reach this precise question. The proviso to the imposition of the forfeiture, (§ 24,) permits the master to show that the omission to enter the goods in the manifest is by mistake—that is, that the “manifest is incorrect by mistake.” If, then, on arrival, goods are discovered which have been brought by seamen or others without his knowledge, so that his manifest was made in good faith, in the belief that it contained all dutiable goods, and his mistake therein is shown to be caused by a deceit and fraud practiced on himself, he is to make that fact appear to the collector, naval officer and surveyor, or a major part of them, and, in such case, the forfeiture is not incurred.

I do not think it necessary to pursue the discussion into the other details of the argument in behalf of the claimants. In respect to those, so far as is material to the conclusion, I concur in the decision made in the District Court. (4 *Benedict*, 410.)

The libellants must, therefore, have a decree for the amount awarded below, with costs.

John J. Allen, (Assistant District Attorney,) for the United States.

Goodrich & Wheeler, for the claimants.

The Elwine Kreplin.

THE ELWINE KREPLIN.

Article 10 of the treaty between the United States and the King of Prussia, of May 1st, 1828, (8 *U. S. Stat. at Large*, 378, 382,) provides, that the consuls, vice-consuls and commercial agents of each party "shall have the right, as such, to sit as judges and arbitrators, in such differences as may arise between the captains and crews of the vessels belonging to the nation whose interests are committed to their charge, without the interference of the local authorities," subject to the right of the contending parties "to resort, on their return, to the judicial authority of their country," and to the right of the consuls, vice-consuls or commercial agents to require the assistance of the local authorities, "to cause their decisions to be carried into effect or supported." The crew of a Prussian vessel sued her *in rem*, in Admiralty, in the District Court, to recover wages alleged to be due to them. The master of the vessel answered, denying the debt, invoking the protection of said treaty, denying the jurisdiction of the Court, and averring that the claim for wages had already been adjudicated by the Prussian consul at New York. The consul also protested formally to the Court against the exercise of its jurisdiction. The case was tried in the District Court, and it appeared that the consul had adjudicated on the claim for wages. *The District Court decreed in favor of the libellants: *Held*, That the District Court had no jurisdiction of the case.

(Before WOODRUFF, J., Eastern District of New York, February 23d, 1872.)

WOODRUFF, J. By the tenth article of the Treaty made by the United States with the King of Prussia, on the 1st of May, 1828, (8 *U. S. Stat. at Large*, 378, 382,) it is provided, that "the consuls, vice-consuls, and commercial agents,"—which each of the parties to the treaty is declared entitled to have in the ports of the other—"shall have the right, as such, to sit as judges and arbitrators, in such differences as may arise between the captains and crews of the vessels belonging to the nation whose interests are committed to their charge, without the interference of the local authorities. * * * It is, however, understood, that this species of judgment or arbitration shall not deprive the contending parties of the right they have to resort, on their return, to the judicial

The Elwine Kreplin.

authority of their country." To this general rule there is a qualification: "unless the conduct of the crews, or of the captain, should disturb the order or tranquility of the country, or the said consuls, vice-consuls, or commercial agents should require their assistance" (the assistance of the local authorities,) "to cause their decisions to be carried into effect or supported." This treaty is, by the Constitution of the United States, the law of the land, and the Courts of justice are bound to observe it. When a case arises which is within this provision of the treaty, jurisdiction thereof belongs to the consul, vice-consul, or commercial agent of the nation whose interests are committed to his charge, and with the exercise of that jurisdiction the local tribunals are not at liberty to interfere, unless such consul, vice-consul, or commercial agent requires their assistance, to cause their decision to be carried into effect or supported.

In the present case, the mate and several of the crew of the barque Elwine Kreplin prosecuted their libels against the vessel, in the District Court, for the recovery of wages alleged to be due to them, which the master of the vessel denied to be due, upon various grounds; and the vessel was attached to answer. The master of the barque, intervening for the interest of the owner, sets up, in his answer, various grounds of defence to the claim, some of which arise under the laws of Prussia; and, especially, he invokes the protection of the treaty above mentioned, and denies the jurisdiction of the District Court, alleging, moreover, that the matter in difference—the claim of the libellants for wages—has already, in fact, been adjudicated by the Prussian consul at the port of New York. Before the cause was tried in the District Court, the consul-general of the North German Union presented to the District Court his formal protest against the exercise of jurisdiction by that Court in the matter in difference. He invoked therein the treaty above referred to, and claimed exclusive jurisdiction of such matter in difference; and he also declared, that, before the filing of the libel, the said matter had been adjudicated by him, and insisted that his adjudica-

The Elwine Kreplin.

tion was binding between the parties, and could only be reviewed by the judicial tribunals of Prussia.

The barque is a Prussian vessel, the mate and crew are Prussian seamen, who shipped in Prussia, under and with express reference to the laws of Prussia, referred to in the shipping articles, and it should be assumed, that the treaty which binds this nation and its citizens and seamen, binds also Prussia and her subjects and seamen. The consul-general of the North German Union is commissioned by the King of Prussia, and, by certificate of the Secretary of State of the United States, under the seal of that Department, it appears, that the Executive Department of the United States recognizes the consuls of the North German Union as consuls of each one of the sovereign states composing that Union, "the same as if they had been commissioned by each one of such states." The kingdom of Prussia is one of the states composing the North German Union. The treaty does not require that the consuls, vice-consuls, &c., should bear any specific name. It is sufficient, that the "interests" of Prussia "are committed to their charge," and quite sufficient, that the Government of the United States, by its Executive, recognizes the consul as consul of the kingdom of Prussia.

The discussion of the case at the hearing on the appeal, was, on the part of the libellants, very largely devoted to the merits of the claim for wages, upon principles applicable, it may be, to the subject, if no such treaty was in force, and under decisions of our Courts in reference to the rights and duties of seaman and master, the effect of the misconduct of either upon the obligation of the other, for the purpose of showing that the treatment of the libellants by the master exonerated them from their duty to serve according to the terms of the shipping articles, and also from all others of its stipulations, even from such as arise from the laws of Prussia forming a part of the terms, stipulations, and conditions which enter into the relation of the crew to the master and owners, and to the vessel. That discussion was very full, and

was presented, in argument, with great ability, by the counsel for the libellants. With most of the rules of law invoked by the counsel, when considered apart from and independent of any treaty stipulation, the claimants have no contest; and they are, no doubt, settled, by the cases cited. But the prior question of jurisdiction must be determined, before it is competent even to enquire into the merits of the libellants' claim to recover their wages.

In the first instance, it would seem clear, that a claim of the crew of a Prussian vessel to recover wages which the master of the vessel either denied to be due, or refused to pay, was, *par eminence*, a matter in difference between the captain and crew, which, by the very terms of the treaty, the Prussian consul or vice-consul had jurisdiction, as judge or arbitrator, to determine, "without the interference" of the Courts of this country; and such jurisdiction, when it exists, is, by such terms as these, exclusive. It is, however, claimed, that the present cause is not at all embraced within the treaty, for the reason, that it is a proceeding *in rem*, to enforce a maritime lien upon the vessel itself, and not a difference between the captain and crew; and, also, because the Prussian consul has no power to conduct and carry into effect a proceeding *in rem* for the enforcement of such a lien.

The treaty can receive no such narrow and technical construction. The master is the representative, in this port, of the vessel, and of all the interests concerned therein. He is plainly so regarded in the treaty. The matter in difference in this cause is the claim for wages. That arises between the crew and the master, either as master, or as the representative here of vessel and owners. It is precisely that which is in litigation in this case. The lien, and the proceeding *in rem* against the vessel, appertain to the remedy, and only to the remedy. The very first step in this cause is to settle the matter in dispute. If the claim be established, then; as incident to the right to the wages, the lien and its enforcement against the vessel follow. The District Court can have no jurisdiction of the lien, nor jurisdiction to enforce it, if it has

The Elwine Kreplin.

no jurisdiction of the difference or dispute touching the claim for wages. To hold that the jurisdiction of the consul is confined to cases in which there is no maritime lien, and in which no libel of the vessel could, apart from the treaty, be maintained, is to take from the treaty very much of its substance. The existence of any lien, and of any right to charge the vessel, is in difference here. To say, that the treaty gives the consul jurisdiction of claims against the master *in personam*, and does not include a claim to remove the vessel itself from his custody, as the owner *pro hac vice*, or as the representative of all the interests therein, that the voyage may be broken up, and the vessel sold for the wages of the crew, and that an effort, by judicial proceeding, to do this, is not included in the terms, a difference arising between captain and crew, seems to me to destroy the very substance of the stipulation, and defeat its obvious purpose, to confine both masters and crews of Prussia to the rights and obligations of the Prussian laws, and compel obedience to its mandates. And, be it observed, the treaty gives the same protection to, and requires the like obedience by, the masters and crews of vessels of the United States. It does not add to the legal reasons for this view, but, if a vessel of the United States were sold in a port in Prussia, to pay the wages of its crew, alleged by the master not to be payable, and in repudiation of any right of the United States consul at that port to act as judge or arbitrator upon that claim, it would, at least, stimulate our quickness of apprehension to discover, and would incline us to insist, that the treaty intended to protect our shipowners against the application of foreign laws, and the decisions of foreign Courts, to our vessels and the relations of the master and crews thereof.

To the suggestion, that the consul has no power to enforce the maritime lien, and cause the vessel to be sold, to satisfy the wages, if he should find that wages are due and payable, it is sufficient to say, that the treaty has been deliberately entered into, and has become the law for both nations. Each preferred to employ its own officers. The power given to

The Elwine Kreplin.

consuls to act as judge or arbitrator is not made final. The parties have the right of resort to the tribunals of their own country, without being concluded by the decisions of the consul. This was deemed a sufficient protection, and to afford, for the time being, a sufficient remedy to both master and crew; and it is not for this Court to say, that the remedy here, by attachment of the vessel, will be more efficient and useful, and, on that ground, to apply it. Besides, this Court cannot know that the remedy by resort to the vessel is not, if it exists, so regulated in Prussia, that it was intended that her seamen should not invoke against the vessel the remedies permitted by our laws, under the mode of administration and rules of decision by which our Courts are governed. And, further, under the expressed exception, which permits resort to local tribunals by consuls, &c., who may require their assistance to cause their decisions to be carried into effect or supported, it is plausible, at least, to say, that, if the consul decide, on a difference between captain and crew, that wages are payable, the power of the Court to attach and condemn the vessel for their payment may be invoked to support and give effect to such decision.

Again, it is said, that, in this case, the captain and crew were not confronted before the consul, witnesses were not examined, no adjudication in writing was made, but the consul only orally declared his judgment of the matter in difference, after hearing the statement of the master and the statement of the libellants, and then declared that he had nothing further to do therein. The proceeding does not, it is true, conform to our ideas of the requisites of a judicial proceedings; but, are the Courts of this country to prescribe to the Prussian consul the forms and modes of proceeding which he must adopt when he acts as a judge or arbitrator between master and crew under this treaty? Must he follow the practice, and be governed by the rules, governing trials and arbitrations under our laws? Must our consuls in Prussia follow the rules and practice of the Courts of that kingdom? If so, then the District Court here was sitting as a Court of

The Elwine Kreplin.

error, to review the judgment or award of the Prussian consul. What can this Court say are the formal requisites of a Prussian arbitration? It is manifest, by the reservation of the right to resort to the judicial tribunals of the home country, without being concluded by the decision of the consul, that the proceeding before him as an arbitrator or judge was intended to be summary, and its conduct left very much in his discretion; and, especially, it is manifest, that the nations respectively intended to confide in their consul, and temporarily entrust to him the adjustment of differences between officer and crew of their vessel in the port of the other, and it was not intended that the Courts of such other nation should sit in judgment upon the form or regularity, or the justice, of the acts of the consul, or interfere therewith in any manner. It was deemed safe and proper to leave to such consuls this temporary administration of the interests of their seamen abroad, assured that they would act with fairness and integrity therein, but yet giving the right of full and final investigation and adjudication at home, where home laws, home remedies, and home modes of investigation could be resorted to. The District Court here not only passed upon the requisites of the proceeding as judicial, or as an arbitrament, but assumed to inquire into the details of the evidence, and the truth of the declared grounds upon which the vice-consul testified that he acted, and which he says were before him in the admissions of the crew—thus, in effect, reviewing the law and the facts which the consul made the basis of his decision.

It is claimed, that the consul did not act as judge or arbitrator to determine this case, and that, he not having taken jurisdiction, a proceeding in our Courts is no interference in disregard of the treaty. It is by no means clear, that the attachment of the vessel, on the libel of the crew, is not, in itself, such an interference as precludes the action of the consul. But in this case, the argument disregards the clearly established fact, that the consul or his vice consul, (who is, in terms, included in the treaty, and whose acts in the matter the consul recognizes,) did hear the parties respectively. On

The Elwine Kreplin.

the statement of the case by the crew (who, whichever of them was the first speaker, had the opportunity to tell their story,) he pronounced against them. On their own story, he decided that they had forfeited their wages, by the Prussian law, applied to their contract of shipment; and, afterwards, when this suit was commenced, he formally represents to the Court, that he had already adjudicated the matter in difference, and claimed that his jurisdiction for that purpose is exclusive of the Courts of this country. It was after such declaration of his decision to the crew, that he, knowing that the vessel was laid up, advised them to see the captain, and, by civil and conciliatory deportment, induce him to waive the forfeiture and pay the wages which had accrued. In the situation in which the vessel and her master then were, it is obvious, that, if the men had forfeited their wages, (of which I here express no opinion,) their acts had wrought no great harm, the captain had no present need of the services of so many, and many considerations might properly have moved him to pay their wages and let them go. The advice of the consul indicated that he thought the loss of their service was no inconvenience to the captain and, even if wrong theretofore, they had claims to his consideration, while destitute and in a foreign country, which might and, perhaps, ought to induce him to pay their wages. This is all there is of the argument, that the consul himself regarded the crew as practically discharged.

I do not propose to examine the merits of the libellants' claim for wages. That they were, on the requisition of the consul, and without sufficient grounds therefor, held in prison as deserters, is most probable. That their departure from the vessel, and going ashore without leave, and against the will of the master, (save as to one, who had his consent,) is not desertion by our law, unless it was done without the intention to return, is, no doubt, true. That the master did not, in fact, consent to the discharge of any of them, is, I think, clear, while I think it in the highest degree probable, that, if this difficulty had not arisen, he would, in view of the laying up of the vessel, have consented to part with most of them.

The Elwine Kreplin.

I do not think it certain, that an imprisonment, on the requisition of the consul, though induced by a statement of the facts by the captain, operated to discharge the seamen from their articles, even though the imprisonment was not warranted by the facts. (*Jordan v. Williams*, 1 *Curtis' C. C. R.*, 69, 83.) Nor is it certain that, under this treaty, and the Act of March 2d, 1829, (4 *U. S. Stat. at Large*, 359,) a State magistrate can have no jurisdiction to arrest and detain a seaman charged as a deserter. True, the laws of the United States may not make it the duty of a State Judge to act; but it does not follow, that, if he is included in the law, his acts will be without authority. There are many powers conferred upon State magistrates by the laws of the United States, which, if executed, are valid. Whether such magistrate is bound to accept the authority and act upon it, is another question. The Act of 1829, in determining the duty, confers the power on "any Court, judge, justice, or other magistrate having competent power, to issue warrants" to arrest, &c. (See *Parsons on Shipping*, p. 102; *Kentucky v. Dennison*, 24 *How.*, 66, 107, 108.) It is apparent, that the requisition was given to the master to be delivered to the justice at Staten Island, who, as the captain informed the consul, then detained the seamen; and if, as stated by counsel, (though it does not appear as printed in the copy proofs handed to me,) it was addressed to "any magistrate," &c., the power of the magistrate is not clearly wanting.

But all these and other questions go to the merits. They bear on the broad question, whether, under the terms of the shipping articles, and the Prussian rules contained in the navigation book, &c., the seamen had a right to their wages. The effect of the stipulation not to sue in a foreign country, which appears to be one of those rules, also, and what amounts to a discharge from the contract, actual or constructive, are questions on the merits; and the sympathy, which the condition of these men, penniless in a foreign land, whether with or without fault on their part, must awaken in every mind susceptible of human emotion, strongly inclines

Petty v. Merrill.

to a condemnation of the conduct of the master in this matter.

But I am constrained to the conclusion, that the treaty required that this matter in difference should have been left where, I think, the treaty with Prussia leaves it—in the hands, and subject to the determination, of their own public officer.

The necessary result is the dismissal of the libels. (4 *Benedict*, 413.)

Dennis McMahon, for the libellants.

Edward Salomon, for the claimants.

JOHN W. PETTY AND OTHERS

vs.

HENRY B. MERRILL AND OTHERS.

In a case of collision, the District Court allowed, as an item of damage, \$500, for depreciation in the value of the libellant's vessel, besides allowing \$600 for future repairs. It appeared that the \$600 would put the vessel in a seaworthy condition, and in as good and serviceable a condition as she was in before the collision; but the ship-builder testified, that, with such repairs, the vessel would not be as valuable, by \$500, as before the collision, and that, there is a general damage, which vessels sustain when they come together, that they show when they grow old: *Held*, that the allowance of the \$500 was improper.

When a vessel is made as serviceable as she was before, any conjecture that she is not as valuable, or that, when she is old, some damage will appear, as the result of the collision, not now discoverable, is too vague and uncertain to warrant the finding of the conjectural amount of damage.

(Before Woodruff, J., Eastern District of New York, February 23d, 1872.)

Petty v. Merrill.

THIS was an appeal by the respondents from a decree of the District Court, in a case of collision, in which the libellants' vessel, the schooner *Mary Eveline*, was damaged.

Franklin A. Wilcox, for the libellants.

Richard H. Huntley, for the respondents.

WOODRUFF, J. The allowance of five hundred dollars for depreciation in the value of the libellants' vessel, does not seem to me well sustained. The witness upon whose estimate it was allowed is the ship-builder who estimates the future repairs required at six hundred dollars; and the six hundred dollars are allowed. He testifies to having the vessel on his ways before the collision, that he examined her all over, and that her condition was good. Again, he testifies that he had her on his ways just after the collision, and again examined her; and he specifies the particular injury she received. Being asked, on behalf of the libellants: "In your opinion, what repairs are still necessary to place the *Mary Eveline* in a seaworthy condition?" He says: "Six hundred dollars." Again: "In your opinion, what repairs are still necessary to place the *Eveline* in as good condition as she was before the collision?" He says: "Six hundred dollars." He enumerates the particulars of the injury, and, being asked: "What would it cost to repair the damages you have mentioned?" He again says: "Six hundred dollars." On cross-examination: "Do you mean to be understood that six hundred dollars will repair all the damages you saw when you examined the vessel, after the collision?" He answers: "It would." On re-direct: "As I understand, from your testimony, there are certain repairs yet to be done to the *Mary Eveline*, to place her in as serviceable a condition as she was before the collision; please state what it will cost?" Again, for the fifth time, he answers: "Six hundred dollars." This is very distinct evidence, by the libellants' own witness, that the expenditure of six hundred dollars will repair all the

Petty v. Merrill

damages, will place the vessel in as good a condition as she was before the accident, and will place her in as serviceable a condition as she was before the collision. Nevertheless, in answer to a species of cross-examination by the libellants' counsel, on inquiry: "Would six hundred dollars place the schooner in as good a condition as she was previous to the collision?" He replies: "It would not." "With the repairs which you have mentioned, would the vessel be as valuable as she was previous to receiving the injury sustained by the collision?" "The vessel would not be worth as much, by five hundred dollars, after these repairs, as before the collision." It is after this testimony, that he testifies, in answer to the libellants, that six hundred dollars would place her in as serviceable a condition as she was before the collision; and, by way of further explanation, on cross-examination, he says: "There is a general damage, that vessels sustain when they come together, that they show when they grow old."

I am not satisfied, that, upon such testimony, five hundred dollars should be allowed, in addition to the cost of the repairs. It rests upon no certain or definite grounds, for an estimate. The witness had stated all the cost of making the vessel as good as she was before; and then, having stated that she would, nevertheless, not be so valuable, he states that she would be as serviceable; and, finally, the cross-examination shows that his estimate of five hundred dollars less in value rests upon a conjecture, based upon what he states as a general result of all collisions—that the vessels sustain a damage that "will show when they grow old." This is altogether too vague, uncertain and unreliable, to warrant the inference, as a fact, in this particular case, that, beyond any injury which the witness could detect, by his careful examination as an expert in building and repairing vessels, she had, also, received some undiscovered and undiscoverable damage, which, although it did not render her less serviceable, yet detracted five hundred dollars from her value, because it would show when she was old. The elements of calculation, or of estimate

of amount, are wanting. Palpably, the assumed fact of such hidden injury, and its extent and character, are conjectural, and the amount of money required as an indemnity is even more so. It may be conceded, that the shock of a violent collision will be felt throughout the vessel; but the injury from that cause, if any, is not to be estimated, and cannot be determined, as a fact, in a Court of justice, by reasoning upon any general rule, such as appears to have guided the witness, if, indeed, his estimate was anything more than a rough guess, without any specific facts to support it. No two collisions are alike in any of their circumstances or results. The injury in any given case must be quite peculiar, if the skill of the shipbuilder, at liberty to employ all the expense requisite, is incapable of repairing it; and, when a vessel is made as serviceable as she was before, any conjecture that she is not as valuable, or that, when she is old, some damage will appear, as the result of the collision, not now discoverable, is too vague and uncertain to warrant a finding of the conjectural amount of damage. There may be proof of injury, which, though known, cannot be repaired without unreasonable cost, where the party in fault will be benefitted by an allowance for actual depreciation, because an attempt to make complete repairs would involve an expense greatly disproportionate to the amount of such depreciation. But, in general, estimates of depreciation, founded in speculative opinions of the probable effect of a collision, where no such effect is known or discernible, and estimates of diminished value, founded, as they sometimes are, upon the idea, that, although the vessel is as serviceable as she was before, yet she will not sell for so much as she would before, are not of sufficient reliability to warrant the taking of the money of one party and awarding it to another. See, on this subject, *The Isaac Newton*, (4 Blatchf. C. C. R., 21;) *The St. John*, (7 Id., 220, 226;) *The Favorita*, (8 Id., 539.)

The sum of five hundred dollars allowed to the libellants, for supposed depreciation in the value of their vessel, must be disallowed.

The Pennsylvania.

THE PENNSYLVANIA.

A steamship and a barque collided, in the Atlantic Ocean, within a day's sail of New York, in the track of her inward and outward commerce, where the presence of other vessels was to be expected, in a fog so dense that a vessel could not be seen at a distance greater than the length of the barque. The steamer was going, at the time, at a speed of not less than seven miles an hour: *Held*, that the steamer was in fault in going at such a rate of speed, and that such fault was a cause of the collision.

Held, also, that her navigators were in fault, in giving conflicting and vacillating orders, after discovering the barque.

The barque, although under way, was ringing a bell, and was not blowing a fog-horn. That was a fault on her part, but, on the evidence, it was not a fault which contributed to the collision.

The jurisdiction of the District Court for the Eastern District of New York, in this case, sustained, although the vessel proceeded against was found and attached in the waters of the county of New York.

The report of the Commissioner as to the value of the libellant's vessel, founded on conflicting or varying estimates, sustained.

(Before WOODRUFF, J., Eastern District of New York, February 23d, 1872.)

WOODRUFF, J. The proofs in this cause fully establish fault in the management of the steamship, both in respect to the speed at which she was running, in a fog so dense that a vessel could not be seen at a distance greater than the length of the barque; and, I think, also, there was fault in the confused and conflicting or vacillating orders given after the barque was discovered. I greatly doubt whether any change in her course, after the barque was seen, would have been completely effectual to prevent a collision; but, had she done her utmost, in an endeavor to turn in a single direction, accompanying that effort by a reversal of her engine, the injury by the collision might have been greatly mitigated. To this is to be added the fact, fairly inferrible from the testimony of the claimants' own witnesses, that the first report of the lookout, announcing a bell on the starboard bow, was not heard by the officer to whom it was addressed; and the suggestion becomes more significant, that if, at that moment, a consistent effort had been made, the collision might not have happened, or its

The Pennsylvania.

injurious consequences would have been greatly lessened. The second officer, who was on the bridge, states, that the first report he heard was, "Ship ahead, a little on the star-board bow;" and no other officer testifies to hearing any earlier report. He testifies, also, that the barque was then "barely her own length off." It is perfectly shown, by the two men on the lookout, that the bell on the barque was heard before she could be seen. It follows, that the bell was not properly reported, or the officer was inattentive. The first thing heard by the officer at the bow, was the bell itself, and he saw the barque at the same time, then barely a ship's length distant. So, also, the master heard nothing until he heard the bell and saw the barque. The man at the wheel testifies explicitly to the conflicting or vacillating orders, and there is no explicit denial that they were given, by the officers.

The principal and primary fault, however, was in running at too great speed, in such a fog. I concur with the District Judge, on that subject, in two aspects of the question—first, that seven miles an hour was, under such circumstances, a hazardous speed, when the steamship was within a day's sail of New York, in the track of her outward and inward commerce, where the presence of other vessels was to be expected; and, second, the proof is not very satisfactory, that her speed was not greater.

On the other hand, it is clear, that the barque was in fault. She was in direct violation of the rule of navigation which required her to blow a fog-horn. It is not improbable that her officers construed the rule to require them to ring a bell. Such is the testimony in her behalf. They regarded themselves as lying to; and, in this, they are supported by other witnesses, who are experienced mariners. They appeared to have regarded the term "under way," in the rule, as the opposite of "lying to." But, in this they were mistaken, if the term "lying to" was at all apt to describe their condition. The rule is, that, in a fog, sailing ships under way shall use a fog-horn; when not under way,

The Pennsylvania.

they shall use a bell. Here, the barque, although having some of her sails reefed, and her helm lashed, was on her starboard tack, and making not less than a mile an hour. True, she was not under full headway, but she was, nevertheless, under way, and should have used her fog-horn. Evidence was given, tending to show that the bell which she used could be heard at a greater distance than a fog-horn could be heard. But parties are not at liberty to disregard a distinct and explicit rule of navigation, upon their judgment that its disobedience will better subserve the purpose for which the rule is designed. The fact so testified may be useful in determining whether the neglect to use a fog-horn contributed to the collision; but, if the negative of that be proved, by decided, and even conclusive, evidence, it will, nevertheless, be true, that the disobedience of the rule is not justified, when obedience was practicable.

I do not find, upon the evidence, any other fault in the conduct of the barque. She had a perfect right to lash her helm, and, in view of the head winds, which impeded her direct progress, suffer herself to be carried, on her starboard tack, in the direction off her desired course, at as slow a rate as possible. Nor do I find that any want of vigilance or lookout, on her part, if any there was, could have had any influence in causing the collision.

The case stands thus: The Pennsylvania was in fault; and that fault, beyond all question, was a cause of the collision. It brought the steamship into a position, relatively to the barque, in which collision, if not inevitable, was made so by the failure to discover the barque, and act on the discovery in season, and by the conflicting or vacillating orders and movements which she made. The barque was in fault, by neglecting or misinterpreting the rule which required her to blow the fog horn, and by ringing the bell, which indicated that she was not under way. The question in the case is, by these facts, reduced to the enquiry, whether the barque should contribute to the loss resulting from the collision; and this is to be answered by enquiring whether the fault of the barque

The Pennsylvania.

contributed to the collision itself, for, if it did not, then, however severely the neglect of the rule may be condemned, such condemnation in no wise enures to the benefit of the other vessel.

It is claimed, that the neglect of the rule did contribute to the collision in two ways—first, that a fog horn could have been heard further, and, if blown, would have earlier apprised the Pennsylvania of her neighborhood, and afforded her more time and opportunity to check her own speed and avoid the barque; and, second, that the ringing of the bell was adapted to deceive those in the management of the Pennsylvania, into the belief that she was not in motion, and that the management of the Pennsylvania was thereby affected. If there is just reason, upon the proofs herein, to conclude, that, had the fog horn been used, the Pennsylvania would have had such earlier notice, that, under the speed at which she was moving, her efforts to avoid the collision would have been more effectual, or, if her officers were in fact deceived, and thereby led to do what otherwise they would not have done, or were led to omit to do anything which otherwise they would have done, then the fault of the barque contributed to the collision, and her owners should share in the resulting loss.

This question is often one of much delicacy. Parties found in actual fault should make it plain that their fault was not a contributory cause of the disaster. Community in fault, in general, involves community in the aggregate or combined result; and I am bound to admit, that, in this case, there is room for no little hesitation, in declaring that the fault of the barque in no wise operated as a cause of the collision of the two vessels. But it was deemed, in the Court below, that all suggestion that the use of the bell had any influence was speculative and imaginary; that an examination of the proofs by a practical mind, and a view of all the facts in the light of reason and good sense, would show, that the theory, suggested by counsel, of what was possible, was a suggestion of what might, in a supposable case, be possible, but which, in this case, is not true; that no witness from the Pennsylvania has

The Pennsylvania.

suggested that any one was deceived, or that any one on board of her acted upon any idea that the barque was in any other situation than she proved to be ; that, in fact, for reasons above suggested, the steamship did absolutely nothing until they saw the barque, and then the measures taken to avoid her were taken not in view of the bell, or of the want of the sound of the fog horn, but in view of the report, "Ship ahead, off starboard bow ;" that there is, therefore, literally, no ground for any suggestion whatever, that those who actually directed the movements of the Pennsylvania were deceived, or that those movements were, in any manner, affected by the use of the bell, as an indication that the barque was not under way ; and that, as to the claim that the fog horn would have sooner apprised the Pennsylvania of the neighborhood of the barque, several answers are pertinent—that the bell was heard, and ineffectually reported, and, in fact, nothing was done until the barque was seen ; that, in truth, the preponderance of the testimony is, that the bell on the barque could be heard further than a fog horn could be heard ; and, finally, that, if there could be claimed any slight difference in this respect—for, upon the testimony most favorable to the Pennsylvania, it must be slight—that difference, upon all the proofs, would manifestly have not affected the movements of the Pennsylvania or averted the collision. It is not without great hesitation that my mind has concurred with the District Judge on this branch of the case.

As to the question of the jurisdiction of the Court, I think there is no room for doubt. The cause was maritime. Of the subject matter the District Court for the Eastern District has jurisdiction ; and, by the express provision of the statute creating the District and the Court, it has power to send its process into any of the waters of the county of New York, and thereby gain jurisdiction of the cause, by attaching the vessel proceeded against. (*Act of February 25th, 1865, 13 U. S. Stat. at Large, 438, § 2.*)

As to the exceptions to the Commissioner's report on the value of the vessel, it must suffice to say, that it was

Britton v. Butler.

founded upon conflicting or varying estimates; and it cannot, I think, be said, that the Commissioner based his report on the proof of value in New York, more than it can be said he based it on the proof of value at St. Johns, where the vessel was owned. He properly found the value of the vessel at the time and place of collision. As a guide to that value, he had before him the estimates of various witnesses at her home port, varying in amount, from greatly less to greatly more than he reported, and the estimate of witnesses of her value at her port of destination, varying from the amount which he reported to a much greater extent. If I were to conclude, that, on a perusal of the written testimony, I might differ in some small sum from his conclusion, I must still say, that the proof sustains his finding in such degree that it ought not to be disturbed.

This view leads to a decree for the amount reported and decreed to the libellants below, (4 *Benedict*, 257), with costs of the appeal.

Benedict & Benedict, for the libellants.

Charles Donohue & John Chetwood, for the claimants.

WILLIAM A. BRITTON vs. BENJAMIN F. BUTLER.

To an action of assumpsit the defendant pleaded, (1.) That he was military commander under the United States, at New Orleans, and martial law obtained there, from May 1st, 1862, till December 16th, 1862; that, on September 1st, 1862, the armed forces under his command captured a person endeavoring to make his way from the enemy's lines, in Mississippi, to New Orleans; that there were found concealed on his person certain drafts drawn by persons in Natchez, Mississippi, then in the occupation of the enemy, on persons in New Orleans, then in the occupation of the forces of the United States; that the defendant, in his military capacity, and under the authority of the President and the Acts of Congress, captured said drafts, and caused the proceeds thereof, when collected, to be turned over to the Treasury of the United States, and they had been credited to him, by order of the President; and that the

Britton v. Butler.

causes of action sued on arose out of said acts and doings; (2.) That the pretended acts which, if true, would give to the plaintiff the supposed causes of action sued on, were performed by the defendant, if performed, as a military officer of the United States, and in pursuance of the laws of the United States, and of the orders of the President, and during the late rebellion, and that said supposed causes of action did not accrue within two years next before the commencement of the suit, nor within two years after March 3d, 1863: *Held*, on demurrer to the pleas, that the pleas were bad.

Commercial intercourse between the State of Mississippi and the city of New Orleans being unlawful, under § 5 of the Act of July 13th, 1861, (12 *U. S. Stat. at Large*, 257,) and the Proclamation of the President, of August 16th, 1861, (*Id.*, 1262,) the drafts mentioned in the first plea were illegal and void instruments.

The seizure of the drafts passed no title to the United States to the moneys in the hands of the drawees in New Orleans, which were collected on the drafts, the bills not having been accepted before seizure.

The moneys in the hands of the drawees of the bills were not, on the facts set out in the first plea, subject to seizure.

A mere declaration of war does not confiscate enemy property, or debts due to an enemy, nor does it so vest the property or the debts in the Government, as to support judicial proceedings for confiscation of the property or debts, without the expression of the will of the Government, through its proper department, to that effect.

Under the Constitution of the United States, the power of confiscating enemy property and debts due to an enemy, is in Congress alone.

The confiscation Acts of August 6th, 1861, (12 *U. S. Stat. at Large*, 519,) July 17th, 1862, (*Id.*, 589,) and March 12th, 1863, (*Id.*, 820,) all of them provide for a seizure only with a view to judicial proceedings.

None of the confiscation Acts authorize the confiscation of moneys situated as the moneys in this case are alleged by the said first plea to have been situated.

The possession of the unaccepted drafts, considered as captured documents constituting the evidence of debts due to an enemy, gave no right to the captors to take physical possession of the moneys of the drawees.

The Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 432,) approving, legalizing and making valid certain acts and orders of the President, or acts done by his authority or approval, and certain proceedings, acts, arrests and imprisonments, does not embrace the transactions set up in said first plea.

The fact, that martial law obtained in New Orleans, on September 1st, 1862, does not, on the allegations in said first plea, make an order of the President authorizing or approving the seizure of said moneys, an act or order of his respecting martial law, or make the act of the defendant in seizing the moneys an act of his respecting martial law, within the meaning of said Acts.

There is nothing in the mere existence of martial law, which, on the facts alleged in said first plea, justifies the seizure of said moneys.

If said moneys were voluntarily paid to the defendant, the fact that he received

Britton v. Butler.

them as a military commander, and in obedience to the orders of the President, and paid them into the Treasury, and that such payment has been approved by the President, cannot vary his liability for them to the plaintiff, if he would otherwise be liable for them.

The 7th section of the Act of March 3d, 1863, (12 *U. S. Stat. at Large*, 757,) providing a two years' limitation for the bringing of a suit for an arrest or imprisonment made, or trespass or wrong done or committed, or act omitted to be done, during the late rebellion, under authority of the President, or of an Act of Congress, does not apply to an action of assumpsit.

(Before BLATCHFORD, J., Southern District of New York, February 23d, 1872.)

BLATCHFORD, J. This suit was brought in a State Court and transferred into this Court. The declaration is in assumpsit, on the money counts and an account stated. The damages are laid at \$15,000, and the causes of action are alleged to have accrued at New Orleans, in the State of Louisiana, on the 1st day of September, 1862. The defendant pleads the general issue and two special pleas. To each of the special pleas a special demurrer is interposed by the plaintiff, alleging defects in substance and form.

The first special plea avers, that, from the 24th of February, 1862, until the 16th of December, 1862, the defendant was a Major-General of volunteers, duly commissioned by the President, in the service of the United States, and was assigned to the Military Geographical Department of the Gulf, including within its bounds the State of Louisiana, and, as such commander, so assigned, took possession of the city of New Orleans and the adjacent portion of said State of Louisiana, and held the same by the armed forces of the United States, of which he was in command in time of war, and, with such armed forces, was engaged in carrying on the war and suppressing the recent rebellion against the United States, then having broken out into public territorial war in said State of Louisiana and the adjacent States of Mississippi and Texas; that, by due proclamation, according to the customs and usages of war, martial law was declared and proclaimed and obtained in said Department, from the 1st of May in said year 1862, all the time till the 16th day of December in said year,

Britton v. Butler.

and, during all said time, the defendant was acting under the orders and proclamations of the President of the United States, and in administration, and in virtue and under color, of the Acts of Congress ; that, on the 16th of August, 1861, pursuant to the statutes of the United States in such case made and provided, the inhabitants of the States of Louisiana and Mississippi and other States, were, by a proclamation of the President of the United States, declared to be in a state of insurrection against the United States, and that all commercial intercourse should cease, as, by such proclamation, will fully appear ; that, at the time of the promises and undertakings, and of the supposed grievances, complained of by the plaintiff, and subsequently thereto, such proclamation was and remained in full force and virtue ; that, on or about the 1st of September, in said year, the pickets of the armed forces of the United States then under the command of the defendant, and stationed on the outer lines of the camp or garrison of New Orleans, for the protection of said camp or garrison against the enemy, captured a person endeavoring to make his way furtively from the lines and territory occupied by the enemy, to wit, from the city of Natchez in said State of Mississippi, then in the armed occupation of the enemy, to the said city of New Orleans, then in the armed occupation and possession of the United States' forces, as aforesaid ; that there were found concealed upon the person so captured two or more drafts, check or bills of exchange, drawn by persons or firms doing business in said city of Natchez, then in the occupation of the enemy, upon persons or firms doing business in the said city of New Orleans, then in the occupation of the United States' forces ; that, thereupon, the defendant, as such Major-General, and in obedience to the orders and proclamations of the President of the United States, and in the administration, and in virtue and under color, of the Acts of Congress in such case made and provided, captured said drafts, checks, or bills of exchange, and caused the proceeds thereof, when collected to be turned over to the Treasury of the United States, which said proceeds

Britton v. Butler.

have been duly passed upon, audited and credited to him by the order of the President of the United States; and that out of the acts and doings aforesaid, and not otherwise, arose the said several causes of action of which the plaintiff complains.

Under the provisions of the 5th section of the Act of July 13th, 1861, (12 *U. S. Stat. at Large*, 257,) and the Proclamation of the President, of August 16th, 1861, (*Id.*, 1262,) the inhabitants of the States of Mississippi and Louisiana (with certain specified exceptions) were declared to be in a state of insurrection against the United States, and all commercial intercourse between the said States of Mississippi and Louisiana and the inhabitants thereof, and the citizens of other States and other parts of the United States, was made unlawful after the date of said Proclamation, with the said specified exceptions. One of those exceptions excepted from the inhabitants of the State of Louisiana the inhabitants of such parts of that State as might be, from time to time, occupied and controlled by forces of the United States engaged in dispersing the insurgents against the laws, Constitution and government of the United States. On the facts set up in the first special plea, it clearly appears, that, on the 1st of September, 1862, and when the matters alleged in the said plea took place, commercial intercourse between the State of Mississippi and the city of New Orleans was unlawful. That being so, the drafts, checks or bills of exchange, mentioned in that plea, drawn by persons doing business in Natchez, Mississippi, on persons doing business in New Orleans, were illegal and void instruments. (*The Ouachita Cotton*, 6 *Wallace*, 521, 530; *Woods v. Wilder*, 43 *New York*, 164.)

The defendant contends, that, as the bills of exchange were thus void, they were subjects of confiscation; that, as martial law prevailed, and there were no Courts and no civil authorities, the bills of exchange became confiscate at the will of the commanding General, without any of the ordinary processes of law; that the bills thus became the property of the United States, in the hands of the General in command; that

Britton v. Butler.

he, on behalf of the United States, and as its agent, collected the amounts for which they were drawn, being the same moneys to recover which the suit is brought ; and that that is a defence to the suit. It is difficult to see how the consequence logically follows the premises. If the bills of exchange were void, then, even if they were confiscable by mere seizure, it is difficult to see how their seizure and confiscation passed a title to the United States to the moneys in the hands of the drawees of the bills in New Orleans, which the defendant sets up that he afterwards received as a collection of the bills. The bills are not averred to have been accepted by the drawees before they were seized. The confiscation, by the seizure, if of anything, was merely of the naked pieces of paper seized. It gave no valid claim to the United States to collect from the drawees the moneys expressed in the bills. If the moneys were seized in the possession of the drawees, the transaction was no different from what it would have been if the bills of exchange had never been drawn or seized. If the moneys were voluntarily paid by the drawees to the defendant, on a demand for them, as being drawn for by the bills, the bills being void instruments, their seizure could confer on the United States, and on the defendant, no title to receive or retain the moneys, which they would not have had if the bills had never been seized or presented. The transaction set up in the first special plea comes down, then, to this, that the defendant, by order of the President of the United States, either took or received the moneys referred to, which are the moneys sued for.

If the defendant took the moneys by seizing them, the act, so far as the special plea shows, was unlawful. The moneys are not therein alleged to have been forfeitable or subject to seizure for any cause whatever. No Act of Congress, or proclamation or order of the President, is referred to, which made such moneys forfeitable or liable to seizure. They were not seized while passing between loyal and disloyal territory. They were in loyal territory. The plea is, that the defendant, having captured these void drafts, in the

Britton v. Butler.

discharge of his duty, took away from the persons who were the drawees of the drafts, certain moneys belonging to the plaintiff, and paid them into the Treasury of the United States, and that, by the order of the President of the United States, those moneys have been passed upon, audited and credited to him. There is no warrant for saying that the transaction, as set up in the plea, if one of seizure, was lawful. The moneys are not even averred to have been the property of an enemy or of an insurgent. The fact that the drawers of the bills, which are alleged in the plea to have been drafts, checks or bills of exchange, were within the insurgent territory, and that the bills were drawn there, although it may warrant the presumption that the drawees were debtors to the drawers to the amounts of the bills, does not warrant the presumption that the moneys in the hands of the drawees were not the moneys of the drawees, or were the moneys of persons within the insurgent territory, or were the moneys of the enemy. The case, then, as one of seizure, is one of seizure, in loyal territory, of the moneys of persons in such territory, not alleged to have been enemies of the United States.

Even if the moneys were the property of an enemy of the United States, or were the representative of debts due to such enemy, the plea sets up no authority for their seizure. The mere declaration of war does not confiscate enemy property or debts due to an enemy, nor does it so vest the property or the debts in the Government, as to support judicial proceedings for the confiscation of the property or debts, without the expression of the will of the Government, through its proper department, to that effect. Under the Constitution of the United States, the power of confiscating enemy property and debts due to an enemy is in Congress alone. (*Brown v. United States*, 8 Cranch, 110.) In legislating on the subject, Congress has passed various Acts, but none of them authorize the confiscation of moneys situated as the moneys in this case are alleged by the plea to have been situated. The Act of August 6th, 1861, (12 *U.S. Stat. at Large*, 319,) provides for the seizure by the President, and the condemnation by

Britton v. Butler.

judicial proceedings, of property acquired or disposed of with intent to employ the same in aiding the insurrection, and property knowingly so employed. The Act of July 17th, 1862, (*Id.*, 589,) provides for the seizure by the President, and the application to the support of the army of the United States, through judicial proceedings, of the proceeds, of the property, money, credits, and effects, of persons holding office under the insurgents, and of persons owning property in loyal territory, who aid the rebellion, and of persons in the rebel States in arms or aiding the rebellion, who do not return to their allegiance within sixty days after warning by proclamation. The Act of March 12th, 1863, (*Id.*, 820,) provides for the confiscation, through judicial proceedings, of property coming from within the insurgent States into the loyal States, otherwise than according to regulations prescribed by that Act. All of these Acts provide for a seizure only with a view to judicial proceedings. Even if a seizure in this case was lawful, no judicial proceedings are set up, but only a turning over of the moneys to the Treasury of the United States.

Considered as a capture of documents constituting the evidence of debts dues to an enemy, (if that is predicable of unaccepted bills), and as giving the right to capture the moneys, representing the debts, as the property of the enemy, the transaction stands in no different posture. The bills captured were not the debts. The possession of the unaccepted bills gave no right to the captors to take physical possession of the moneys of the drawees, and could have no effect to divest or affect the title of the drawees to such moneys, or their right of possession in the same. (*Halleck on International Law*, chap. 19, sec. 8.)

The Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 432,) is invoked in aid of the plea. That Act provides, that all acts and orders of the President, or acts done by his authority or approval, after March 4th, 1861, and before July 1st, 1866, "respecting martial law, military trials by Courts martial or military commissions, or the arrest, imprisonment, and trial of

persons charged with participation in the late rebellion against the United States, or as aiders or abettors thereof, or as guilty of any disloyal practice in aid thereof, or of any violation of the laws or usages of war, or of affording aid and comfort to rebels against the authority of the United States, and all proceedings and acts done or had by courts martial or military commissions, or arrests and imprisonments made in the premises by any person by the authority of the orders or proclamations of the President, made as aforesaid, or in aid thereof," are thereby approved in all respects, legalized, and made valid, "to the same extent and with the same effect as if said orders and proclamations had been issued and made, and said arrests, imprisonments, proceedings, and acts had been done, under the previous express authority and direction of the Congress of the United States, and in pursuance of a law thereof previously enacted, and expressly authorizing and directing the same to be done." It also provides, that no Court "shall have or take jurisdiction of, or in any manner reverse, any of the proceedings had or acts done as aforesaid, nor shall any person be held to answer in any of said Courts, for any act done, or omitted to be done, in pursuance or in aid of any of said proclamations or orders, or by authority, or with the approval, of the President, within the period aforesaid, and respecting any of the matters aforesaid;" and that "all officers and other persons in the service of the United States, or who acted in aid thereof, acting in the premises, shall be held, *prima facie*, to have been authorized by the President." This Act applies solely to "the matters" and "the premises" mentioned in it, and those do not embrace the transaction set up in the plea. The fact, that martial law obtained in New Orleans on the 1st of September, 1862, does not, on the allegations in the plea, make an order of the President authorizing or approving the seizure of these moneys, an act or order of his respecting martial law, or make the act of the defendant in seizing the moneys an act of his respecting martial law, within the meaning of the statute. There is nothing in the mere existence of martial law, which, on the facts alleged

Britton v. Butler.

in the plea, justifies the seizure of the moneys. In the case of *The Venice*, (2 *Wallace*, 258,) the Supreme Court, referring to the reoccupation of New Orleans by the forces of the United States, in May, 1862, and to the proclamation of the commanding general, on the 6th of that month, declaring the city to be under martial law, and also declaring that "all the rights of property, of whatever kind, will be held inviolate, subject only to the laws of the United States," says, that, under the Act of July 13th, 1861, and the proclamation of the President, of August 16th, 1861, the city of New Orleans, after its actual, substantial, complete, and permanent military occupation and control by the United States, in May, 1862, could not be regarded as in actual insurrection, nor could its inhabitants be regarded as subject, in most respects, to treatment as enemies; and that such military occupation and control drew after it the full measure of protection to persons and property consistent with a necessary subjection to military government. The plea sets up no necessity for the seizure of the moneys, and no justification therefor, within these principles.

If the moneys were voluntarily paid to the defendant, and not seized by him by military power, the fact that he received them as major-general, and in obedience to the orders of the President, and paid them into the Treasury, and that such payment has been approved by the President, cannot vary his liability for them to the plaintiff, if he would be liable for them in case no such fact existed, on evidence to be adduced by the plaintiff under his declaration. Whether, if the case ever comes to trial on the plea of the general issue, the plaintiff can make out the defendant's liability, is another question. All I mean to say is, that, if the defendant is otherwise liable, the facts set up in the plea constitute no defence to the action.

The demurrer to the first special plea must, therefore, be allowed, with leave to the defendant to amend, on payment of costs.

The second special plea avers, that the pretended acts

Britton v. Butler.

which, if true, would give to the plaintiff the supposed causes of action mentioned in the declaration, were performed, if performed by the defendant, as a major-general of volunteers in the army of the United States, duly commissioned by the President, and under and in pursuance of the laws of the United States, and the orders and proclamations of the President, and during the late rebellion of the Southern States against the authority of the General Government of the United States; and that said supposed causes of action did not, nor did any or either of them, accrue within two years next before the commencement of this action, nor within two years after March 3d, 1863.

The statute relied on as supporting this plea is the 7th section of the Act of March 3d, 1863, (12 *U. S. Stat. at Large*, 757,) which enacts, that "no suit or prosecution, civil or criminal, shall be maintained for any arrest or imprisonment made, or other trespasses or wrongs done or committed, or act omitted to be done, at any time during the present rebellion, by virtue or under color of any authority derived from, or exercised by or under, the President of the United States, or by or under any Act of Congress, unless the same shall have been commenced within two years next after such arrest, imprisonment, trespass, or wrong may have been done or committed, or act may have been omitted to be done, provided, that, in no case shall the limitation herein provided commence to run until the passage of this Act, so that no party shall, by virtue of this Act, be debarred of his remedy by suit or prosecution, until two years from and after the passage of this Act." It is sufficient to say, that this suit is an action of assumpsit, and is not a suit for an arrest or imprisonment made, or a trespass or wrong done or committed, or an act omitted to be done, during the rebellion. Moreover, the plea does not aver that the "pretended acts" which it refers to were arrests or imprisonments or trespasses or wrongs. The 4th section of the same Act makes an order of the President, or under his authority, made during the existence of the rebellion, a defence only to an action or prosecution, civil or crim-

 Carrington v. The Florida Railroad Company.

inal, "for any search, seizure, arrest, or imprisonment made, done, or committed, or acts omitted to be done, under and by virtue of such order, or under color of any law of Congress." The nature of the action, for the purposes of the demurrer to this plea, can be judged of only by the declaration.

The demurrer to the second special plea is, therefore, allowed, with leave to the defendant to amend, on payment of costs.

Everett P. Wheeler, for the plaintiff.

John E. Develin, for the defendant.

DANIEL N. CARRINGTON

v8.

THE FLORIDA RAILROAD COMPANY AND ALBERT A. DRAKE.
IN EQUITY.

An action was removed into this Court, from a State Court, as against two of the defendants, under the Act of July 27th, 1866, (14 *U. S. Stat. at Large*, 306.) After the record of removal was filed in this Court, the plaintiff pleaded anew, setting up, in his bill, the removal of the cause. After issue, the plaintiff moved to remand the cause to the State Court, on the ground that it was not within the Act: *Held*, that it was too late for the plaintiff to ask that the cause be remanded, on motion.

(Before BENEDICT, J., Eastern District of New York, March 4th, 1872.)

BENEDICT, J. This action was originally commenced in the Supreme Court of the State of New York, and is now upon the docket of this Court, by virtue of proceedings taken to remove it, as against two of the defendants, from the State

Carrington v. The Florida Railroad Company.

Court to this Court, in pursuance of the Act of Congress of July 27th, 1866, (14 *U. S. Stat. at Large*, 306.) It now comes before the Court upon a motion made by the plaintiff to remand the cause to the State Court, upon the ground that it is of such a nature as not to be within the scope of the Act of 1866, it being, however, admitted, that the defendants are citizens of another State.

It appears to me a sufficient answer to this motion to say, that it is made to appear, that, after the record of removal was filed in this Court, the plaintiff pleaded anew in this Court, and, in his bill, set up the removal of the cause into this Court, as having been effected by the proceedings taken by these defendants, without any suggestion that the case was not removed, and properly so. The case is now at issue in this Court, upon the plaintiff's bill filed here, and the answer and demurrer of the defendants; and it is too late now for the plaintiff to ask that the cause be remanded, on motion.

The motion to remand is denied.

John L. Hill, for the plaintiff.

Edward N. Dickerson, for the defendants.

DANIEL N. CARRINGTON

vs.

THE FLORIDA RAILROAD COMPANY AND ALBERT A. DRAKE.
IN EQUITY.

Before the removal of a cause into this Court, from a State Court, as against two of the defendants, under the Act of July 27th, 1866, (14 *U. S. Stat. at Large*, 306,) an injunction was granted in it, by the State Court, on a full

Carrington v. The Florida Railroad Company.

hearing, on notice, against such defendants. After the removal, they moved, in this Court, to dissolve the injunction, on the same papers on which it was granted: *Held*, that leave to make such motion must be applied for and obtained, before it could be made.

(Before BENEDICT, J., Eastern District of New York, March 5th, 1872.)

BENEDICT, J. This action was originally commenced in the Supreme Court of the State of New York. While the cause was before the State Court, all the defendants having appeared therein, a motion for an injunction was made on the part of the plaintiff, which was opposed, on affidavits, by the defendants, and, after hearing all parties, the State Court granted the injunction asked for by the plaintiff. Shortly after the decision of the State Court upon the motion for an injunction, two of the defendants, who are citizens of another State, took proceedings under the Act of Congress of July 27th, 1866, (14 *U. S. Stat. at Large*, 306,) to have the cause, as to such defendants, removed into this Court. By virtue of such proceedings, a record of removal was filed in this Court, and the appearance of the said two defendants was here entered, whereupon the plaintiff pleaded anew in this Court, in order to conform the proceedings to the Chancery practice of the Court. In this stage of the case, the defendants now move, in this Court, to dissolve the injunction granted by the State Court, and such motion is made upon the same papers upon which the injunction was granted by the State Court.

I entertain no doubt of the power of this Court, in a cause duly removed from the State Court, to dissolve an injunction granted in the cause while it was in the State Court. But I am of the opinion, that, where it is desired to make a motion like the present, which is, in effect, an application for a re-argument of the motion made before the State Court, leave to make such application should be first applied for and obtained.

The motion to dissolve the injunction is, therefore, denied, upon the ground that no leave to make the same had been previously obtained.

John L. Hill, for the plaintiff.

Edward N. Dickerson, for the defendants.

* Galvin v. Boutwell.

BARTHOLOMEW C. GALVIN

vs.

GEORGE S. BOUTWELL.

A case was removed into this Court, under the 12th section of the Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 79,) on the allegation that the plaintiff was a citizen of New York, and the defendant a citizen of Massachusetts. The plaintiff moved to remand the cause, on the ground that he was an alien. That fact was not denied: *Held*, that the motion must be granted.

(Before BLATCHFORD, J., Southern District of New York, March 8th, 1872.)

BLATCHFORD, J. As it is not denied, on this motion, that the plaintiff is an alien, I think the case ought to be remanded to the State Court. It was removed here under the 12th section of the Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 79,) on the allegation that the plaintiff was a citizen of New York, and the defendant a citizen of Massachusetts. I do not think it falls within the principle of *Dennistoun v. Draper*, (5 *Blatchf. C. C. R.*, 336,) and *Wood v. Mattheros*, (2 *Id.*, 70.) If the question of the alienage of the plaintiff were seriously contested, it would be proper to retain the case for a trial of that question, on the merits, on formal issues in the cause. There can be no doubt of the power of this Court to remand the cause, if it sees that there is no jurisdiction. (*Witetiqui v. D'Arbel*, 9 *Peters*, 692, 701.) The exercise of that power at this stage of the cause is a question of discretion; and, in this case, I think a proper exercise of such discretion requires that the case be remanded. The motion is granted, on condition that the plaintiff stipulates that the defendant have thirty days' time to answer the complaint,

after a certified copy of the order herein shall have been filed in the State Court.

Joseph J. Marrin, for the plaintiff.

Noah Davis, for the defendant.

MARK SHAW vs. MOSES H. GRINNELL.

By the 15th section of the Act of June 30th, 1864, (13 *U. S. Stat. at Large*, 215,) the decision of a collector of customs, as to fees, charges and exactions claimed by him in the performance of his official duty, is declared to be final and conclusive, unless an appeal is taken to the Secretary of the Treasury, and it is provided that no suit shall be maintained to recover any such fees, &c., alleged to have been erroneously or illegally exacted, until the decision on such appeal is had. A vessel from a foreign port, with dutiable goods on board, arrived at New York, and was there sold, under a decree on a libel in admiralty, to the plaintiff. The duties on the goods not being paid or secured, the inspectors in charge, under the order of the collector, took the goods to the public stores, according to the provisions of § 56 of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 669,) and of the Act of March 2d, 1861, (12 *Id.*, 209.) The collector exacted from the plaintiff the fees, charges and expenses connected with the removal of the goods, as a condition of granting to him a clearance for the vessel for an outward voyage. The plaintiff paid the amount, under protest, but did not appeal to the Secretary of the Treasury, and then brought this suit to recover back the amount paid: *Held*, that, although the exaction was, in fact, not warranted by law, the suit could not be maintained, because of the failure to appeal to the Secretary of the Treasury.

(Before WOODRUFF, J., Southern District of New York, March 11th, 1872.)

WOODRUFF, J. I am not able to withdraw the claim of the plaintiff, in this case, from the operation of section 15 of the Act of June 30th, 1864, (13 *U. S. Stat. at Large*, 215.) That section provides, that "the decision of the respective

collectors of customs, as to all fees, charges and exactions of whatever character, other than those mentioned in the next preceding section, claimed by them, or by any of the officers under them, in the performance of their official duty, shall be final and conclusive against all persons interested in such fees, charges or exactions, unless * * notice that an appeal will be taken * * to the Secretary of the Treasury, shall be given within ten days, * * and unless such appeal shall actually be taken within thirty days. * * * * And no suit shall be maintained in any Court, for the recovery of any such fees, costs and charges alleged to have been erroneously or illegally exacted, until the decision of the Secretary of the Treasury shall have been first had on such appeal."

About the 1st of April, 1869, the brig Julia Kelly, of Parrsborough, Nova Scotia, arrived at this port, with a cargo of goods, from the port of Hamburg. She was here proceeded against by libel, in admiralty, and, on or about the 12th of May, was sold by the marshal, under the decree of the Court. The plaintiff became the purchaser, and received a bill of sale from the marshal, dated May 12th, 1869. Meantime, having dutiable goods on board, and the duties not being paid or secured, on the 5th of May, an order was issued, by the Collector of the port, to the United States' inspectors in charge, to take the goods to the public stores, in accordance with § 56 of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 669,) and the Act of March 2d, 1861, amendatory thereof, (12 *Id.*, 209.) After the purchase above mentioned, the plaintiff applied to the defendant for a clearance of the brig for an outward voyage, and such clearance was refused, unless the fees of inspectors, charges of stevedores, and other expenses of removing the goods, were paid. The plaintiff, protesting against the exaction, paid the charges, amounting to \$485 95 over and above the ordinary fees and charges for a clearance, and, without taking any appeal to the Secretary of the Treasury, brought this suit.

The form of the declaration herein is somewhat equivocal.

The summons appears to be in assumpsit. The declaration, while it sounds in tort, for damages, gives a narrative of the exaction, and claims the money, alleged to have been illegally exacted, as damages, and there is no allegation, nor any proof, of any other damages.

I think it quite clear, that the exaction was not warranted by any law relating to the clearance of vessels. Certain papers are required to be produced, and fees for clearance paid, but no statute declares that costs or charges of unlading the vessel, under the order of the collector, shall be paid before the vessel shall be cleared; and, the statute under which such unlading is done, having made provision for those charges, there is no implication of intent to charge the vessel or its owners therewith. The statute directs, that, after the goods have remained in store for a period specified, they shall be sold, the duties, and all charges thereon, shall be deducted from the proceeds, and the surplus shall be transmitted to the Treasury, for the use of the owner of the goods. And this should be so. The Act was intended not only to secure to the Government the duties on the goods, but was designed for the relief of the vessel and owners, not to burthen them. They, being carriers merely, had need of some provision of law whereby, when the owners of the goods, or the consignees, neglected to pay the duties or procure permits for the landing and delivery thereof, the ship might be discharged of her cargo, by delivery to the officers of the customs, and proceed on her future voyage.

The exaction was, therefore, unwarranted, and the plaintiff, if he had taken the requisite steps, would have been entitled to a return of the money which he was required to pay to obtain a clearance. But it is, I think, impossible to escape the provisions of the Act of 1864, above cited. If that Act related solely, as it does very largely, to duties on goods, it might be possible to construe the 15th section as limited to exactions already in that Act mentioned. But the 14th section covers all such exactions. It includes all overcharges of duties on the goods, and also all tonnage duties on the vessel, and requires protest and appeal before suit; and then the 15th

section, in the terms above cited, includes all fees, charges and exactions of whatever character, other than those mentioned in the 14th section, claimed by the collector in the performance of his official duty. It is a broad and general provision. It reaches all collectors and officers under them, and all requirements made by them in the performance of official duty.

It will not obviate this provision to say, that, because there is no law to warrant the exaction, therefore, this section does not apply. It is enacted for the express purpose of providing for exactions not warranted by law, and to regulate the manner in which re-imbursement may be had. Every excess of fees, every over-charge of duties, all charges of duty on goods that should be admitted free, are illegal charges. It makes no difference that some exactions are more plainly illegal than others. There was no occasion for a statute regulating a proceeding to recover back legal charges or exactions.

The enquiry is—Was it an exaction made by the collector in the performance of his official duty? Undoubtedly it was. It was his official duty to grant a clearance of the vessel on the production of proper papers and the payment of legal charges and fees. As collector, acting officially on the question whether the plaintiff was entitled to a clearance, he decided that the charges for the previous unlading must be first paid. The subject matter was within his jurisdiction. However great his mistake or error, it was his official act. Herein the case is distinguished from the illustrations suggested by the counsel for the plaintiff, where a collector is assumed to have casually obtained the manual possession of the property of another, and refuses to give up such possession without the payment of money, the collector not having possession or control of the property by virtue of his office, and having no official duty to perform in respect thereto.

In respect to the form of the action, several observations are pertinent: 1st. This is not an action on the case for fraud. There is no allegation of fraud or wilful misfeasance. There is no pretence that the collector acted otherwise in this matter

Shaw v. Grinnell.

than under a mistake in regard to the charges which could properly be required as a condition of granting the clearance. 2d. If this be not regarded as, in substance, an action to recover back the moneys illegally exacted, there is no evidence of any other damages. It does not appear that the plaintiff sustained any damage, except that he paid so much money, and there is no proof of any other. 3d. A plaintiff who has paid duties, charges or other exactions, cannot avoid the statute by claiming to recover back the money in an action sounding in tort. No suit can be sustained, in which the exaction shall be the ground, and the amount paid is made the measure of the recovery, without a compliance with the statute.

Although it is eminently just that these moneys should be refunded, I am not able to refuse to the defendant the benefit of the statute referred to. If the defendant paid over the money to the Treasury of the United States, it is not only just, so far as it appears by any proofs before the Court, that the money should be refunded by the Government, but a failure to refund seems to me eminently unjust. Apparently, the Government holds the goods themselves. It had full right and power to collect this money from the goods. It is not easy to see why that was not done; and, if the goods were sold and the proceeds are in the Treasury, the Government now holds the money as twice paid. How, in that state of things, can the plaintiff obtain re-imbursement of what it was wholly unnecessary for the protection of the Government, and wholly unjust, to require him to pay? There is to this manifestly unjust result the dry legal answer—he should have appealed to the Secretary of the Treasury, and, failing to do so, he can maintain no suit. As I am constrained to say that this answer is sufficient in law, I must direct judgment for the defendant.

Robert D. Benedict, for the plaintiff.

Noah Davis, (*District Attorney*), for the defendant.

WILLIAM WILLIAMS

vs.

CALVIN A. LEONARD AND OTHERS. IN EQUITY.

In a suit in equity, for the infringement of letters patent, brought before the passage of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 206, 216, §§ 55, 111,) both profits and damages cannot be recovered.

An interlocutory decree in such a suit, entered after the passage of such Act, inadvertently provided for the recovery of both profits and damages. The report of the Commissioner reported both profits and damages, and was excepted to by the defendant, on the ground that the damages could not be recovered in the suit: *Held*, that the point could not be raised by an exception to such report, but that, nevertheless, the Court would not award any damages, and would resettle the interlocutory decree, so as to exclude them.

In an accounting for profits, the defendant cannot be credited with a sum of money as a salary earned by and paid to himself, while engaged in the business which earned the profits.

(Before WOODRUFF, J., Northern District of New York, March 19th, 1872.)

WOODRUFF, J. The form of the interlocutory decree in this case warranted the Commissioner in reporting both the profits made by the defendants, by infringing the patent of the complainant, and also the damages (over and above, or beyond the amount of, those profits) sustained by the complainant, as allowed in actions brought after the passage of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 206, 216, §§ 55, 111.) Whether any language can be found in the opinion of the Court, delivered after the hearing of the cause on pleadings and proofs, that seemed to warrant such an interlocutory decree, I am not able, from recollection, to say; but it is quite certain, that the Court did not intend to decide, that, in a suit brought in equity before the passage of that Act, both profits and damages can be recovered. Section 111 declares, that actions and causes of action then existing may

be commenced and prosecuted, and that suits then pending may be prosecuted to final judgment and execution, in the same manner as though the Act had not been passed, and that the remedial provisions of the Act shall be applicable to all suits and proceedings thereafter commenced, although the cause of action may have arisen before. The provisions of the statute regulating the form of action, and prescribing the measure of recovery, at law or in equity, are provisions applicable especially to the remedy; they are among the "remedial provisions." When they were declared applicable to all suits thereafter brought, as an exception to language importing that prior causes of action, not yet prosecuted, should be commenced and prosecuted, and suits commenced should be prosecuted to judgment, in the same manner as if the Act had not been passed, the negative implication is plain, that those remedial provisions which were new have no application to suits then pending. In construing an exception, the *expressio unius* is eminently the *exclusio alterius*.

The interlocutory decree is wrong. Had such a decree been entered by consent, the defendants might be bound by it; but I presume it was entered without the attention of counsel being called to the construction of the statute. How it was settled does not appear.

But, in so far as the exceptions to the report of the Commissioner are addressed to this point, the defendants have mistaken the mode of correcting the error. The report conforms to the decree, and, therefore, is not, in this particular, the proper subject of exception. The Court should have been applied to, to resettle the decree.

Nevertheless, it is not too late to make the correction. Entertaining the opinion above expressed, the Court will not proceed to a final decree against the defendants, which it deems not warranted by law; and the facts reported in detail by the Commissioner will enable the Court to decree the recovery of the gains and profits made by the defendants, by the infringement, excluding damages beyond that amount. The complainant had his election, to proceed for such gains and profits,

Williams v. Leonard.

or to sue for damages, and he chose the former. As to the result of such election, the law has not been changed since he brought his suit, and it is no hardship that he is held to his election.

As to the "salaries" of the defendants, during the period in which they have been engaged in infringing, they have no title, as against the complainant. It would be very great injustice, if the *quantum* of gains and profits recoverable by a complainant depended on the question, how much of such gains and profits the defendants used for their own support, or the support of their families, or, as even more broadly claimed here by the defendants, how much they saw fit to appropriate to their own use. Infringers would rarely be required to pay over anything, if they could divide the gains and profits among themselves, under the name of salary, wages, or any other designation. Men work for gains and profits, but they are gains and profits still. Men support themselves and their families out of their gains and profits, but that does not change their nature. If it were not so, inventors might, by reason of infringements, fail to obtain anything, and the infringers obtain what they see fit to term adequate salaries, out of their piracy. What, in good faith, the defendants pay to others, as expenses, may be taken as the cost, to them, of their manufacture. What they take to themselves are gains. They might, perhaps, have earned and gained as much, or perhaps more, by laboring in some other business, in no violation of the rights of their neighbor; but they cannot be permitted to gain either wages or salary by a violation of such rights.

The exceptions, as exceptions, must be overruled, with costs; but the interlocutory decree should be resettled and entered, and the amount of gains and profits, which, as I understand the report, are \$1,668 $\frac{1}{10}$, should be awarded by the final decree, with interest thereon, and the costs of suit.

F. A. Macomber, for the plaintiff.

H. H. Woodward, for the defendants.

Buerk v. Valentine.

JACOB E. BUEBK

vs.

DENNIS VALENTINE. IN EQUITY.

The reissued letters patent, granted to Jacob E. Buerk, as assignee of John Burk, the inventor, March 8th, 1860, for 14 years from October 29th, 1856, for an "improvement in watchman's time-detectors," the original patent having been granted to Buerk, January 1st, 1861, for 14 years from that day, and reissued to him, August 22d, 1865, for the residue of such last-named term, are valid.

Burk having obtained in France, October 29th, 1856, a patent for his invention, it was proper to correct, by a reissue, the error in granting the patent in the United States otherwise than for 14 years from that date.

Making a prior device, which will serve the like useful purpose, is not necessarily anticipating an invention. Where the mechanical means employed are different, and the mechanical result is different, one does not anticipate the other.

Whether the letters patent granted to Jacob E. Buerk, as inventor, June 6th, 1865, for an improvement on the time detector described in the said patent of 1856, are valid, *quere*.

The defendant's apparatus held to be an infringement of the plaintiff's patent, where its mechanical construction was the same in all that constituted the principle or mode of operation of the plaintiff's apparatus, and gave it efficiency in securing the object of the invention.

(Before WOODRUFF, J., Northern District of New York, March 19th, 1872.)

WOODRUFF, J. This is a suit brought to restrain the alleged infringement of two patents, and for an account of gains and profits accruing to the defendant by such infringement, and for damages.

The patent first set out in the bill of complaint is based upon an alleged invention by John Burk, of Schwenningen, in the kingdom of Wurtemberg, made prior to the 1st of January, 1861, and assigned to the complainant, December

3d, 1860. The original patent was granted to the complainant January 1st, 1861, and purported to grant to him the exclusive right to make, use and sell, &c., for fourteen years. This patent was surrendered and re-issued on the 22d of August, 1865, for the residue of the term of fourteen years from the 1st of January, 1861. John Burk, the alleged inventor, having, as early as October 29th, 1856, obtained a patent for his invention from the Government of France, it was perceived that the patents issued in the United States to the complainant had erroneously granted the exclusive right for fourteen years from the 1st of January, 1861. The complainant, therefore, again surrendered his patent, and the same was re-issued on the 8th of March, 1870, for the term of fourteen years from the 29th of October, 1856, the date of the inventor's French patent. The patent and such re-issues are for an "improvement in watchman's time-detectors."

The other patent alleged in the bill to have been infringed by the defendant was granted to the complainant himself, as the inventor of an alleged improvement upon the time-detector described in the other patent. It was granted on the 6th of June, 1865, for the term of seventeen years thence next ensuing.

The invention described in the first patent, as re-issued to the complainant in 1870, provided for the watchman a watch, which he carried with him in his rounds, so constructed, that, by the insertion of a key provided at each of the stations which he was required to visit, he could make, within the watch, a record indicating the several stations visited, the precise time of each visit, and, of course, the order in which the visits to the respective stations were made. The watch was provided with a lock, so that the watchman had no access to its interior; and, as the record of each station could only be made by the peculiar key which belonged to such station and was there secured or made fast, the watchman could make no false record or deceive his employers. Without entering into unnecessary detail, it will be sufficient, in the

Buerk v. Valentine.

first instance, to say, that this was effected by using a watch- or small portable clock-movement, enclosed in a strong case, the lid of which could be locked, the employer retaining the key. To the arbor of the watch upon which the hour hand was placed, a drum was attached, so as to revolve as the hour hand revolved. The circumference of the drum was a little greater than the ordinary watch dial, and its surface was of width suitable to receive the paper next mentioned. Around the circumference of the drum was placed a strip of paper. By marks thereon, the paper was divided into spaces corresponding, in their position relatively to the centre of the watch, to the hours and minutes of the watch dial, and, by lines drawn lengthwise, it was also divided into several spaces, corresponding in number to the number of markers to be used, as next mentioned. Exterior to the watch-movement, but within the case, there were placed several small steel bars or springs, terminating each in a point bent at right angles, while the other end was fixed firmly to the circular plate or frame of the watch movement. These springs were placed and held, in a gauge, one above another, so that the points were in a row perpendicular to the watch face, at and exterior to the point on the dial of the watch indicating the hour of 12; and each point was directly opposite one of the longitudinal spaces in the strip of paper around the circumference of the drum. In this position, it is obvious, that, if the point of one of the springs was pressed inward upon the revolving drum, it would perforate the paper within its proper longitudinal division, and the perforation would show the hour and minute at which it was made; and, in order to permit such perforation without injuring the steel point, the periphery of the drum was channeled by narrow longitudinal grooves, beneath each of the said longitudinal spaces in the paper placed thereon. Keys were provided, which varied from each other in the location of the bit thereon, in the width of such bits, and also in the number of bits, in such wise, that, one of the keys being inserted in a key-hole contiguous to the steel springs, and turned, the bit of the key would press one of the

Buerk v. Valentine.

springs inward upon the paper and make one perforation, another key would press two springs inward and make two perforations, another three, and so on; and one key would press the first of the springs, another the second, another the third, and so on; and one key would press inward the first and second, another the first and third, another the first and fourth, another the second and third, another the second and fourth, another the third and fourth, another the third and fifth, and so on, through all the variations of which the number of springs used was susceptible; and, one key being fastened at each station, the marks or punctures which would indicate a visit to that station could not be made by any other key, nor by any means but by an actual visit to that station and the use of the key there suspended.

The claims in the specification annexed to the re-issued patent for this invention are: (1.) The drum, carrying a removable piece of paper, or other suitable material, marked or divided off in a convenient number of parts, in combination with a chronometer movement or time-piece, and with one or more marking devices, substantially as and for the purpose set forth. (2.) The combination of the marking devices, fastened internally to a time-piece, with a watch movement, and with a series of keys, and a surface for receiving marks, substantially as described.

The invention described in the second patent, and claimed to be the invention made by the complainant himself, was for the same purpose as the other, and is only claimed as an improvement thereon. In its main features, it consisted in removing the drum entirely and the paper wound thereon. It attached a circular disk to the arbor of the hour hand, to revolve therewith, and attached thereto a circular flat paper dial, of larger diameter, divided by radial lines corresponding with the hours and minutes of a watch dial, and having a portion of its exterior divided into spaces by circular lines drawn at uniform distances, such spaces corresponding, as the paper disk revolved, to the location of the steel points next mentioned. Beneath the circular plate forming the support or

Buark v. Valentine.

frame of the watch movement, the gauge of steel bars or springs was firmly attached to such plate, in such position that the points were in a straight line radial to the centre, and, over each point, was a hole in the said plate, so that each spring could be pushed upward, the point thereof passing through the hole, and upward, sufficiently to perforate the revolving paper dial, in the space corresponding to the point of the spring so raised. Over the row of holes was placed what is called a fixed index—a small strip of metal fastened to the circular plate or frame of the watch, and extending towards the centre of the disk, raised sufficiently above the revolving disk to permit the paper dial to revolve freely under it and over the holes through which the spring points were to rise; and, to prevent injury to those points, holes were made in its under surface, opposite each point, into which the points, as they rose and perforated the paper, would enter, and then, by the power of the spring, be immediately withdrawn to their respective positions below such plate. The keys were the same as used in the former invention, and were inserted in a key-hole so located that the bits of the keys, when turned, forced the springs upwards instead of inwards, as before, the springs lying flat upon or near the inner surface of the circular plate or frame before mentioned. By this means, the perforation was made in the exterior portion of the revolving paper dial, and the place of perforation indicated the precise hour and minute it was made, and the particular keys by which it was made, with all the variations above stated as to the former patent; and the perforations were all from beneath the paper, upward, through it.

The claims of this patent are: (1.) The use of the false revolving dial, in combination with the stationary index and spring points, constructed and operated substantially as and for the purpose set forth. (2.) Producing the perforations on the paper dial, or its equivalent, from the inside out, instead of from the outside in, as before.

The defendant imports and sells a watchman's time-detector, which serves the same purpose as those above de-

Buerk v. Valentine.

scribed, and is operated by keys having like bits, and varied in the same manner in the location of the bits. It is susceptible of like variations in the form of the keys, to adapt it for use at numerous stations. It makes the record by perforations in a revolving paper dial, attached to a circular disk fastened to the arbor of the watch on which the hour hand is placed. That paper dial is divided in the same manner as is above described; and the perforations are made by the points of steel springs arranged in a like gang side by side, moved by the bit of the respective keys in like manner.

The leading feature in which it differs from the time-detector as alleged to be improved by the devices mentioned in the complainant's second patent, is this : The gang of steel springs, instead of being placed beneath the circular plate or frame of the watch movement, is attached to the lid of the case of the instrument, immediately over the location of the gang of springs in the complainant's detector. When closed, the line or row of points is in the same straight line radially from the centre; and, in order to perforate the paper dial, they must be pressed downward, instead of upward. To that end, the key-hole is placed in the side of the lid, over the gang of springs, instead of being placed in the body of the case, below the springs, as in the detector of the complainant. Instead of the complainant's fixed index, placed over the holes through which, in his detector, the points rise to perforate the paper, there is, in the same location, a row of holes in the plate or frame of the movement, into which the points enter, to protect them from injury when making the perforation. The necessity of making such fixed index in such manner that it will sustain the paper during the act of perforation, being obviated by making the motion of the springs downward, whereby the plate of the watch performs the same office during such act, a mark in the form of an arrow is made on the plate or frame, opposite the row of holes which performs the office of the index, in indicating the point corresponding with the figure 12 of the watch dial, as a guide in

setting the paper dial, when the watch is placed in the hands of the watchman.

There are some minor differences in the manner in which the paper disk is attached to the revolving disk upon the arbor, but they are deemed to be very clearly not of the substance of the complainant's invention; and the examples which are produced as exhibits show, also, a watch dial and hands, on the defendant's detector, which does not appear in the complainant's, but that is a matter which is not supposed to be included in the complainant's patent, or to be, in itself, any infringement. This, however, involves another variation in the marking and figuring of the paper dials. As the complainant's dial is placed on what is ordinarily the face of the watch, and revolves as the hour hand revolves, the figures thereon denoting the time, (and passing successively under the index, where perforations may be made,) are necessarily printed in an order in reverse of the figures on the watch dial; while, in the defendant's detector, as the paper dial is put on the other end of the arbor, (opposite the face of the watch,) the figures on the paper dial are printed in the same order as on the face of the watch, but the motion thereof, relatively to the points for perforation, is reversed. The results of the revolution, in respect to the record of the time, are, therefore, the same in each. If, in either of these points of difference, the detector of the defendant is an improvement, that alone will not protect the defendant from liability, if the complainant's patents are valid, and the devices protected thereby are, in substance, incorporated in such detector.

It is, I think, entirely clear, that John Burk was the inventor of the detector for which the patent was granted to the complainant, as his assignee. No one of the prior devices mentioned in the proofs contains a combination of spring points to be operated upon by a series of keys, (susceptible of numerous combinations,) with a watch-movement, all in one case carried by the watchman, and, by successive punctures, indicating the particular key, and, thereby, the station at which it was made. Still less is it true, that any prior device

was constructed in the same manner, or by the use of mechanical equivalents. Most of the detectors were stationary, and operated in an entirely different manner.

Biram's tell-tale was operated by the pressure of the hand of the person desiring to register his presence, on a pin or button exterior to the instrument. He could make that record wherever the instrument might be, and nothing in the record indicated the visit of the watchman to more than the single station where it was. He could make as many records as he saw fit, without at any time moving from the one place.

Rowbotham's device was simply to print upon a revolving paper, within the case of the watch, the impression of various type keys, or stamps, dipped in colored ink from a reservoir in the watch case. The differing form of the keys or stamps at the successive stations may have been useful in disclosing the time and place where the marks were made, and so disclosing the fact and the time of the visit to each station. This may have been more or less efficient in accomplishing the purpose of a detector, but, as a machine or mechanical structure, it was not like the plaintiff's. Making a prior device which will serve the like useful purpose, is not necessarily anticipating an invention. Where the mechanical means employed are different, and the mechanical result is different, one does not anticipate the other. If this were not so, an inventor who had made a machine which would serve a useful purpose would exclude all others from the right to a patent for other mechanical devices or combinations producing the like useful result in other modes, or producing a different mechanical result which served the same purpose.

This is also true of a device shown in the evidence as described in the German publication called "The Polytechnisches Central Blatt, for 1855." There is much obscurity in the description there given, and it is at least doubtful whether it is sufficiently clear or specific to enable a skilful mechanic to construct the instrument by that mere description. Probably, by the use of inventive skill, he might contrive auxiliary devices supplying the omissions, so that the instrument could

Buerk v. Valentine.

be operated ; but, whether, when completed, the instrument would be the same, in respect of those devices, as the machine of which such imperfect description is given, is, at least, very doubtful. If, however, he should succeed, the instrument would, in mechanical construction and operation, be unlike the complainant's detector. It would have but one marker. That marker must be moved from its ordinary position, at each station visited. For this purpose, it requires as many key-holes as there are stations, the key at each station operating upon it in a different manner. The number of keys which it would be possible to apply to the marker must, of necessity, be very few, and, of consequence, the number of stations at which it could be used must be small. It has no capacity, by combination of marks or punctures, to furnish a record at many stations, either by one key at each, or through the same key-hole. The minutes of the Leipsic Association, in 1864, not only recognize the invention of John Burk, but they are subsequent to his foreign patent, and subsequent to the original patent of 1861, granted to the present complainant. In that view, it is not necessary to decide whether, in fact, it was such a publication as would, in any event, impair the validity of a patent issued in this country after its date.

I do not deem it necessary to decide how far the invention described in the patent granted to the complainant in June, 1865, (in which the circular paper dial is substituted for the paper strip described by John Burk,) was anticipated by the invention of John Burk. Some of the testimony seems to indicate that the substitution of the revolving disk for the drum, and the circular dial for the strip of paper around the drum, together with the adaptation of the spring points by an arrangement which made the perforations of the paper disk practicable, were but a substitution of merely equivalent devices. I certainly cannot express any concurrence in that view of the two patents. But, for the purposes of this case, it is enough to say, that, if such changes were the mere use of equivalents, then the re-issued patent of 1870 embraces both forms or modes of construction, and the defendant is in no

Buerk v. Valentine.

wise aided. The question of infringement will still be—Does the defendant's detector infringe either? Nor can I regard that as seriously questionable. He employs every substantial device in the detector as now made by the complainant, and described in his patent of June 6th, 1865, above recited, save only, that he places the springs in the lid of the box or case, perforating therewith downward, instead of placing them under the plate or frame supporting the watch movement, and perforating therewith upward, thereby dispensing with the special form of what is called the fixed index, but for which, as an index serving to point to the hour at which the revolving dial should be set, he substitutes the mark of an arrow at the same point. Whether this change in the location of the springs is or is not an improvement, it is no part of my duty to say. There is some evidence that it is, because there is no opportunity for the entrance of dust, through the key-hole, to the works of the watch. On the other hand, the partition, in the specimen of the complainant's detector produced in evidence, entirely separates the complainant's springs and the key-hole leading thereto, from the watch movement, so that no dust can enter, and obviates the supposed disadvantage. Be that as it may, the mechanical construction is the same, in all that constitutes the principle or mode of operation of the instrument, and gives it efficiency as a record of the watchman's visits to the several stations. It violates, in terms, the second claim of the re-issued patent of 1870; and, if the paper dial and the revolving disk are equivalents of the drum and strip of paper around its periphery, then it violates the first claim of that patent. It also violates the first claim of the complainant's patent of June 6th, 1865. Reversing its position, so that the points perforate downward, instead of upward, cannot avoid that claim, notwithstanding, by so doing, the defendant is able to substitute the mark of an arrow for the stationary index in the complainant's instrument.

As already remarked, the minor specific differences in the means by which the paper dial is held upon the revolving

Buerk v. Valentine.

disk, and the like, do not affect the substance of the inventions. If they are improvements, the defendant is at liberty to use them, if he obtains a license from the complainant to use his invention.

I am, also, of opinion, that the error testified to have been a mistake, by which the original patent of 1861 was granted for fourteen years from that date, cannot affect the complainant's rights under his re-issued patent of 1870, whereby that mistake was corrected. Independent of the question, whether the re-issued patent can be thus collaterally impeached, I think it sufficiently appears that the error was a proper one to be corrected by a re-issue; and, if so, then the complainant's rights are not other than those of any inventor whose first patent is void for mistake or error, which is corrected by a re-issue. He cannot recover for alleged infringements prior to the re-issue, but may for subsequent infringements. Nor, in such case, will the notoriety or use of the patented invention, after his first application, and prior to the re-issue, render such re-issue void, although the original patent issued on such application was wholly invalid. If I was brought, however, to the conclusion, that the complainant could not sustain the re-issue, on the ground last referred to, it would still remain true, that the defendant's detector infringes the first claim of the patent of June 6th, 1865.

The complainant is entitled to a decree awarding an injunction and account, as prayed in his bill.

J. Van Santvoord, for the plaintiff.

C. W. Smith and *N. B. Smith*, for the defendant.

THE RUBBER TIP PENCIL COMPANY

vs.

SAMUEL E. HOWARD AND OTHERS. IN EQUITY.

The letters patent granted to J. B. Blair, July 23d, 1867, for a rubber head for lead pencils, the claim of which is, "An elastic, erasive pencil head, made substantially in manner as described," are void.

The claim is one to a piece of india-rubber with a hole in it, and is invalid, for want of invention.

(Before BENEDICT, J., Southern District of New York, March 19th, 1872.)

BENEDICT, J. This action is founded upon a patent for a rubber head for lead pencils, issued to J. B. Blair, July 23d, 1867, and numbered 66,938. The novelty of the invention and the validity of the patent are put in issue.

The proper construction of the patent is the question first presented. The specification states the invention to be "a new and useful cap or rubber head, to be applied to lead pencils, &c., for the purpose of rubbing out pencil marks." It then describes it as follows: "The nature of my invention is to be found in a new and useful or improved rubber or erasing head for lead pencils, &c., and consists in making the said head of any convenient external form, and forming a socket longitudinally in the same, to receive one end of a lead pencil, or a tenon extending from it. The said head may have a flat top surface, or its top may be of a semi-circular or conical shape, or any other that may be desirable. Within one end of the said head, I form a cylindrical or other proper cavity. This socket I usually make about two-thirds through the head, and axially thereof; but, if desirable, the socket or bore may extend entirely through the said head. The diameter of the socket should be a very little smaller than that of the pencil

The Rubber Tip Pencil Company v. Howard.

to be inserted in it. The elastic erasive head so made is to fit upon a lead pencil at or near one end thereof, and to be made so as to surround the part on which it is to be placed, and to be held thereon by the inherent elasticity of the material of which the head may be composed. The head is to be composed of india-rubber, or india-rubber and some other material which will increase the erasive properties of the head, such as powdered emery, for instance." The article is further described by drawings, which, the specification states, "exhibit the elastic head, so made as to cover the end, as well as to extend around the cylinder sides of the pencil; but it is evident that the contour of the said head may be varied to suit the fancy or the taste of an artist or other person; and I do not limit my invention to the precise forms shown in the drawings, as it may have such, or any other convenient form for the purpose, so long as it is made so as to encompass the pencil, and present an erasive surface about the sides of the same." The specification further states, that "the elastic or rubber pencil head, made as above set forth, may be applied not only to lead pencils, but to ink erasers, and other articles of like character." The claim is, for "an elastic erasive pencil head, made substantially in manner as described."

In considering the effect of this language, it is to be noticed, that the invention is not stated to be a combination, but a single article of manufacture, namely, "an elastic erasive pencil head." The peculiarity in this article, by reason of which the inventor supposes himself entitled to secure it as his own, is not stated to consist in its elasticity. That is a quality of the material to be used, which is india-rubber. Nor does it consist in its erasive capacity. That, also, is solely due to the material out of which the article is manufactured. An effort has been made to show that the erasive capacity of the Blair head is increased by means of certain swells or projections on the sides of the head, which are portrayed in the drawings, and supposed to be indicated, in the specification, as a feature of the invention claimed. But I find no language

The Rubber Tip Pencil Company v. Howard.

which can fairly be said to convey the idea that such swells or projections form a part of the invention. On the contrary, the description states that the heads may be of any convenient external form, and expressly declares, that the invention is not limited to the precise forms shown in the drawings, but may have any convenient form, "so long as it is made so as to encompass the pencil, and present an erasive surface about the sides of the same." The phrase last quoted from the specification discloses what is the real and only feature of the article in question, upon which the right to it is based; and this characteristic is one of form, but not of what is called, in the specification, external form. The characteristic form which the inventor claims to have invented, is, broadly, any form which will enable the rubber to encompass a pencil, ink eraser, or other articles of like character. The additional words, "and present an erasive surface about the sides of the same," add nothing to the description, as it is impossible to have a piece of rubber encompass a pencil, ink eraser, or other article of similar character, without presenting an erasive surface about the sides of the same. - From this form which the inventor gives to a piece of rubber—otherwise, to be of any convenient form—and from this form alone, does, his article derive its value, as distinguished from rubber in any other form. By means of this form, any person is enabled easily to attach the rubber to a pencil, ink eraser, or other article of similar character; and the only useful result attained by the invention in question is, that the head can be so easily attached to any pencil. Now, what is it that accomplishes the useful result attained by the Blair pencil head? Simply, the hole made in the rubber. There must be a piece of rubber, with a cavity in it, to constitute such a pencil head as Blair's specification describes; and there need be nothing more. The cavity may be round, square, or any other shape. It may go through, or partly through, the piece of rubber; and it may be of all sizes. The article sought to be secured by this patent, briefly, and yet, as I think, fully described, consists, therefore, of a piece of india-rubber, with a hole in it. I am

The Rubber Tip Pencil Company v. Howard.

unable to fix any other limitation to the invention, by any fair use of the language employed in the specification and claim. Such an article cannot be the subject of a patent. The elastic and erasive properties of india-rubber were known to all, and gave to that substance the name by which it is generally designated; and how to make a piece of rubber encompass and adhere to another article, was known to every person who had ever seen a rubber shoe. No person knowing of the elastic quality of rubber, could be wanting in the knowledge, that a piece of rubber could be made to encompass and adhere to a pencil, ink eraser, or other article of similar character, by making a hole in it, nor could any one be deficient in the skill requisite to make such a hole.

I am of the opinion, therefore, that the patent in question cannot be upheld, for want of invention. This conviction, which I have been unable to escape, renders it unnecessary for me to express any opinion upon the question of abandonment, so largely discussed at the hearing, or to determine whether the patent in question is for the same invention described by Joshua Gray, in his application for a patent, and by others, who have been relied on by the defence, as showing prior invention.

A decree must be entered dismissing the bill, with costs.

John S. Washburn, for the plaintiffs.

Frederic H. Betts, for the defendants.

NATHAN A. BALDWIN AND OTHERS

vs.

JOSEPH SCHULTZ AND LEOPOLD HECHT. IN EQUITY.

The reissued letters patent granted to the Modena Hat Company, as assignees of Henry Loewenberg, the inventor, April 30th, 1867, for an "improved fabric for hats, bonnets, &c.," on the surrender of original letters patent granted to said Loewenberg, February 28th, 1865, the claim of such reissue being, "The new compound fabric, hereinbefore described, having substantially a foundation of interlaced threads, and a surface composed of fibrous material, stiffened by gelatinous matter, and consolidated by pressure," are not infringed by the use, as a fabric, of muslin, having interlaced threads, but no surface of fibrous material, either as part of the fabric or artificially applied.

The letters patent granted to John L. Kendall and R. H. Trested, February 9th, 1869, for an "improved compound for coating textile fabrics for manufacture of hats and bonnets," the claim of such patent being for a compound composed of white French zinc, or its equivalent, or lead, ground in a colorless and inodorous oil, such as castor oil, and collodion, made by dissolving in ether gun cotton saturated with alcohol, are not infringed by the use of a compound not containing oil or collodion, but containing zinc white, starch, glue, glycerine, and damar.

In the claim of the letters patent granted to S. A. Blake, December 24th, 1861, for an "improvement in bonnets," namely, "A bonnet, cap, or other head covering, the body of which is made of two or more thicknesses of muslin, or other suitable fabric, shaped or formed with a series of raised or embossed stripes, in imitation of straw, or other braid, by means of suitable dies, in the manner herein set forth," the word "body" means a part of the bonnet which does not include the tip or crown-piece of the bonnet, and means that part of the bonnet to which the tip is united, in the finished bonnet.

According to the description of the Blake patent, the product of the action of the dies is the completed body of a bonnet, embossed in imitation of straw, and fit for use as the body of a bonnet, in the shape given to it by the dies, and without further ornamenting or covering its surface, and is not merely a frame, or carcass, or skeleton, requiring to be afterwards covered or ornamented, to make its exterior surface so comely and presentable as to be salable as a bonnet, and is not merely a fabric having the completed exterior surface necessary in the bonnet salable as such, but not shaped into its

Baldwin v. Schultz.

ultimate shape by dies, and requiring further manipulation to put it into such ultimate shape.

The proper construction of the claim of that patent is, that it claims a bonnet the body of which is embossed in imitation of straw or other braid, by dies, which, at the same time, give to it its ultimate shape, such body being made of two or more thicknesses of muslin or other suitable fabric, united by starch or other suitable adhesive and stiffening substance.

The article produced according to the Blake invention is new and useful, an improvement in the trade, and patentable.

It is an infringement of the Blake patent to make a bonnet of three thicknesses of muslin, united by starch, and shaped by dies, which, at the same time, emboss it in imitation of straw braid, although a coating is put on the muslin-frame before it is subjected to the final action of the dies.

A hat may infringe the Blake patent, and yet be seamless throughout.

The essence of the invention of Blake being, that the product of the action of the dies to which the thing is last subjected, is the completed body of the bonnet, embossed in imitation of straw, and shaped and ready for practical use, as the body of a bonnet, without further covering or ornamentation, the patent is infringed if the last embossing die gives the ultimate shape to the bonnet, although such dies may be of the same shape as a die to whose shaping action the bonnet has been previously subjected.

In a suit in equity, it is irregular to swear a person to an affidavit entitled in the suit, before the bill has been filed.

The question of withholding an injunction, if the defendant will take a license, considered.

(Before BLATCHFORD, J., Southern District of New York, September 26th, 1871, March 30th, 1872, and April 22d, 1872.)

BLATCHFORD, J. This suit is brought on three letters patent: (1.) A patent granted to S. A. Blake, December 24th, 1861, for an "improvement in bonnets;" (2.) A reissued patent granted to the Modena Hat Company, as assignees of Henry Loewenberg, the inventor, April 30th, 1867, for an "improved fabric for hats, bonnets, &c.," on the surrender of an original patent granted to Loewenberg, February 28th, 1865; (3.) A patent granted to John L. Kendall and R. H. Trested, February 9th, 1869, for an "improved compound for coating textile fabrics for manufacture of hats and bonnets."

The defendants are manufacturing and selling stamped hats, made in imitation of straw braid. Such hats are made by the following process: The frame is made of three-ply

buckram, that is, three thicknesses of muslin, united by starch, formed into the shape of a hat by the use of smooth, heated dies of the desired shape. The frame thus formed is then coated with a compound, made of two parts of zinc white and one part of boiled starch, to which is added a mixture of glue and glycerine, (consisting of twenty parts of dissolved glue to one part of glycerine), equal to one-half of the quantity of starch used. After these ingredients have been thoroughly mixed together, there is added one one-hundredth part of damar, which has been previously dissolved in benzine. The whole mixture is then passed through a paint mill, and is then applied with a brush to the outside of the buckram hat frame. Two coats of the compound are thus applied, and, before the second coat has become dry, a small quantity of powdered soapstone is shaken through a sieve over the outer surface of the compound. After the hat has become dry, it is subjected to the pressure of two cold dies, which are of the same shape as the hat, except that the lower die, or female die, which comes in contact with the outer surface of the hat, is engraved in imitation of straw braid. The male die, or upper die, is smooth. The hat, with the compound upon it, is placed in the engraved female die, and a square piece of india rubber, large enough to cover the whole inner surface of the hat, and to come out beyond the brim of the hat, is laid over the inner surface of the hat. The upper, or smooth, die is then brought down with great force on the india rubber, which regulates the pressure, and makes it uniform over the entire surface of the hat. By this means, the surface which has upon it the compound, is pressed into the engraving of the female die, and takes and retains the counter shape of the female die. It is claimed, that the defendants, in making and selling hats made by the process thus described, infringe the three patents referred to.

The reissued patent of 1867 to the Modena Hat Company claims, "the new compound fabric, hereinbefore described, having substantially a foundation of interlaced threads, and a surface composed of fibrous material, stiffened by gelatinous

matter, and consolidated by pressure." The specification indicates cotton flannel as a material consisting of interlaced threads covered with a fibrous material. To stiffen such material by gelatinous matter, it suggests saturating it with the glutinous solution in water of soluble glass, and drying the saturated cloth. To consolidate the material by pressure, it suggests the action on it of a die or dies placed in a suitable press. The foundation of interlaced threads is described as giving strength to the fabric. The saturated fibrous material is described as forming a pulpy layer capable of receiving and retaining a highly embossed surface. It is manifest that the defendants do not infringe this patent. Although they use muslin, which has interlaced threads, yet their fabric has no surface of fibrous material. They do not use cotton flannel, nor do they put upon their muslin an artificial surface of flock or ground cotton.

The patent of 1869, to Kendall and Trested, describes and claims, as their invention, a compound to be applied as a facing or coating to buckram frames, and similar textile fabrics, and to paper. The ingredients of this compound are stated to be, white French zinc, or its equivalent, or lead, ground in a colorless and inodorous oil, such as castor oil, and collodion, made by dissolving in ether gun cotton saturated with alcohol. The mixture forms a thin white paste, and its merit is described as consisting in the fact, that, when applied with a brush as a coating, it dries almost instantly, has a soft, polished surface, is pliable, can be struck up by dies without injuring the surface, and is water-proof. The defendants do not use this compound. Their compound contains no oil and no collodion. The patentees add to zinc white, oil and collodion. The defendants add to zinc white, starch, glue, glycerine, and damar. In using this compound, the defendants do not infringe the Kendall and Trested patent.

The serious contest in this case is as to the Blake patent. The specification of that patent says: "This invention consists in a bonnet, cap, or other head covering, the body of which is made of two or more thicknesses of muslin or other

Baldwin v. Schultz.

suitable fabric, united by some adhesive and stiffening substance, and shaped and formed into a series of raised stripes, by means of suitable dies, in such a manner that the sewing together of said stripes is obviated, and that such bonnet, cap or head covering is a perfect imitation of the ordinary bonnets or caps made by sewing together a large number of narrow braids of straw or embossed stripes of muslin. * * *

In order to form a bonnet, I make a sheet, by uniting two pieces of muslin or other material, by means of starch or other suitable adhesive material. I prefer rice starch for this purpose, as it makes a good stiffening. I then cut from this sheet a single piece, or two pieces, of proper shape to form the bonnet and tip, and, after dampening them and putting them as nearly as practicable into form over a suitable mould or former, I subject them to the action of suitable dies, which may be inserted into a press such as represented in figure 4. The female die is provided on its inner surface with a number of creases or grooves formed according to the stripes to be produced on the bonnet. The male die is perfectly smooth on its upper surface, and it is covered with a layer of paper, mill board, or other suitable material, which, when exposed to the pressure of the female die, will readily adapt itself to the inner surface of said die, the whole being arranged similar to the machinery generally used for embossing paper, leather, etc. The blank is now placed upon the male die, and the female die is brought down by means of a screw, so that the fabric assumes the shape of the male die, and at the same time the desired stripes are embossed on its surface. When taken from the press, the surface of the fabric presents a series of stripes, *a*, such as represented in figures 2 and 3 of the drawing, resembling closely the stripes or braids from which ordinary straw bonnets are made. In forming a bonnet, cap or other head dress by this process, it is indispensable that the blank, which is to form the body of the bonnet or other head covering, is cut open on one side, in order to place it on the die in such a manner that all its parts are exposed to the action of the dies. The tip, which may be pressed or em-

bossed separately from the body of the bonnet, or simultaneously with it, is cut out and inserted after the ends of the body have been joined. The embossing itself gives to the muslin or other fabric the required stiffness, and a bonnet made according to my invention is superior in lightness, and in its graceful look, to bonnets made according to the ordinary method, and, furthermore, much time is saved, since the sewing together of the several stripes is obviated. It is obvious, that, by changing the form of the dies, bonnets of different shapes, or caps, or other head coverings, can be made in a manner similar to the one above specified. I do not claim as my invention the within described manner of embossing muslin, substantially the same method having been practised long ago; but, having thus fully described my invention, what I claim as new and desire to secure by letters patent, is: A bonnet, cap, or other head covering, the body of which is made of two or more thicknesses of muslin or other suitable fabric, shaped or formed with a series of raised or embossed stripes, in imitation of straw or other braid, by means of suitable dies, in the manner herein set forth."

The first question is as to the proper construction of the claim of the Blake patent. It is to be observed, that Blake puts no coating or covering upon the exterior surface of the fabric of his head covering. The stripes are embossed directly upon one of the thicknesses of muslin. It is also to be noted, that the specification of the patent draws a distinction between the body of the bonnet and the tip or crown-piece of the bonnet. According to the language used in the specification, the body and the tip, taken together, form the bonnet. The sheet, made of two or more thicknesses of muslin, united to each other by a suitable adhesive material, is the sheet from which the body and the tip are cut, either in a single piece or in two pieces. The claim is to a bonnet, in which the body thereof is made of two or more thicknesses of fabric shaped or formed with a series of raised or embossed stripes, in imitation of straw or other braid, by means of suitable dies, in the manner set forth. The word "body," in the

claim, must be construed to mean a part of the bonnet which does not include the tip, and to mean that part of the bonnet to which the tip is united in the finished bonnet. It is the "body" which is to be made of two or more thicknesses of muslin or other suitable fabric, and it is the "body" which is to be shaped or formed with a series of raised or embossed stripes, in imitation of straw or other braid, and it is the "body" which is to be so shaped or formed by means of suitable dies, in the manner set forth in the specification.

The defendants have put in evidence six prior patents, as affecting the Blake patent, to show the state of the art, as bearing on the question of the construction of the specification of that patent, and to be used to attack the novelty of Blake's invention, and to aid in determining the question of the infringement of that patent. The date of Blake's invention is shown to be the very end of the year 1859. The six patents referred to are as follows: (1.) English patent to Alexander Daninos, dated February 4th, 1829, specification enrolled August 4th, 1829, for an invention "for the manufacture of improved hats and bonnets in imitation of Leghorn straw hats and bonnets;" (2.) English patent to Richard Archibald Brooman, dated April 11th, 1854, specification enrolled October 9th, 1854, for an invention "for improvements in the manufacture of hats;" (3.) Letters patent of the United States, granted to William Osborn, August 19th, 1856, for an "improvement in machinery for pressing bonnets and bonnet frames;" (4.) English patent to Gustavus Palmer Harding, dated July 14th, 1857, specification enrolled January 14th, 1858, for an invention "for improvements in the manufacture of hats, caps and other coverings for the head;" (5.) French patent to Roger and Ledion, granted September 15th, 1859, for the inventions described in the English letters patent to Marc Antoine François Mennons, next mentioned; (6.) English patent to Marc Antoine François Mennons, dated November 13th, 1860, specification enrolled May 8th, 1861, for an invention "for an improved manufacture for coverings

for the head," being a communication from Gustave Victor Roger, a resident of France.

The Daninos patent employs two or three thicknesses of woven material, glued or cemented together, and treated by a water-proof composition. The hat is made of three pieces, the brim or rim being one piece, the sides another piece, and the top or crown another piece. Each piece is embossed or figured with an imitation of the plaiting and sewing seen on the surface of a real Leghorn straw hat. The brim or rim is embossed on both sides, an engraved plate being used for each side, and the embossing being done simultaneously by the two plates. The piece for the sides is embossed by being passed between a brass roller engraved with the design and a hard-wood roller covered with pasteboard. The piece for the crown is embossed by a brass plate. The top of the sides is glued or cemented to a rim which is turned up at the outer circumference of the crown, and the sides are also cemented or glued to a rim turned up on the brim. The characteristic distinction between a hat made according to the Daninos patent and the hat claimed in the Blake patent is, that the body of the Daninos hat is not formed or shaped with embossed stripes by means of dies. The dies which act in conjunction with each other to emboss the body of the Blake hat, give it its ultimate shape at the same time that it is embossed—the shape which it has as the body of the completed hat in the completed hat.

The Brooman patent describes a water-proof hat made of two thicknesses of felt cloth, with a sheet of gutta percha between them, formed into a hat by pressure in a mould, while the gutta percha is in a plastic state. The hat is not embossed in imitation of straw or other braid, nor could it be.

The Osborn patent describes a machine to form, by the pressure of two dies, all kinds, shapes and sizes of bonnets and bonnet frames, the dies being heated, and the article being formed by a single impression. It is sufficient to say, that this patent does not describe a hat made of two or more

thicknesses of fabric, nor a hat embossed to imitate straw or other braid.

The Harding patent describes a process of making hats by stamping or pressing them into form between a hollow heated matrix and a hollow heated plunger. The material is described as being "cloth, velvet, plush and other similar materials," dressed with a solution of adhesive material. The specification says, that, "where requisite, a lining may be stamped up with the cloth, at the same operation;" that a water-proof solution or composition may be "used to cause adhesion, when the lining is employed;" and that "it will be readily understood, that any pattern or device capable of being produced by stamping, may be applied to the article to be formed, by engraving or otherwise preparing the matrix and plunger, to produce the effect required." There is not in the Harding patent any suggestion of a hat embossed in imitation of straw or other braid. It is very questionable whether such an embossed imitation could be made on cloth or velvet, or plush, or other similar material, even when dressed as suggested by Harding. The vague suggestion, that any device which is capable of being produced by stamping may be applied to the hat by engraving or otherwise preparing the matrix and plunger, to produce the effect required, is too general and indefinite. The burden of proof is on the defendants, to show the actual prior existence of a bonnet or other head covering answering the description of the claim of the Blake patent; and the Harding patent fails to show this.

The Roger and Ledion patent and the Mennons patent (the latter being subsequent in date to Blake's invention) describe a hat made to imitate straw, by compressing it in an electrotyped mould. A composition is made of collodion, pulverized cotton and castor oil, forming a pasty mass. The mould is obtained by depositing copper on the outer surface of a straw hat, by the electrotpe process. The specification says: "The carcase of the hat or bonnet, formed in the ordinary way, of any convenient tissue, is coated on all sides with the plastic composition above described, and left to dry, after which it is

placed in the electrotyped mould," and operated upon in a press, the inside of the hat being filled with discs of vulcanized caoutchouc, which act as an elastic piston, and force the plastic matter into the interstices of the mould. The strength of the defendants' case is mainly rested on this Roger invention communicated to Mennons. Criticism is made by the plaintiffs on the Roger specification, that it gives no description, suggestion, or hint, that the body or carcase of the hat is to be made of two thicknesses of material, so as to form one compound body, such as is described in the Blake patent; and, that it teaches, that the carcase is to be formed before it is pressed between the embossing mould and the piston, and not that it is to be shaped by such pressure. To show what was understood in the art, at the date of the French patent, September, 1859, by the expression, in the specification of that patent, "the carcase of the hat or bonnet, formed in the ordinary way, of any convenient tissue," the defendants have introduced evidence proving that, as early as 1857, hat or bonnet frames were made of two or more thicknesses of muslin, stuck together by paste, and stamped into the shape of a hat by means of smooth dies, at one operation, the hat or bonnet frame, when completed, being seamless, and consisting of two or more thicknesses of muslin throughout. The frame, thus stamped into the shape of a hat, is the carcase of the hat, formed of a tissue, and must be regarded as being included in the word "carcase," as used in the Roger specification. In regard to shaping the hat, Blake says, in his specification, that he first puts the cut-out pieces as nearly as practicable into form, over a suitable mould or former. They are then shaped by the action of the dies, the fabric assuming the shape of the male or lower die, at the same time that its surface is embossed by the female or upper die. The defendants first form their carcase or frame into the shape of a hat by smooth heated dies. In that condition, it is the carcase of Roger, formed in the ordinary way, known prior to 1859, of two thicknesses of muslin, united by an adhesive and stiffening substance, and stamped into shape by smooth dies, at one operation. The

Baldwin v. Schultz.

defendants then coat the carcase with a compound, as Roger does. They then have two dies of the same shape as the hat, the female or lower die being engraved on its inner surface, the upper or male die being smooth, the hat being placed in the female die, the entire inner surface of the hat being covered by a piece of india-rubber, and the male die, by its pressure against the india-rubber, forcing the coated surface of the hat to take and retain the counter-shape of the engraved inner surface of the female die. In substance, this is the operation performed by Roger, the only difference being, that Roger makes his piston of india-rubber or caoutchouc discs serve the purpose of the defendants' male die and piece of india-rubber combined. But, from the nature of india-rubber, these instrumentalities in the two operations are the equivalents of each other, in their action in connection with the hat frame and the female die or mould, in the process of embossing the fabric. The Roger specification speaks of the composition as being reduced to shape in the mould. So, too, the defendants reduce to shape, in their female die, the compound which has been applied in two coats to the frame. Blake does not reduce any coating to shape, for he has no coating. His embossing is made directly on the surface of the muslin. He dispenses with a coating, and says, in his specification, that "the embossing itself gives to the muslin or other fabric the required stiffness." I am unable, therefore, to perceive that the defendants, in making the hats complained of, have done anything more than they are warranted in doing by the Roger and Ledion patent, assuming, as must be done for the purposes of this case, on the wording of the stipulation entered into by the parties, that that patent antedates Blake's invention.

In view of the Roger invention, as earlier than Blake's invention, the Blake patent, in order to be upheld as a valid patent, must be construed to be limited to a hat in which the embossing is made directly on the muslin, without the intervention of any coating, the required stiffness being given by the embossing itself, without the use of a coating, and the hat being lighter, by reason of the absence of the coating.

Baldwin v. Schultz.

On this construction, the patent is valid, but, as the defendants use a coating, they do not infringe it.

It follows, that the bill must be dismissed, with costs.

Solomon J. Gordon, for the plaintiffs.

Thomas B. Hewitt, for the defendants.

AFTER the foregoing decision was rendered, in September, 1871, the case was re-opened, in certain particulars, and further testimony was taken, and the case was reheard. The following decision was given in March, 1872.

George Gifford and *Solomon J. Gordon*, for the plaintiffs.

George F. Langbein, for the defendants.

BLATCHFORD, J. A decision was rendered, in this cause, in September, 1871, on final hearing, dismissing the bill. That decision proceeded upon the ground, that the defendants had not infringed two of the three patents sued on, namely, the re-issued patent to the Modena Hat Company, of April 30th, 1867, and the patent to John L. Kendall and R. H. Trested, of February 9th, 1869. As to the third patent sued on, that to S. A. Blake, of December 24th, 1861, it was stipulated by the parties, that a French patent, granted to Roger and Ledion, September 15th, 1859, antedated the invention covered by the Blake patent, and the Court held that the defendants, in making the hats complained of, had not done anything more than they were warranted in doing by the description furnished, under such stipulation, as the description contained in the Roger and Ledion patent. The Court also held, that, in view of the Roger and Ledion patent, as earlier, the Blake patent, in order to be upheld as a valid patent, must be construed to be limited to a hat in which the embossing is made directly on the muslin, without

the intervention of any coating, the required stiffness being given by the embossing itself, without the use of a coating, and the hat being lighter by reason of the absence of the coating; but that, on such construction, the defendants did not infringe the patent, as they used a coating.

Before any decree was entered on that decision, it was discovered by the parties, that the description on which they and the Court had acted, as the description contained in the French patent to Roger and Ledion, of September, 1859, was not the description contained in that patent, but was, to a considerable extent, in substance, the description contained in a French patent granted to Roger and Ledion July 19th, 1860. The only patent to Roger and Ledion, set up in the answer as antedating the Blake invention, is that of September, 1859. By consent of the parties, and on the order of the Court, the case was re opened, so far as to admit of the taking of testimony to determine whether or not the hats made by the defendants infringe the Blake patent, in view of the Roger and Ledion French patent of September, 1859, and for further argument on the question of infringement and the proper effect to be given to such French patent, in determining that question. The defendants also had leave to introduce evidence of any additional matter of defence set up in the answer, but not theretofore relied upon and presented to the Court, which they might see fit. Further testimony has been taken and the case has been reheard. The conclusion having been reached, in the former decision, that, in view of what was then understood to have been the Roger and Ledion patent of September, 1859, the bill must be dismissed, there were several matters of defence developed in the proofs, which were not considered or passed upon by the Court, and which are now open for consideration.

The invention of Blake is not carried back to a date earlier than December 31st, 1859. It is shown, on the part of the defendants, that, as early as 1857, hat or bonnet frames were made of two or more thicknesses of muslin, stuck together by paste, and stamped into the shape of a hat, by means of

smooth dies, at one operation, the hat or bonnet frame, when completed, being seamless and consisting of two or more thicknesses of muslin throughout. It is also shown, that, in the spring of the year 1859, hats and bonnets were made out of two-ply and three-ply buckram, (that is, two or three thicknesses of muslin stuck together by starch,) covered with satin, silk or velvet, by means of dies, at one operation, so that, when finished, the hat or bonnet was of one piece, seamless, and consisted of two or three thicknesses of muslin throughout, covered all over with silk, satin or velvet. It is also shown, that it was no new thing, at the date of Blake's invention, to stamp paper, and to stamp such two and three-ply buckram, in imitation of straw braid, to be used in making bonnets, by means of flat engraved plates or dies. It is claimed, on the part of the plaintiffs, that, according to the description in the specification of the Blake patent, the product of the action of the dies is the completed body of a bonnet, embossed in imitation of straw, and fit for use as the body of a bonnet, in the shape given to it by the dies, and without further ornamenting or covering its surface; and that it is not merely a frame, or carcase, or skeleton, requiring to be afterwards covered or ornamented, to make its exterior surface so comely and presentable as to be salable as a bonnet; and, further, that it is not merely a fabric having the completed exterior surface necessary in the bonnet salable as such, but not shaped into its ultimate shape by dies, and requiring further manipulation to put it into such ultimate shape. I think these views of Blake's invention are correct, and that the proper construction of the claim of his patent is, that it claims a bonnet, the body of which is embossed, in imitation of straw or other braid, by dies, which, at the same time, give to it its ultimate shape, such body being made of two or more thicknesses of muslin or other suitable fabric, united by starch or other suitable adhesive and stiffening substance. None of the articles above mentioned as prior inventions anticipate Blake's invention, on this construction of his claim, which is the construction which, in the former decision, I adopted as the

proper one, aside from what was then supposed to be shown by the Roger and Ledion patent of 1859. The article produced according to the Blake invention is new and useful, an improvement in the trade, and patentable.

The hat testified to by Shaw as existing in 1857 is too vaguely deposed to. It is not shown how it was, in fact, made. It is not produced. All that there is is the casual observation of it by a person who calls back his recollection of it fourteen years afterwards, and who says it was made, in one piece, of muslin, with a surface of paper in imitation of Leghorn braid, and that it had the appearance of having been shaped, and put into imitation of Leghorn braid, by the use of engraved dies, at one process. Such evidence cannot be admitted as sufficient to invalidate the Blake patent.

This leaves to be considered only the Roger and Ledion patent of 1859. According to the true text of that patent, now produced, there is no suggestion in it of the making of a bonnet by dies, in imitation of straw braid, out of two or more thicknesses of muslin, united into one fabric by starch or other adhesive and stiffening substance. The patent indicates the mould or die, of proper form, and arranged to produce the imitation of straw on "a fabric of flax or cotton," impregnated with pasty collodion, and speaks of making hats in that way. The patent of Blake makes it an essential point that the bonnet shall be made of two or more thicknesses of fabric, united into a sheet by starch or other suitable adhesive and stiffening material. The importance of using such stiffening material is dwelt on, and the fact that the bonnet, when embossed, has a stiffness of fabric, and, at the same time, a lightness. The evidence shows that there is an advantage, in cheapness of manufacture and in flexibility during manufacture, in using a fabric thus made of two thicknesses, over the use of a single fabric of equal thickness with the two.

The defendants' bonnet is made in the same way as the bonnet of the Blake patent, in all the features of the claim of that patent. It is made of three thicknesses of muslin, united by starch, and is shaped by dies which, at the same time, em-

Baldwin v. Schultz.

boss it in imitation of straw braid. The fact that the defendants put a coating on the muslin frame before subjecting it to the final action of the dies, does not make the product any the less the Blake product? It is shown, that, in the defendants' bonnet, corrugations are formed in the fabric itself, by the dies, though to an extent diminished by the thickness of the coating. Adequate stiffness can be given by embossing directly on the muslin, without any coating. But the required stiffness is given when a coating is used.

There must be a decree for the plaintiffs, for a perpetual injunction and an account of profits, as respects the Blake patent, with costs, with a reference to a master to take the account.*

* On the 22d of April, 1872, a motion for a provisional injunction, on a bill filed by the same plaintiffs against Henry O. Bernard and others, on the patent to S. A. Blake, of December 24th, 1861, (*George Gifford and Solomon J. Gordon*, for the plaintiffs, and *Stephen D. Law and Charles B. Stoughton*, for the defendants,) coming on to be heard, before Judge BLATCHFORD, the defendants moved to dismiss the application, on the ground that the affidavit of one Eicke, relied on to prove a sale by the defendants of the hats alleged to infringe, was sworn to April 6th, but the bill was not filed until April 8th, and the subpoena was not issued until April 12th. The Court said; It is, undoubtedly, irregular to swear a person in a suit before the bill has been filed. The irregularity consists in having the affidavit sworn to under the title of a suit in which no bill has been filed. If the title had been omitted, there would have been no irregularity. This is continually done in applications for habeas corpus and mandamus, and, to swear falsely in such affidavits, is indictable as perjury. The suit is commenced when the bill is filed. Eicke's affidavit ought not to have been entitled in the suit. On this ground, the affidavit of Eicke should be excluded, but I will permit it to be re-sworn. The parties must be considered as having had reasonable notice of it. They have had a copy of it. [The affidavits were then read and arguments made on both sides, after which the following opinion was orally pronounced.] BLATCHFORD, J. If I have correctly understood the counsel for the defendants, I see nothing in this case to distinguish it from the one in which Schultz and Hecht were defendants. I have listened carefully to everything that has been urged, and it has made no impression different from that produced upon my mind in the other case. The counsel for the defendants has entirely misapprehended the scope and effect of the former decision as to the Blake patent. It is very true, that Blake, in his patent, describes that particular sort of hat which required, in order to make it, that there should be an opening cut in it. But that particular form of hat constituted no part of the invention

Baldwin v. Schultz.

of Blake. A hat may infringe the patent and yet be seamless throughout. The essence of the invention, as it appears in the patent, is this—that the product of the action of the dies to which the thing is last subjected, is the completed body of the bonnet, embossed in imitation of straw, and shaped and ready for practical use, as the body of a bonnet, without further covering or ornamentation. Now, this is true of the bonnet of the defendants. It is embossed fit for use, and shaped to the form in which the last dies used in its production leave it. It is of no consequence that other dies may have been used previously to shape it. It is no matter if it had been shaped by fifty dies previously. Bernard, in one of his affidavits, himself says, that the last die used must be of the same shape as the previous one. This constitutes an infringement. This last die is the one that does the embossing. When the embossing is done by dies that have a shape, that shape is given by the embossing dies. Bernard, in his affidavit, says, that it is absolutely indispensable that the embossing dies should have the same shape as the previous dies; and the embossing dies give the ultimate shape, *because* their shape is not altered. In my former decision I said: “It is claimed, on the part of the plaintiffs, that, according to the description in the specification of the Blake patent, the product of the action of the dies is the completed body of a bonnet, embossed in imitation of straw, and fit for use as the body of a bonnet, in the shape given to it by the dies, and without further ornamenting or covering its surface;” and I said, I thought these views of Blake’s invention were correct. The defendants do not afterwards cover their hats, do not afterwards ornament them, do not alter them in any manner. If the brim and top of the hat, as well as the body, are embossed by the dies, it is none the less an infringement. I also said, in that decision, that the proper construction of the claim of Blake’s patent is, “that it claims a bonnet, the body of which is embossed, in imitation of straw or other braid, by dies, which, at the same time, give to it its ultimate shape.” Its *ultimate* shape. It is no matter how many dies have previously given shape to it. It may have been one. It may have been twenty. It makes no difference what number. This last embossing die of the defendants is the one that gives the ultimate shape to the bonnet, because it is of the same shape as the previous die. The defendants say, that there are two operations in the production of their bonnet. This is nothing but trying to evade the patent, by splitting the thing into two—making two operations, where only one was necessary. That will not do. A case very similar to this, in this particular, was lately tried in the District of Connecticut, (*Wallace v. Holmes*, *ante*, p. 65,) in which the patent sued on was for a lamp burner, to be used with a chimney, and so described in the patent. The defendants made and sold the burner; but, because they did not make or sell the chimney with it, they said they did not infringe. But it was held they did, as all the purchaser would have to do would be to buy a glass chimney next door and put it in. So, in this case, there was a purpose of infringing, I should say, in making two operations where only one is necessary. Courts always look with suspicion upon such a transaction. As to the Roger and Ledion patent, if that patent covered this invention, as to one thickness of muslin, it might be a patentable improvement to make the bonnet of two thicknesses. The defendants say, that there is nothing in the fact of there

Baldwin v. Schultz.

being two thicknesses. Why do they not make their bonnets out of one thickness? There must be something in the using of two thicknesses. None of the parties who make the bonnets have used one thickness. The defendants may make as many hats as they please out of one thickness of muslin. In regard to the other suit—the suit against Schultz and Hecht—it is true, that the parties on both sides, in that suit, were satisfied that the hearing should be had upon affidavits. The plaintiffs took the defendants' affidavits. The defendants took the plaintiffs'. The plaintiffs were willing to accept the defendants' affidavits as true, just as they were. The defendants did not care to cross-examine the deponents who made affidavits for the plaintiffs. It is not alleged here, that any one of the witnesses knew anything else that could be brought out. Blake fixed 1860 as the date of his invention, and the defendants do not undertake to show that Blake did not make the invention when he said he did. The defendants say, that, if you take their hat from the first die and put it into their embossing die, you will get no salable hat, but, if you put the coating or putty upon the hat, after using the first die, and then use the embossing die, you will have a salable hat. But, the point is, that they put the putty on, and then emboss the hat. They say, that there is no infringement, because they do not emboss directly upon the muslin. True it is, that, looking on the completed hat, the eye rests simply on the coating or putty, but the corrugations extend into and through the muslin, and show, as is here apparent, on the inside of the hat. This operation has an effect, over and beyond the mere ornamentation. There is a durability and stiffness in the hat made of this fabric. It is very light, yet, at the same time, it has the requisite stiffness. Now, this durability and stiffness and lightness are due to the fact that the hat is made out of two or three thicknesses of muslin, stamped in this way. If these defendants do not make the article out of one thickness of muslin, there must be something in this idea of Blake's, of using two thicknesses. At first blush, one would say that there could not be any difference between a fabric made of one thickness of muslin, and a fabric made of two thicknesses, with paste between them. Yet, these defendants do not use one thickness. They do use two thicknesses. Hats made of one thickness look to me just as good, but the evidence and the conduct of the defendants go to show to me, that they are not, and that there is something in the use of two thicknesses, which makes their employment necessary and useful. As to the coating, the bonnet is none the less an infringement because a coating is put upon it. Putting on this coating or putty may be an improvement—perhaps, it is a useful improvement. But, it is a mere addition. The defendants may have something more than Blake has, but it is none the less apparent that they have what Blake has. The same questions were before me in the Schultz and Hecht case. That case was fully argued. There is nothing which leads me to suppose that their counsel did not defend them to the best of his ability. Every point involved seems to have been presented. Besides, I studied that case thoroughly, and gave more time and attention to it than to almost any other case that has lately come before me. Especially did I thoroughly study it, after its second argument, to make myself familiar with it, in view of the fact, that, after having first given a decision one way, I felt called upon to give

Baldwin v. Schultz.

one the other way. If the defendants in the Schultz and Hecht case would not permit the case to be opened otherwise, there was certainly nothing wrong or fraudulent in making an arrangement to secure such re-opening. If a mistake had been made, it was the duty of the counsel, to himself, his clients and the Court, to get the case re-opened, if possible. If this had not been done it would all have had to come before the Court at another time. If there was any suppression of truth or lack of full consideration, the Court ought to look into it. So, too, if any prior patent should be brought before me, or if any new testimony should be offered, it would be entitled to consideration, just as if the other case had never been heard. But there is nothing of that character. In regard to the suggestion about a license, the defendants knew of this patent, and had notice of the proceedings in the other case. They engaged in this business with their eyes open. They took the risk upon themselves. They asked for a license, but they did not ask for it on the ordinary terms. They wanted to impose conditions upon the licensors. It is undoubtedly true, that, in some cases, and under certain circumstances, I have said, I would not grant an injunction, except on refusal of the defendants to accept a license. I believe such was the fact in the car brake case, the fat acid case, and, if I recollect correctly, in one of the hoop skirt cases; but in all of those cases, the plaintiffs were perfectly open and free to grant licenses to anybody. The more licensees they had, the better it was for them. But that is not the case with these plaintiffs. They undertake to show, in their affidavits, why it would be prejudicial to them for these defendants to have a license. [Mr. Law stated that the defendants do not want a license, such as is offered them, because they cannot honestly live up to its terms.] The conduct of these defendants, in this regard, is certainly very honorable, and I should think they were just such persons as the plaintiffs would desire to be licensees. It does not very clearly appear, I confess, how granting a license would injure these plaintiffs. In Waller's affidavit, it is not very clearly expressed. [Mr. Gordon called attention to the fact, that the plaintiffs are themselves large manufacturers, and that they and their present licensees can supply the market, and that this appears in the bill of complaint, as well as in the affidavits.] I did not observe, that the plaintiffs are themselves manufacturers of the bonnets. They are entitled to the injunction.

Wilkinson v. Pomeroy.

SADIE E. WILKINSON *vs.* MARK M. POMEROY.

A plea, without a conclusion, is no plea.

A plea of the general issue, in an action for breach of promise of marriage, may be treated as a nullity, under Rule 26 of this Court, if not accompanied by the affidavit and the certificate required by that Rule.

A special plea, in such an action, may be treated as a nullity, under Rule 27 of this Court, if not accompanied by the certificate required by that Rule.

Matter pleadable in bar, in such an action, if intended to show that the plaintiff had no subsisting cause of action when the suit was commenced, can be given in evidence under the general issue.

In such an action, evidence of acts of misfeasance, immediately connected with the cause of action, or evidence showing an equitable defence arising out of the cause of action, if admissible at all, can be given in evidence, in mitigation of damages, under a plea of the general issue.

In such an action, matter, in a plea, which attributes to the plaintiff habits, disposition, temper, and acts, in such wise as would warrant an action for libel against whoever should publicly make such charges by printing or writing, is irrelevant, impertinent, and scandalous, and will be stricken out, on motion.

(Before BLATCHFORD, J., Southern District of New York, April 4th, 1872.)

BLATCHFORD, J. This is an action for breach of promise of marriage. The declaration contains two counts. The first count is in the usual form. It alleges the plaintiff to have been, and to be, unmarried, and that the defendant married another person. The second count alleges, that the defendant, being a married man, and having a lawful wife alive, promised to marry the plaintiff, she being unmarried, and believing the defendant to be unmarried.

The defendant has put in, in answer to the declaration, a paper which denominates itself as being "pleas," and which contains four parts.

The first part professes to be an answer to only the first count of the declaration. It is, in substance, a plea of the general issue to such first count, denying any promise to marry by the defendant, and all else in it being surplusage. But it has no conclusion. It does not conclude to the country, nor

does it conclude with a verification. It is, in fact, no plea at all. If regarded as a plea of the general issue, the plaintiff would have a right to treat it as a nullity, under Rule 26, because, being put in in an action on contract, it has not annexed to it, and filed with it, an affidavit of the defendant, that he has a good and substantial defence on the merits, as he is advised by his counsel, and verily believes, together with a certificate of counsel, that he so advised the defendant.

The second part of the paper purports to be, if anything, a special plea to the first count of the declaration. But it purports, on its face, to be equivalent to the general issue, for it concludes to the country. Yet, it calls itself a "further plea." Regarded as a plea of the general issue, the plaintiff would have the right to treat it as a nullity, for the reason above given in respect to the first part. Regarded as a special plea, he would have a right to treat it as a nullity, under Rule 27, as not being accompanied by the certificate of a counsellor of this Court, that, in his opinion, it is well founded. It contains some matter, which, if pleadable at all in bar, is intended to show that the plaintiff had no subsisting cause of action when the suit was commenced. Such matter can be given in evidence under the general issue. The rest of the matter in it is matter not in bar, but matter which, if it could be taken into consideration at all, would be matter only in mitigation of damages. As such, it could, in an action of assumpsit, such as this is, be given in evidence, if admissible at all, under a plea of the general issue, as being evidence of acts of misfeasance, immediately connected with the cause of action, or evidence showing an equitable defence arising out of the cause of action. (*Withers v. Green*, 9 *Howard*, 213; *Van Buren v. Digges*, 11 *Id.*, 461; *Winder v. Caldwell*, 14 *Id.*, 434; *Miller v. Smith*, 1 *Mason*, 437.)

The matter last referred to has, therefore, no proper place in these pleadings. It is open to the further objection, that, being irrelevant and impertinent, it is also scandalous. It attributes to the plaintiff habits, disposition, temper, and acts, in such wise as would warrant an action for libel against

Wilkinson v. Pomeroy.

whoever should publicly make such charges by printing or writing.

The third part of the paper purports to be, if anything, a plea of the general issue to the second count of the declaration; but it has no conclusion, either to the country or with a verification. If regarded as a plea of the general issue, it could have been treated as a nullity, for the reasons before stated in regard to the first part of the paper. It denies any undertaking to marry the plaintiff, and all the rest of it is surplusage.

The fourth part of the paper purports to be, if anything, a special plea to the second count of the declaration, but it concludes to the country, thus claiming to be equivalent to the general issue. It calls itself a "further plea." Regarded either as a plea of the general issue, or as a special plea, it could have been treated as a nullity, for the reasons before stated in regard to the preceding parts of the paper. It is made up of matter of two classes, falling under the descriptions above given of the matter in the second part of the paper, and contains like scandalous allegations in respect to the plaintiff.

There is nothing in the paper which confesses either of the causes of action in the declaration, and then avoids them.

The plaintiff moves that this paper be stricken out as impertinent and scandalous, and that judgment, with costs, for the plaintiff, be given on the pleadings, and for such other rule or order as to the Court may seem meet. The motion is granted, so far as to strike out the paper as a pleading. (*Wilder v. Gayler*, 7 *Blatchf. C. C. R.* 597; *Varnum v. Campbell*, 1 *McLean*, 313.) But the defendant will be allowed, within ten days, to plead the general issue, if he desires, by a plea properly verified and certified under Rule 26, provided he will also accept notice of trial for the present term of the Court, the cause to be put on the calendar for trial thereat.

Benjamin F. Butler and Sidney DeKay, for the plaintiff.

James D. Reymert, for the defendant.

Jenkins v. Johnson.

NATHANIEL JENKINS

vs.

JOHN JOHNSON AND OTHERS. IN EQUITY.

The reissued letters patent granted to Nathaniel Jenkins, August 3d, 1869, for an "improvement in the manufacture of elastic packing," the original patent having been granted to him, as inventor, May 8th, 1866, are valid.

The first claim of that patent, namely, "An elastic packing, composed of at least four-tenths of finely pulverized, refractory, earthy or stony material, intimately mingled with, and held together by, rubber prepared for vulcanizing, and then vulcanized, as and for the purpose described," claims a packing, into the composition of which there enters at least four-tenths of refractory, earthy, stony, or mineral matter, which must go in in a pulverized state, in order to be intimately incorporated with the india-rubber, which serves as a vehicle to hold the powder, the compound being then vulcanized, by subjecting it to heat, in the presence of sulphur, and the result being a packing which is elastic, while it is indestructible by heat.

The letters patent granted to Nathaniel Jenkins, October 6th, 1868, for an "improvement in steam globe-valves," are valid.

The claim of that patent, namely, "The arrangement of the bearing surface, *l*, of the valve-head and the elastic packing held in an annular recess in the valve-head, as described, with the valve-seat, *f'*, and the raised seat, *f*, in the manner as shown and specified," claims the arrangement of an annular chamber or cup, containing an elastic packing, with a raised seat, in connection with the two bearing surfaces outside of the cup and the raised seat, the whole operating in the manner described.

Such invention is not anticipated by a valve consisting of a raised seat, and a metallic receptacle fitting over it; nor by a valve with a raised seat, and a cup, and a packing of lead or tin fused into the cup.

(Before BLATCHFORD, J., Southern District of New York, April 10th, 1872.)

BLATCHFORD, J. This suit is founded on two letters patent granted to the plaintiff. One of them is a re-issued patent, granted August 3d, 1869, for an "improvement in the manufacture of elastic packing," the original patent having been granted to the plaintiff, as inventor, May 8th, 1866.

The other is a patent granted to the plaintiff, as inventor, October 6th, 1868, for an "improvement in steam globe-valves."

The specification of the packing patent describes the invention as one of an "elastic packing for joints and valves exposed to destructive fluids." It says: "The nature of the invention consists, first, in constructing the packing of refractory earths, or earthy and stony matters, mingled with rubber and such other materials as are necessary to vulcanize the rubber, in such quantity that the earthy or stony matter shall be more than four-tenths of the entire compound, and then vulcanized in moulds to the desired shape of the packing; and, second, in the selection of such earthy or stony materials, and proportioning them in the compound. All elastic packing, of indestructible properties, to a valve, joint or aperture through which a destructive fluid is to pass, such as steam of any kind, hot water, kerosene, or other coal-oil, hot or cold, has been unattainable till recently; but, after experiments of more than one year, I claim to have discovered a tight, indestructible, elastic packing, for these purposes. It will be seen, from the following formulas, that a leading feature of the composition is, that it contains large quantities of earthy material, such as French chalk, or talcose matter, a very refractory material; Paris-white, a substance which is decomposed only at a very high temperature, and in presence of air or gases of combustion, or of strong acids, with steam, and is not easily fused; and litharge, which assists in vulcanizing, and does not tend to decompose the other ingredients, at the temperatures to which the composition is exposed. In the selection of the earthy or stony matter, the choice would be governed by facility of pulverization, and unsusceptibility to heating influence. Soapstone is indicated as an ingredient, by the use of French chalk. Paris-white indicates the use of other earthy carbonates. The substance of the invention is, the employment, for a packing, of an earthy powder of refractory quality, intimately mingled with vulcanized rubber, and constituting forty per cent. of the compound. With the follow-

Jenkins v. Johnson.

ing ingredients, the proportions would be within the following limits: pure rubber, from 20 to 25 per cent.; pure gum shellac, from 10 to 20 per cent.; pure Paris white, from 20 to 30 per cent.; pure French chalk, from 15 to 25 per cent.; pure litharge, from 11 to 18 per cent.; pure lamp-black, from 2 to 3 per cent.; pure sulphur, from 1 to 3 per cent. Increase the quantity of rubber when the fluid to be resisted is less penetrating, and increase the quantity of Paris white, French chalk, litharge and shellac, when it is more penetrating. One hundred parts of the above substances, mingled within the per centages given, will be comparatively indestructible, in the presence of coal oil, steam or hot water, and will preserve their elasticity and texture for a long time." A table is then given, of proportions in use, with coal oil, steam and hot water, respectively, of the various ingredients above mentioned, which, it is stated, have given favorable results, and which the patentee states he is inclined to consider the best attainable for their respective purposes. They range, except as to lamp-black, which goes up to $3\frac{1}{4}$ per cent., within the limits before stated. The specification continues: "I do not, however, confine myself to these exact proportions, but consider the composition most accurately stated by the limitations given before. The ingredients, other than the rubber, are to be finely powdered and intimately mixed together. They are then to be spread on the surface of the rubber, and rolled with it, between cold rollers, until they are thoroughly incorporated with the substance of the rubber. The mass is then to be moulded in iron moulds, of proper shape, and subjected to a high vulcanizing heat, say that due to a steam pressure of 60 to 75 pounds, or, if desired to be very hard, even more, for from 20 to 45 minutes." The claims are as follows: "1. An elastic packing, composed of at least four-tenths of finely pulverized refractory, earthy or stony material, intimately mingled with, and held together by, rubber prepared for vulcanizing, and then vulcanized, as and for the purpose described. 2. The composition of the ingredients, and within the proportions above set forth, substantially as and for the

purpose described. 3. The employment of French chalk, or equivalent talcose mineral, substantially in the manner and for the purpose described."

"Refractory" is thus defined: "Noting earths or metals that are infusible, or require an extraordinary degree of heat to fuse them." "Earth," in chemistry, is "a metallic oxide, inodorous, dry, unflammable, and infusible;" and, among the chemical earths, are silica and magnesia. A metallic oxide is composed of oxygen and a metal, as a base. A "stone" is "earthy or mineral matter condensed into a hard state." A "mineral" is defined as "a natural body, destitute of organization or life—a substance found in or on the earth, which is neither animal nor vegetable." "French chalk" is "steatite or soapstone—a soft magnesian mineral." Soapstone is composed chiefly of silica and magnesia. "Steatite" is defined as "a variety of talc—soapstone." "Talc" is defined as "a mineral," and is composed chiefly of silica, magnesia and water. Litharge is an oxide of lead.

The answers set up want of novelty and want of patentability and non-infringement, as a defence to the packing patent, but there is no specification of any prior invention.

There can be no doubt, on the proofs, that a packing compounded and prepared like the plaintiff's packing, and possessing its characteristics, did not exist before his invention. It is highly useful, supplied a great need, and has displaced previous packings, where resistance to destructive fluids is required.

The proper construction of the first claim of the patent is, that it claims a packing, into the composition of which there enters at least four-tenths of refractory, earthy, stony or mineral matter, which must go in in a pulverized state, in order to be intimately incorporated with the caoutchouc or India rubber, which serves as a vehicle to hold the powder, the compound being then vulcanized by subjecting it to heat in the presence of sulphur, and the result being a packing which is elastic while it is indestructible by heat. In the product, the India rubber and the sulphur are chemically combined,

forming vulcanized India rubber, but the substances which, in the completed product, give to it its refractory character, are not chemically combined with the vulcanized India rubber, but act mechanically. The refractoriness of the product is due to the non-elastic refractory substances in it, while its elasticity is due to the non-refractory vulcanized India rubber. It was necessary that the packing, to serve all the ends of a packing, should be both refractory and elastic. It might thoroughly resist heat, yet, if it were not elastic, so as, by its resilience, under pressure, to tightly close all orifices which ought to be closed, it would not fulfil the purposes of a packing; and it might act for a short time as a practical elastic packing, and yet soon be destroyed by heat, if not so refractory as to resist the effects of heat for a long time. But the patentee discovered that a compound fulfilling the conditions of that claimed in his first claim would be comparatively indestructible in the presence of coal-oil, steam and hot water, and would preserve its elasticity and texture for a long time.

The packing of the defendants is an elastic packing, constructed of refractory earths, mingled with India rubber and sulphur, and then vulcanized. It has the indestructible properties of the plaintiff's packing. It contains large quantities of soapstone. Its earthy refractory matter constitutes forty per cent., at least, of the compound. The soapstone is in the proportion of from fifteen to twenty-five per cent. The ingredients found in the defendants' packing, by analysis, are India rubber, sulphur, the oxides of lead and iron, and soapstone. The proportion of India rubber and the proportion of sulphur to the whole mass exceed, each of them, the highest per centage given in the specification for those articles respectively. But it is shown that the excess of sulphur beyond the amount taken up by the India rubber for vulcanization unites with the iron and lead and forms refractory mineral matter, and that such refractory mineral matter and the soapstone together are at least forty per cent. of the whole compound. This refractory forty per cent. acts mechanically, to resist heat, after the sulphur has united with the iron and

lead, and is cemented together by the vulcanized India rubber, which gives to the whole mass the necessary elasticity. The packing is substantially the same as the plaintiff's packing, as regards its mechanical application and operation in use, and its adaptation to the end desired. It results, therefore, that the defendants have infringed the first claim of the patent.

Regarding the third claim as a claim to the employment of French chalk or equivalent talcose material, in the range of proportions named in the specification, in the compound covered by the first claim, the defendants have infringed the third claim also. This construction of the third claim is the one contended for by the defendants. Whether the third claim is susceptible of a broader construction, it is not necessary to decide in this case.

The specification of the valve patent says: "The invention is of that class of globe valves in which an elastic or semi-elastic packing is employed for sealing the joint of the valve, the object of this invention being to provide more perfect security, or additional means of security, against clandestine escape of the steam or water about the joint of the valve, when closed, the same construction which accomplishes this also producing a durable or lasting valve. The invention consists in a peculiar construction or arrangement of parts, and the combination therewith of an elastic or semi-elastic annulus or packing, the arrangement of parts being such, that, in the event of the destruction or weakening of the elastic packing, the metallic portions of the joint shall come in contact, and operate to effect a tight union of the same." The structure is then described. It is a globe valve, having a chamber, an inlet, an outlet, a stem, a stopper or valve, on the bottom of the stem, and a raised seat or annular ledge, *f*, raised some distance above the surrounding metal, *f'*. The stopper or valve is composed of a metallic head, pivoted to the lower end of the stem, in any suitable manner, such head being formed, upon its under side, with an annular chamber, for the reception of an annulus or packing of elastic or semi-

elastic India rubber, or other suitable material or compound, such packing being retained in place, in its chamber, by a nut screwed upon the shank of the head, and partially overlapping it, the packing extending a short distance below or beyond the annular lid, or circumscribing circumference, or bearing surface, *l*, of the head. The stem runs through a stuffing box. On lowering the stopper or valve, in the act of closing the valve-opening or passage below, the packing is pressed tightly on the annular raised seat, *f*, which, by such pressure, is forced somewhat into the packing, and a tight joint between the valve and the seat is secured. From long usage, or from being subjected to the action of great heat, the packing may become enlarged or distended. Should this take place, it will, upon the descent of the valve, become enclosed between the annular end or face, *l*, of the valve-head, and the surface, *f*, immediately surrounding the valve-seat, *f*, and, by this means, form a secondary or additional means of closing the valve-opening against the passage of steam or water. Should the packing, in extreme cases, become wholly or partially destroyed, and unfit to perform its functions, the two metallic surfaces *l* and *f* will be brought tightly in contact, and, in themselves, form a close joint, thus creating an additional and third means or resource for effecting the desired object. The claim is this: "The arrangement of the bearing surface, *l*, of the valve-head, and the elastic packing held in an annular recess in the valve-head, as described, with the valve seat, *f*, and the raised seat, *f*, in the manner as shown and specified."

The defence in regard to this patent is non-infringement, and that the defendant Johnson was the prior inventor of the improvement covered by the patent, and that the valves made and sold by the defendants are such as are described in letters patent granted to the defendant Johnson, August 15th, 1865, for an improvement in steam-valves.

The proper construction of the claim of the patent, in view of the state of the art at the time of the plaintiff's invention, is, that it claims the arrangement of an annular chamber or cup, containing an elastic packing, with a raised seat, in con-

Jenkins v. Johnson.

nection with the two bearing surfaces outside of the cup and the raised seat, the whole operating in the manner described. The valve patented to Johnson in August, 1865, consisting of a raised seat and a metallic receptacle fitting over it, does not anticipate the invention. Nor does a valve with a raised seat, and a cup, and a packing of lead or tin fused into the cup. The elastic packing is an essential element in the arrangement. The full utility of the raised seat and the cup, and of the two bearing parts outside of them, is not developed until an elastic packing is used. The use of the elastic packing is not the mere substitution, in respect of the arrangement covered by the claim, of one packing for another equivalent packing. The use of an elastic packing is necessary to fully utilize the form of valve, and the form of valve is necessary to develop all the merits of such elastic packing as the specification of the plaintiff's patent speaks of—packing which becomes enlarged or distended by pressure or heat, and which, by the use of the plaintiff's arrangement, will, when it escapes outside of the cup and the raised seat, be pressed between the outside bearing surfaces, to still secure a tight joint. Lead or tin packing, fused into a cup, is not an elastic packing, in the sense of the plaintiff's specification, nor is it the equivalent of such elastic packing.

The earliest date of the application of the plaintiff's arrangement by Johnson, in making valves, was October, 1867. The plaintiff applied it a year earlier.

Nothing that is adduced by the defendants affects the novelty of the plaintiff's invention in the valve patent, and the valves made and sold by the defendants are like the plaintiff's valve, in construction and arrangement.

There must be a decree for the plaintiff, for a perpetual injunction and an account of profits, in respect of the first and third claims of the packing patent, and of the claim of the valve patent, with costs.

Thomas W. Clarke and *William D. Booth*, for the plaintiff.

Anthony R. Dyett, for the defendants.

JAMES D. SARVEN

vs.

ELIHU HALL & Co. IN EQUITY.

A reissued patent cannot be sustained by extrinsic proof that the patentee was the inventor of all that is claimed in it, if what is so claimed was not shown or suggested in the original specification, drawings, or model.

Defects or insufficiencies in the description of anything which is found in any form in the original specification, drawings, or model, may be supplied in the reissue.

The specification of the original letters patent granted to J. D. Sarven, June 9th, 1857, for an improved carriage wheel, discloses two devices—one consisting of spokes, whereof a part are tenoned into a wooden hub, and a part are in wedge form, not thus tenoned; the other consisting of flanged collars applied to the hub and the spokes therein, whether the spokes are constructed in the manner last named, or in any other manner, the specification pointing out the application of flanged collars to a wheel containing the ordinary number of spokes, in which it is probable, at least, that the extra or increased number of spokes not tenoned into the hub are omitted.

The reissued letters patent granted to said Sarven, September 6th, 1870, on the surrender of said original patent of 1857, in declaring that the invention embraces the combination of the flanged collars with a wooden hub into which the spokes are tenoned, without including the wedge-form spokes, or the solid bearing of the spokes upon each other exterior to the hub, do not embrace a device not found in the record of the original patent.

The first claim of said reissued patent, namely, "A carriage wheel constructed with the spokes combined with a wooden hub by tenons entering mortises in said hub, and with each other, in such manner that a solid belt is formed around the said hub, substantially as before set forth," is limited to a solid belt formed by alternating tenoned spokes with wedge-formed spokes not tenoned, and is not infringed by a wheel in which all the spokes are tenoned into the hub.

A mere aggregation of parts, whereof the patentee has not the exclusive right to either, and in which the parts have no new operation, and produce no result which is due to the combination itself, is not patentable.

The second claim of said reissued patent, namely, "A carriage wheel constructed with a mortised wooden hub, with tenoned spokes, and with flanges which

Sarven v. Hall.

embrace the faces of the spokes in the immediate vicinity of the hub, and are connected together so as to form a metallic band, through which the spokes extend into the mortises in the wooden hub, substantially as before set forth," is valid.

Such claim is not a claim for a mere aggregation of devices.

Such claim is infringed by a wheel having tenoned spokes, and a wooden hub, and a mortised collar, cast in one piece, with divisions between the mortises for the several spokes, and with tapering sides formed to receive the spokes driven tightly therein, and give them endwise bearings.

As the mortised collar performs, both mechanically and practically, in the combination, the same office that is performed by the flanges of the plaintiff's wheel, it is none the less an equivalent therefor, in the combination, because it performs an additional office, not performed by such flanges.

(Before WOODRUFF and SHIPMAN, JJ., Connecticut, April 23d, 1872.)

THIS was a final hearing, on pleadings and proofs. The bill was founded on reissued letters patent granted to the plaintiff, September 6th, 1870, for an improved carriage wheel. The original patent was granted to him June 9th, 1857, and reissued August 11th, 1868, and afterwards extended. The defendants' wheel was made under letters patent granted to Almon Warner, February 5th, 1867, and reissued November 21st, 1871.

John S. Beach, Samuel S. Fisher, and Charles M. Keller, for the plaintiff.

Charles R. Ingersoll and Benjamin F. Thurston, for the defendants.

WOODRUFF, J. The defence relied upon herein is of a mixed or two-fold character, namely, a want of novelty in those features of the complainant's alleged invention which have been used by the defendants, and a denial that the defendants have infringed the patent granted to the complainant, in any feature which can be lawfully claimed to be secured to him. This mixed defence begets the claim, that no right which was due to the complainant in virtue of the original invention described in his patent, specification, drawings, or

model, has been violated by the defendants; and that, if the invention, as described and claimed in the reissued patent, purports to cover any broader ground, upon which the defendants can be said to have trespassed, then the reissue is, *pro tanto*, void.

These grounds of defence require an examination not only of the state of the art when the complainant's invention is alleged to have been made, but an examination of the complainant's original patent, specification, drawings, and model, to learn therefrom what invention by the complainant is disclosed thereby; for, it was conceded by the counsel for the complainant, on the hearing, that, in their opinion, at least, nothing can be legally claimed in the reissue, which does not appear either in the specification annexed to the original patent, or in the drawings, or in the model, even though it was, in fact, the invention of the patentee, and its use was contemplated by him when the patent was applied for, and that, the reissue could not, in that respect, be sustained by extrinsic proof that the patentee was, in truth, the inventor of all that was included in it, if neither the original specifications, drawings, nor model, showed or suggested the device in question. This is in accordance with the object of a reissue, and with the license therefor given by the law. It is where a patent is inoperative or invalid by reason of a defective or insufficient description, specification, or claim, and not where the device is not described or specified at all, that permission is given to reissue the patent. Devices not described or specified may, if they are the invention of the patentee, be the subject of a patent, subject to all other rules governing the inventor's right; but it is not the office of a reissue to embrace them. (*Seymour v. Osborne*, 11 Wall., 516, 544.) It is true, that an observation of the Court, in *Hussey v. Bradley*, (2 *Fisher's Pat. Cases*, 362, 371,) gives a broader scope to the right of reissue, and an intimation in *Doughty v. West*, (*Id.*, 553, 556,) is in the same direction. But, in the subsequent case of *Doughty v. West*, (3 *Id.*, 580, and 6 *Blatchf. C. O. R.*, 429,) founded on a reissue of the same patent, the re-

issue was sustained on grounds entirely consistent with the doctrine above stated, and the rule is, in my judgment, not only clearly correct in principle, but settled by the authority of the Supreme Court in the case first-above named.

(1.) This view of the law renders it necessary to inquire what invention is disclosed by the original record—the original patent, specification, drawings, and model—and, in that inquiry, the right of the complainant must be conceded, to supply any defects or insufficiencies in the description of anything which is found therein in any form.

In the original specification, the patentee declares that the object of his invention is, “to provide a wheel with a wooden hub, that will admit of a greater number of spokes in each wheel than can be used by the old method, on account of the hub being cut away, by mortises, to receive a number of spokes, that would be sufficiently near together at the rim of the wheel to prevent it from being flattened between the spokes by fast driving * * * ; it also consists in giving greater strength to the spokes at and near the hub, and to the hub itself.” A twofold, or, perhaps, a threefold object is thus announced: first, strengthening the nave of the wheel, by increasing the number of spokes; second, giving greater strength to the spokes at the hub, and, at the same time, strengthening the hub itself. Obviously, each of these objects was desirable, and, obviously, each would be useful, whether they were combined or not. If the proposed devices, or either of them, could be used separately from the others, so that either object was effected, a useful result would follow, which is actually mentioned and avowed to be within the scope of the invention.

The nature of the invention is then declared to consist in the employment of flanged collars of metal, to be used in combination with a wooden hub, as follows: “I use, in general, a very small hub of wood, much smaller than in the old style of wheel, and, instead of making sixteen mortises, as is common for spokes, I make, in general, nine or ten for the

tenons, somewhat larger than in the ordinary way, and, between each of these spokes, I make a mortise in the hub, about three-eighths of an inch deep, and insert spokes wedge-shape, as shown by the drawing accompanying this specification." This, it will be seen, explains the device which the patentee declares he generally employs for increasing the number of spokes, to strengthen and sustain the nave of the wheel, without unduly cutting away the hub by mortises; and the drawing shows, that, in this arrangement, the spokes have a firm bearing against each other at and for a short distance exterior to the wooden hub, so as to form a solid bearing around and exterior thereto.

Next he describes his device for giving greater strength to the spokes at the hub, and to the hub itself: "After the spokes are all fitted, I put the flanged collar on the back part of the hub, the collar fitting closely to the hub, and serves to strengthen and support the same, while the flange fits closely to the back of the spokes. I, in general, make three screw-holes in the collar next the hub, into which I insert screws, so that the collar will retain its position, in case the hub should shrink. In the flange that fits against the spokes, I, in general, make five one-fourth inch holes, in which I cut a thread to receive screws. After the back flange collar is secure, I put on the front flanged collar on the front of the hub, it fitting closely to the hub, but it is not screwed thereto, the flange fitting closely to the front of the spokes. In these flanges there are five holes, opposite those in the back flange. I now bore five one-fourth inch holes through the spokes, and insert screws, drawing both flanges firmly against the spokes, thereby securing all the spokes firmly in their proper place." This part of the specification discloses the device by which the object secondly named, which the patentee had in view, is secured, namely, giving greater strength to the spokes at the hub, and at the same time strengthening the hub.

The specification then proceeds to state the dimensions of the hub and spokes ordinarily used, and the gain in effective strength in the smaller hub, with spokes fitted as first de-

scribed, and the greater power of resistance resulting from the bearing of the spokes on the flanges on either side thereof; and it then adds, that "this arrangement can also be applied to a wheel with the ordinary number of spokes, thereby preventing the tenons at the hub from being broken off." This imports, in connection with what precedes, that, although the inventor, "in general," uses the greater number of spokes, some of which are inserted in the hub by tenons, and the others, in wedge form, enter very slightly into the hub, yet his arrangement can also be applied to a wheel with the ordinary number of spokes; and its effect in "preventing the tenons from being broken" indicates, that, in such case, the spokes are tenoned into the hub—that is to say, it can be applied to a wheel with the ordinary number of spokes inserted by tenons into the hub, which describes the ordinary wheel. It contemplates, as a practicable use of the flanged collars, their application to a wheel not containing the additional number of spokes before described as being without tenons. It, therefore, contemplates the application of those collars to an ordinary wheel, or, possibly, to a wheel in which, although the ordinary number of spokes are used, their shoulders between the flanges are so enlarged as to bear against each other. This latter mode of fitting the spokes to a bearing is certainly not expressed, and it seems, therefore, most in accordance with the terms, to regard it as a suggestion that such flanged collars may be applied to an ordinary wheel with tenoned spokes, and that, when so applied, they strengthen the hub and strengthen the spokes and "prevent the tenons at the hub from being broken off."

The specification then points out the special advantage of the flanges and the importance of securing the back collar to the hub, with the capacity of tightening the front collar on the spokes, if they shrink, in view of the custom of giving a light wheel a dish form, in which there is great strain upon the tenons of the spokes, and also in view of the necessity at times of resetting the tire.

In the drawings annexed to the specification, and in the

description of the drawings contained in the specification, he gives only one kind of wheel, and that embraces both features or devices before mentioned, combined—that is to say, a wheel with the flanged collars and with the increased number of spokes, of which a part are not tenoned, but are wedge-shaped and enter but slightly into a small mortise in the hub. This, however, is not material to the validity of the reissue, if, in fact, what was already in the specification embraces the application of either of his devices to a wheel with the ordinary number of spokes tenoned into the hub.

The statement of the claims of the patentee may properly be referred to as an aid to the same point of inquiry—what is described as the invention of the patentee. The first claim is: “The employment of flanged metallic collars, as described, or other equivalent devices, in combination with a wooden hub, and these in combination with the arrangement of the spokes at the hub, as described, by which means strength and support is given both to the hub and to the spokes at and near the hub, and by which means I am enabled to use any desired number of spokes in each wheel * * * and a much smaller hub than those in general use, and at the same time retain a sufficient degree of strength at the hub, the whole being constructed and arranged substantially as and for the purpose set forth.” This claim manifestly points to and includes both of the devices, as shown in the drawings and model, and contains no suggestion or hint of any construction of a wheel except by making a part of the spokes with tenons and a part in a wedge form without tenons, so fitted that the spokes at the hub bear upon each other.

But the second claim has manifest reference to the other arrangement of spokes, already named in the specification, as follows: “I also claim the flanged collars, as described, or other equivalent devices, when used in combination with a wooden hub, if the spokes are arranged as herein set forth, or in any other manner.” That is to say, he claims the flanged collars in combination with a wooden hub, although the spokes are all tenoned into the hub. Read in connection with the

specification, which declares that his arrangement "can be applied to a wheel with the ordinary number of spokes, thereby preventing the tenons at the hub from being broken off"—in which case it is obvious, from the whole specification, that there will be none which are not thus tenoned—this claim is comprehensive enough to embrace flanged collars applied to a wheel in which there are tenoned spokes only; and, so read, it is specific enough to refer to the application thereof to the ordinary number of spokes, previously mentioned.

Be it here observed, that this review of the original specification and claims is not for the purpose of testing their sufficiency or validity. If insufficient or defective, their defects and insufficiencies might be cured by the reissues. This review is for the single purpose of seeing what inventions or devices are found therein; and it leads to this conclusion, that the patentee has therein disclosed two devices—one consisting of spokes, whereof a part are tenoned into a wooden hub, and a part are in wedge form not thus tenoned; the other consisting of flanged collars applied to the hub and the spokes therein, whether the spokes are constructed in the manner last named or in any other manner. And the preceding specification points out the application of flanged collars to a wheel containing the ordinary number of spokes, in which it is probable, at least, that the extra or increased number of spokes not tenoned into the hub are omitted.

The reissued patent, while it retains the drawings of the original patent, which show the device of metallic flanges applied to a wheel having a part only of the spokes tenoned into the hub, is more specific in declaring that the invention embraces the combination of the metallic flanges with a wooden hub into which the spokes are tenoned, without including the wedge-form spokes or the solid bearing of the spokes upon each other exterior to the hub. The review of the original patent already given shows, I think, that this is not an extension of the patent to a device not found in the record of the original. If so, then one advance has been made in the investigation of the questions raised by the defence—that is

to say, the reissued patent is not, on its face, void, in this feature, as embracing an invention not found in the original patent, specification, drawings, or model.

(2.) The reissue also declares, that the invention, in another part, "consists in the construction of a wheel in which the spokes are combined with a wooden hub by tenons, and with each other, in such a manner that they afford mutual support in the vicinity of the hub, or so that the strain applied to any one spoke in the direction of the length of the felly of the wheel is propagated to the adjacent spokes in the vicinity of the hub, and through them to the tenons that enter the hub, whereby such strain is distributed among all the tenons that enter the hub, instead of being borne by that one only of the spokes to which the strain is applied." And the third part of his invention is declared to be, a wheel combining both of the foregoing characteristics, namely, the mortised wooden hub with spokes having tenons, and so combined as to form the solid belt outside the hub, and also the metallic flanges embracing the sides of the spokes. Although, in this part of the specification, the use of spokes not entering the hub by tenons is not mentioned, the drawing exhibits them as in the original patent, and the detailed explanation of the drawings distinctly recognizes the fact, that a part only of the spokes enter the hub by tenons.

The result is, that the device of strengthening the spokes at the hub by making them bear upon each other, so as to form a solid belt of wood around and exterior to the hub, is, by the introduction of wedge-shaped spokes between the tenoned spokes which are not made wedge-shaped, the giving to the tenoned spokes a somewhat larger tenon than usual, which, by the omission of the tenons on the intermediate spokes, is rendered practicable, without injuriously cutting away the hub. No other mode of constructing this device, or of securing the solid bearing of each spoke upon the others, is shown, suggested, or hinted at, either in the original patent or in the reissue.

This mode of giving to the spokes a bearing upon each

other, the defendants have not adopted. In the defendants' wheel, there is no spoke not tenoned into the hub, the spokes do not bear against each other, and their form near the hub is not the same as described in the complainant's patent. Whether, in this respect, the defendants use a mere equivalent, will, if necessary or material, be hereafter considered.

This mode of giving support to the spokes by their bearing on each other is not new; and, if we were compelled to construe the plaintiff's patent and claim as so broad as to include, as a distinct device, every mode of constructing the spokes so as to give them a solid bearing around the hub, we should be also compelled to say, that, so construed, the patent is, in that particular, void. The wheel known and designated, on the trial, as the Woodruff and Beach wheel contains that device. The contact of each spoke with another on either side formed a solid belt of wood around the hub, operating in reference to resistance of strain in the direction of the plane of the wheel, precisely as the like arrangement in the plaintiff's wheel. It was suggested, that, in that wheel, such contact was not exterior to the hub. But that suggestion is not warranted; for, the distance from the centre to which that contact should be carried in the Woodruff and Beach wheel, is matter of mere judgment and not of invention; and, besides, in that wheel, such contact was carried to a distance exterior to the hub, unless the flanges applied on each side to resist the lateral strain be regarded as part of the hub; and, if that be claimed, the same must be no less true of the plaintiff's flanges; and, in neither of them, is the contact or bearing of the spokes upon each other carried outward beyond the edge of the flanges. It follows, that, in respect to the use of spokes bearing on each other at and near the hub, as a separate device, the plaintiff's patent can only be sustained by giving the specification and claim the construction above already stated. It must be confined to the specific mode of effecting the result which the patentee has described, and which alone he has described, and that mode of construction the defendants have not used.

(3.) As to the lateral support given to the plaintiff's wheel by flanges, viewed as a distinct and separate device, the defendants cannot be charged, for several reasons: *First.* Flanges had been used before on an iron hub in the Woodruff and Beach wheel, and their application differed in no wise from the plaintiff's, except that the inner flange on the plaintiff's wheel, as described by the patentee, is made fast to the hub by being screwed thereto; and, in the Woodruff and Beach wheel, it was attached to the hub firmly by being cast with it. In both, the outer or front flange was adjustable, and was made fast to the other by bolts passing from one to the other. The transfer of flanges from an iron hub to a wooden hub would not be patentable, unless it required some ingenuity or contrivance to adapt it to use in its new position. *Second.* The defendants have not used flanges constructed or applied in the manner devised or used by the plaintiff, but have used, and only used, mortised collars. *Third.* The use of mortised collars on a wooden hub is found in the Smith and Parfrey patent, long before the invention of the plaintiff's wheel. *Fourth.* If, then, the mortised collar is to be deemed an equivalent to the flanged collars claimed by the plaintiff, the latter has no exclusive right to use them, because the mortised collar was an old device; and, on the other hand, if such mortised collar is not an equivalent to the flanged collar, the defendants have invaded no right of the plaintiff in this respect, because the defendants have not used the flanged collars, and have a perfect right to use the mortised collar.

(4.) It follows, from these views, that the defendants have violated no right of the plaintiff in respect to the several parts of the wheel, viewed separately, as distinct devices. The right to construct a wheel having spokes tenoned into a wooden hub was not vested exclusively in the plaintiff. That was found in what is conceded to have been the ordinary wheel long in use. The right to construct a wheel wherein the spokes are in contact, and bear upon or against each other at or near the hub, was not vested exclusively in the plaintiff,

except when constructed in the confessedly novel mode which alone is suggested in his patent, namely, by introducing between the tenoned spokes other spokes or pieces of wood in a wedge-form, to fill the intermediate spaces, but not tenoned into the hub. The right to use the mortised collar is not vested exclusively in the plaintiff, whether it be regarded as equivalent to his flanged collars or a different device, and the defendants have used the mortised collar only. If, therefore, the defendants were sought to be charged as infringers by reason only of their use of the plaintiff's devices viewed separately, or separately patented, or as merely connected with a wooden hub, the plaintiff must fail. Each of these separately the defendants have a right to use.

(5.) It follows, that, if the plaintiff is entitled to charge the defendants at all, it is in virtue of some combination of these devices, claimed and secured to him by his patent. Upon this point the case is a very close one, and is not without embarrassment.

The rules of law applicable to the subject of combinations are free from difficulty. The counsel for the parties respectively do not appear to differ in relation to those rules, so far as they bear upon the present case. *First*. A patent for a combination, where neither part is patented as new, is not infringed by one who uses one, or some, but not all, of the parts. *Second*. A mere aggregation of parts, whereof the patentee has not the exclusive right to either, and in which the parts have no new operation and produce no result which is due to the combination itself, is not patentable. (*Hailes v. Van Wormer*, 7 *Blatchf. C. C. R.*, 443; and see an analogous principle in cases which hold that the mere appropriation of an old device to a new use is not patentable; *Stimpson v. Woodman*, 10 *Wall.*, 117; cases collected in *Curtis on Patents*, sec. 33 and note; *Bean v. Smallwood*, 2 *Story*, 408; *Winans v. R. R. Co.*, *Id.*, 412; *Hotchkiss v. Greenwood*, 11 *How.*, 248.)

The first claim in the reissued patent is: "A carriage wheel constructed with the spokes combined with the wooden

hub by tenons entering mortises in said hub, and with each other, in such manner that a solid belt is formed around the said hub, substantially as before set forth." Recurring now to the specification and to what has already been said on the subject, it will be seen, that this is not a combination of tenoned spokes with any and every manner of connecting the spokes at or near the hub, so that they shall bear against or upon each other, but a combination of tenoned spokes with the construction alone described in the specification, to wit, the alternation of tenoned spokes with spokes in a wedge-form not tenoned into the hub. This combination the defendants have not used.

The second claim is: "A carriage wheel constructed with a mortised wooden hub, with tenoned spokes, and with flanges which embrace the faces of the spokes in the immediate vicinity of the hub, and are connected together so as to form a metallic band through which the spokes extend into the mortises in the wooden hub, substantially as before set forth." This claim, construed by the aid of the specification, is for the combination of the two flanges with tenoned spokes, the two flanges being connected together so as to give lateral support to the spokes.

This second claim raises three questions involved in the present case, which may be most intelligibly discussed in the following order: *First*. Have the defendants used this combination? and if so, then, *second*, is such combination patentable, or is it a mere aggregation of devices not involving patentable invention? and, *third*, is it a new combination?

The defendants have not used—it is not claimed that they have used—flanged collars, constructed separately, to be separately applied and bolted or screwed together. The mechanical construction of the mortised collar, cast in one piece, with divisions between the mortises for the several spokes, and with tapering sides, formed to receive the spokes driven tightly therein and give them endwise bearings, is not the same as the plaintiff's flanged collars. They perform a different office in the particular last named, which the plaintiff's

Sarven v. Hall.

flanged collars do not and cannot perform. The defendants' mortised collar and the plaintiff's flanged collars are, therefore, not identical, either in mechanical construction or in the office which they perform. It is, nevertheless, claimed, that, in the particular construction and office which is embraced within the plaintiff's second claim, they are the precise equivalent of the plaintiff's flanged collars. This claim suggests a question of some interest: Is a device which, both mechanically and practically, performs the same precise office of another device, in substantially the same manner, any less an equivalent of the latter, because it also performs another office or offices, by reason of a difference in its mechanical construction?

The mortised collar used by the defendants has its two sides in the same form as the two flanged collars, of the plaintiff. In reference to the purpose for which the plaintiff's two flanged collars are used—to wit, to strengthen the hub, and to sustain the spokes against lateral pressure or strain, and to co-operate with the tenons in giving firm support to the spokes—they perform identically the same office as the plaintiff's flanged collars, and in the same way. The circumstance that they are held together by connecting cross-pieces, made solid therewith, instead of by bolts or screws, has no effect on the manner of their operation in this respect. Are they, then, to be deemed any less the equivalent of the flanged collars because, by reason of the greater number of cross-pieces, they are stronger, or because the cross-pieces between each two spokes and the sides of the mortise are tapered, so as to give an endwise bearing to the spokes, and enable the spokes to be driven in and be grasped firmly and held therein? I think not. In the use, and for the purpose, for which the plaintiff's flanged collars are useful, they are identical in the office they perform, to wit, to sustain the spokes against lateral strain. The mechanical construction, in the parts which perform this office, is substantially the same. The crosswise partitions and form of tapering mortises may be improvements upon the plaintiff's flanged collars, but the

mortised collars do, nevertheless, operate, for all the purposes for which the flanged collars are used, in precisely the same way. If the question was between a single patented device, conceded to be new, and a device claimed to infringe, because an equivalent, the alleged infringer could not protect himself by showing that, although his device was an equivalent of the patented device, in all its functions, and in its construction and mode of operation, yet, by other or additional features, it possessed other and further useful functions. Such a device would, perhaps, be an improvement upon the patented device, but must be, nevertheless, deemed an appropriation of the former.

This view of the subject of equivalents is not stated in order to a conclusion that, as separate devices, either of these parties has the exclusive right to the flanged collars or to the mortised collar. Both, as hereinbefore stated, are old. It does not follow that the plaintiff's combination of flanged collars with tenoned spokes is old; and the question discussed is, whether, in the combination of flanged collars with the tenoned spokes, the substitution of the mortised collar is not, within the meaning of the law, the substitution of an equivalent in the combination, although such device (being equivalent for the purposes, and in all the functions, of the flanged collars) also contains other and additional functions due to its peculiar construction. In this view, the combination of a mortised collar and tenoned spokes with a wooden hub must be regarded as embracing the combination of the flanged collars and tenoned spokes with a wooden hub, claimed in the plaintiff's patent; and, if that patent is valid in respect of that claim, the defendants must be held to infringe it, notwithstanding the combination used by the defendants may also include other functions and produce effects not attainable by the plaintiff's combination.

(6.) The plaintiff's combination referred to in his second claim is distinguished from a mere aggregation of devices in this, that there is a reciprocal action or operation of the parts upon each other and conjointly upon the entire wheel, each

Sarven v. Hall.

part giving to the other increased support and efficiency, and the two co-operating to make a stronger and more durable wheel than is produced by the use of either without the other—that is to say, the tenoned spokes are strengthened and sustained in position by the flanged collars, and the flanged collars, bound to the spokes by the connecting-bolts or screws, are more firmly held in position by the tenons of the spokes. Combined, they unite hub and spokes, enabling the wheel better to resist a blow or strain either laterally or in the direction of its plane. It must be conceded, within the rule on this subject, that a combination of devices would not necessarily be patentable from the mere fact that their union produced a better wheel. If the superiority arose from the fact that the two devices were intrinsically better than others and the wheel combined both—each, however, operating independently of the other—the combination would be but the exercise of judgment in the choice of parts, and not invention in discovering new means to produce useful or better results. For illustration, one mode of securing the tire to the felly, or the felly to the spokes, may be better than any other in use. One form of axle-box, or a mode of securing the axle-box to the hub, may be better than any other in use; and it might so happen that both or all had never been used together in the construction of a carriage wheel; and yet, both being old, one who should adopt both in the construction of a wheel, without other change in its construction, would not be an inventor, and his wheel would have no patentable quality. Each device is complete in itself, it performs the same functions and in the same way, in whatever wheel it is used, and without being influenced or/affected by the other. This distinction may often be very nice, and sometimes may, for its application, require very close and careful discrimination; but the distinction is itself a substantial one. It reduces the basis of the second claim in the plaintiff's patent to somewhat narrow grounds, but it is sufficient to sustain it. A new relation is established between the efficient means of strengthening and supporting the parts of the wheel in ques-

tion, and a new and greater efficiency is given to each, which is due not to their inherent quality but due to the combination itself.

(7.) If, then, this combination embraced in the second claim was new when the plaintiff received his patent, or, in other words, if he was the inventor, his suit against these defendants must be sustained; for, if that second claim is valid, the defendants' wheel, under the interpretation above given to the rights of the plaintiff in other respects, is a clear infringement.

The patent is itself *prima facie* evidence that the combination was new. The patents and models or specimens, given in evidence by the defendants, none of them contain the combination. Neither the Smith and Parfrey wheel, nor the Woodruff and Beach wheel, contain the tenoned spokes; and the last named contains no wooden hub. The others which have tenoned spokes have neither the flanged collars, nor the mortised collar. In short, there is no evidence of a prior use of this combination, except certain oral testimony to the application of hoops or bands around the hub, to increase its strength; the use, in perhaps a few instances, of rings, or parts of rings, applied to the spokes on each side, and bolted together, to repair a wheel wherein some one or more of the spokes had been split or broken near the hub; and the testimony of one witness, that his father and himself had applied to new wheels, at the hub, next to the spokes, and on each side, a ring of iron of considerable size in either direction, and bolted the one ring to the other, to bind the hub, and assist in sustaining the tenoned spokes. Without questioning the sincerity of the witnesses who testified on this subject, or doubting their intention to testify truthfully, we must say that the evidence was not very satisfactory; and the whole either failed to show much likeness to the plaintiff's device, or was otherwise of too vague and uncertain a character to warrant a conclusion that there was any actual anticipation of it. The witness last referred to no doubt testified to some approximation to the flanged collars, very rude at

best, and only in a few instances used at all. But we think that the testimony fails to show satisfactorily such prior invention, knowledge, or use of the plaintiff's combination as invalidates his patent in respect to the second claim, which alone the defendants have infringed.

(8.) It is not without doubt and hesitation that we have reached the conclusion that the plaintiff is, upon the grounds above stated, entitled to a decree. There is some reason to believe that the whole invention, as regarded by himself, and set forth in the specification annexed to his original patent, was the increase of the number of spokes, by introducing wedge-shaped spokes which should not be tenoned into the hub, lest it should cut it too much away, and, at the same time, enlarging somewhat the tenons of the spokes which were tenoned, and strengthening the spokes, particularly those not tenoned by the flanged collars. Such a wheel the defendants have not constructed. But the plaintiff may have contemplated the use of flanged collars generally in combination with tenoned spokes, and the analysis of his specification and claims, which we have given, indicates, at least, that they are sufficient to include it.

The plaintiff must have a decree declaring the defendants to have infringed the second claim of the patent, and ordering an injunction. The plaintiff having, since the suit was commenced, surrendered the patent upon which his suit was founded, and his case now standing on the reissue of the patent granted September 6th, 1870, set forth in his supplemental bill, he is not entitled to an account of anything done prior to that date; and, as this suit was commenced prior to the patent law of 1870, he is not entitled to damages, as such, notwithstanding the fact that his supplemental bill was filed after the passage of the Act.

Judge SHIPMAN concurs.

The Hartford and New Haven Railroad Co. v. Grant.

THE HARTFORD AND NEW HAVEN RAILROAD COMPANY

vs.

HENRY A. GRANT.

Under § 122 of the Act of June 30th, 1864, (13 *U. S. Stat. at Large*, 284,) moneys used by a railroad company to replace an old and worn out bridge, by another of like materials and dimensions, are not "profits used for construction," and, as such, liable to a tax of five *per cent*.

But, where a wooden bridge is replaced by a much more costly stone bridge, the earnings adequate to pay for the latter, beyond the expense of building anew a like wooden bridge, are to be deemed "profits used for construction."

Where, however, the cost of such stone bridge is charged to the expense account of the company, and the whole amount of such account for the year, including such cost, is not more than a proper percentage of the gross receipts of the company to cover all proper, ordinary, current expenses, and the depreciation of its entire property, such cost is not to be deemed "profits used for construction."

(Before SHIPMAN, J., Connecticut, April 23d, 1872.)

THIS suit was brought to recover back money which the plaintiffs alleged that the defendant, as collector of internal revenue for the first collection district of Connecticut, had illegally exacted of them, and was submitted to the Court on an agreed statement of facts. The following were the material facts agreed upon by the parties: (1.) Early in the year 1866, the plaintiffs commenced building a new bridge at the point where their track crosses the Farmington river, in the town of Windsor, in this State. They continued work on this bridge until after the 31st of August, 1866, the day of the close of their fiscal year, at an expense of \$31,269 35, which they charged in their expense account, for repairs, &c. During the fiscal year of 1867, and up to its close, on the 31st day of August of that year, they expended the additional sum of \$24,442 95, which was charged to the same account, making a total, for the two fiscal years,

The Hartford and New Haven Railroad Co. v. Grant.

ending August 31st, 1867, of \$55,712 30. (2.) On the 13th of January, 1868, the assessor for the district made a special assessment on this sum of \$55,712 60, "as profits, used in construction," at the rate of five per cent., under section 122 of the Act of June 30th, 1864, (15 *U. S. Stat. at Large*, 264); and, on the 11th of February, 1868, the defendant, as collector, required the plaintiffs to pay the same, amounting to \$2,785 61, together with \$139 28, as penalty for non-payment within the time prescribed by law. These two sums, making \$2,924 89, the plaintiffs paid, under protest and duress, to avoid distraint of their property. (3.) The bridge constructed at the point in question at the time the road was built, many years ago, was a wooden structure, on stone piers and abutments. A few years later, this was burned by sparks from a locomotive, and was replaced by another wooden bridge upon the same foundations. In 1854, an unusual freshet in the Farmington river greatly endangered the bridge then in use, the water rising against the floor and upper sides thereof, and it was saved from destruction only by the active exertions of the officers of the company, with a large force of men. A highway bridge, belonging to the town of Windsor, across the same river, a few hundred feet below, was carried away, and a suit was commenced by the town against the railroad company, to recover damages for the destruction of the town bridge, on the ground that the railroad company had so narrowed the waterway of the river by its embankments and abutments, as to send the water with increased velocity and volume against the town bridge, and had thus caused its destruction. This suit was tried three several times, in a series of years, resulting, each time, in a failure of the jury to render a verdict, and was finally settled by compromise. In 1864, it became apparent to the company, that the bridge in question must soon be rebuilt, or replaced by some other structure. It was temporarily strengthened, in various ways, for the time being, and the subject of replacing it by some other structure was carefully considered by the officers of the company; and, finally, in view of the danger of the destruction of a wooden bridge by fire, the necessity

The Hartford and New Haven Railroad Co. v. Grant.

of additional waterway, demonstrated by the experience of previous years, the great loss to the company, and inconvenience to the public, which would result from the destruction of the bridge—a loss to the company which would have exceeded the entire cost of the present bridge—it was decided to proceed gradually with the construction of a bridge composed of continuous stone arches. The bridge was commenced, as already stated, in 1866, and was finished in 1868, at a total cost of \$78,987 75. It consists of seven stone arches, each 54 feet span, affording a waterway of 378 feet, being 88 feet more than that furnished by the old bridge. (4.) Until the year 1871, the fiscal year of the company has terminated on the 31st of August of each year. The expenditures on this bridge, in each of the fiscal years 1866, 1867, and 1868, were charged to the current expenses of repairs of roads and bridges, as they were, in each fiscal year, made. (5.) The total expenditure of the company during the fiscal years 1866 and 1867, (which, in the latter year, was 59 *per cent.* of the gross earnings), for repairs of track, bridges, and equipments, including renewal of bridges, equipment, and structures, and all other current and incidental charges for operating the road, except State and National taxes, was not more than a proper percentage of the gross receipts to cover all proper, ordinary, current expenses, and the depreciation of the entire property. (6.) During the years in question, the company earned a large surplus over their expenses, a portion of which was paid to their stockholders in dividends, and the balance was carried to a contingent fund, upon each and all of which the company paid the taxes required by the laws of the United States. (7.) The cost of replacing the old wooden bridge by another of the same materials and dimensions, would have been \$15,000. The value of the materials of the old bridge was \$1,500.

Henry C. Robinson and Richard D. Hubbard, for the plaintiffs.

Calvin G. Child, for the defendant.

The Hartford and New Haven Railroad Co. v. Grant.

SHIPMAN, J. The disputed assessment in this case was made under that portion of the Internal Revenue Act of June 30th, 1864, which relates to the tax on income. Section 122 of that Act, (13 *U. S. Stat. at Large*, 284,) provides, among other things, that, "any railroad, canal, turnpike, canal navigation, or slack-water company, indebted for any money for which bonds or other evidence of indebtedness have been issued, payable in one or more years after date, upon which interest is stipulated to be paid, or coupons representing the interest, or any such company that may have declared any dividend in scrip, or money, due and payable to its stockholders, as part of the earnings, profits, income, or gains of such company, and all profits of such company carried to the account of any fund, or used for construction, shall be subject to and pay a duty of five *per centum* on the amount of all such interest or coupons, dividends or profits, whenever the same shall be payable."

The principal question presented by this controversy, for determination, is, whether the \$55,712 30 expended by the plaintiffs during the fiscal years 1866 and 1867, on this bridge, were "profits used for construction," and, therefore, subject to tax. It is obvious, at a glance at the agreed facts, that the whole of that sum was not liable to the tax imposed, whatever may be the fact in regard to the larger part of it. The bridge in question needed to be replaced by a new one. The safety of the travelling public demanded this; and, whatever sum was necessary to replace the old and worn-out structure by a new one of the same materials and dimensions, would, in no sense, be deemed profits used in construction. An amount necessary to effect this object could not properly be called "profits," for any purpose. The replacing of the old bridge by such a new one was strictly within the meaning of the word "repairs," and the cost of it was properly chargeable to the ordinary expense account of the company, and was to be deducted from the gross receipts before any proper balance of profit could be ascertained. It is agreed, that the cost of thus replacing the old bridge would

The Hartford and New Haven Railroad Co. v. Grant.

have been \$15,000. From this sum the value of the materials of the old bridge would have to be deducted. It is agreed that they were worth only \$1,500. Thus, \$13,500, which the plaintiffs were clearly entitled to deduct, as a part of their necessary expenses, from their gross earnings, before any profits or income would accrue, was included in the amount upon which the tax was assessed and collected. As well might the assessor have assessed a tax on the wages of the engineers, or on the coal used in driving the engines, as on this sum, which is conceded to have been necessary to keep this bridge in a safe condition for public travel. To the extent, therefore, of \$13,500, or, rather, to the extent of 5 *per cent.* on that sum, the tax was improperly levied, and its collection was illegal.

But, the plaintiffs claim, still further, that none of the expenditure on this new bridge during the years 1866 and 1867 was "profits used for construction." On the contrary, they insist, that, though they reconstructed the bridge on a new plan, with an increased water-way, and with different and non-combustible and comparatively indestructible materials, still, as the new structure was simply a bridge for crossing this stream, with no more tracks, or facilities for business or earnings, than the old one furnished, the expenditure devoted to this object should be deemed, not profits used for construction, but a part of their current expenses, necessarily devoted to the repair and preservation of their property. But, if this question were to be determined exclusively on the naked facts pertaining to this new structure, as compared with the old one, unaffected by any other consideration, I should hesitate to adopt this view of it. This stone bridge was not only a new structure, but it was a different and much more valuable one, not merely to the public, in the way of safety, but to the company, as a security against loss by accidents to their trains, and loss by fire, to which the former wooden structure was exposed, and to which a new wooden bridge would be equally exposed, and by a great saving in future repairs or renewals, provided against effectually by the solid and perma-

The Hartford and New Haven Railroad Co. v. Grant.

ment materials of which it is composed. In this view of the matter merely, the new bridge was an original and independent improvement of the property of the company, which added to the value of their whole estate beyond what any mere repairs on the old bridge, or the substitution of a new one of similar construction, would have done. It would seem that earnings adequate to pay for such an improvement must be deemed profits. Otherwise, a railroad company might, after keeping their tracks and bridges in ordinary repair, such as they had been for twenty years, by a current expenditure for that purpose, devote a part or the whole of their surplus earnings to the erection of stone or iron bridges and stone causeways, and any other more permanent and durable structures, in place of old ones, one after another, and thus increase the value of their entire line of road to the extent of millions, and yet pay no tax on the income by means of which they had been able to accomplish such a result.

But this is not the case presented by the agreed statement of facts submitted. The expenditure on this bridge in 1866 and 1867 was charged by the company in their expense account for the current years, respectively; and it is expressly agreed, that the whole amount expended on the line, including that devoted to this bridge, was not more than a proper per centage of the gross receipts to cover all proper, ordinary, current expenses and the depreciation of the entire property. Now, a deduction of such a per centage must always be made, before the amount of profits can be ascertained. There can be no profits, in any just and proper sense, until a sum necessary to keep the line in good repair and protect the whole property from depreciation by wear and time, has been expended, or set apart, for that purpose. Profits consist of the balance that remains after this is done. The obvious and irresistible inference which follows from the fact agreed to, which I am now considering, is, that, whatever sum was expended on this new bridge in 1866 and 1867, beyond what was necessary to repair the old one, or replace it with one similar in materials and dimensions, was withheld from some other part

of the line needing repairs, to keep *it* in its original condition. In other words, a portion of the earnings which might properly have been devoted to the repair and preservation of the whole line of road and its equipment, was, during these two years, accumulated and expended upon this bridge. Withholding proper expenditure from one portion of the line and devoting it to another, where the amount thus expended does not enhance the value of the property as a whole, does not constitute that expenditure profits. It is a mere mode of administering or distributing the outlay of the fund proper to be applied to repairs—a fund that must always be deducted before the question of profits is reached.

Judgment must, therefore, be entered for the plaintiffs, to recover the whole tax exacted.

THOMAS A. MORRISON AND OTHERS

vs.

JULIUS A. CASE AND OTHERS. IN EQUITY.

Under section 77, &c., of the Act of July 8th, 1870, (16 *U. S. Stat. at Large*, 210, &c.) the words, "The Star Shirt," and those words with the device of a six pointed star used in connection therewith, and the device and words, "The * Shirt," used as a trade mark in connection with the manufacture and sale of men's and boys' shirts, and taken by dealers as designating the shirts made by a particular manufacturer, are a lawful trade-mark.

(Before SHIPMAN, J., Connecticut, April 23d, 1872.)

SHIPMAN, J. This is a bill in equity praying for an injunction to restrain the defendants from using a certain trade-mark upon men's and boy's shirts. The parties are both of them shirt manufacturers, selling their goods in the general

Morrison v. Case.

market. The plaintiffs and their immediate predecessors have been engaged in the manufacture and sale of this class of goods for many years, during which the business has grown to considerable magnitude. For twenty years they have used the trade-mark in question, by stamping or labeling the same upon the shirts manufactured and sold by them, and upon their packages and advertisements. In March, 1871, the plaintiffs caused this trade-mark to be registered in the Patent Office at Washington, under the Act of Congress approved July 8th, 1870, (16 *U. S. Stat. at Large*, 210, &c., § 77, &c.)

The trade-mark in question, as appears by the certificate of the Commissioner of Patents, and the fac-similes filed in his office in conformity to the Act of Congress, consists of the words, "The Star Shirt"; also, the words, "The Star Shirt," with the device of a six-pointed star used in connection therewith; and, also, the device and words, "The * Shirt"—either one, or all, being used, as convenience requires. Though this device or mark is in part arbitrary and, to that extent, would have no natural or necessary significance in connection with the article manufactured, apart from its use in that connection, yet, by such use of the plaintiffs, in connection with their manufacture and sale of these articles, it has become well known to the trade, and has come to be taken by dealers, as a peculiar designation by which the plaintiffs' goods are distinguished in the market. It is, therefore, both in its character and use, when taken together, a lawful trade-mark. It has long been employed by the plaintiffs and well understood, by dealers and the public, as designating such articles of their manufacture. They have complied with the requirements of the Act of Congress, and are entitled to protection. Their exclusive right to the use of this trade-mark is co-extensive with the limits of the United States.

The defendants have clearly infringed this right by using the words and device of the plaintiffs, both in the exact form, and in such near resemblance as is calculated to deceive. They have done this by so marking the shirts made by them, and by the labels used on their packages and packing boxes,

HITCHCOCK v. TREMAINE.

A perpetual injunction must, therefore, issue, restraining them from any use of this tradé-mark, either in the identical form in which it is registered in the Patent Office, or in any form in which it may be calculated to deceive, by confounding the goods manufactured and sold by the plaintiffs with shirts made and sold by the defendants.

Calvin G. Child, for the plaintiffs.

Charles E. Perkins, for the defendants.

ALONZO HITCHCOCK AND OTHERS

vs.

CHARLES M. TREMAINE AND WILLIAM B. TREMAINE.

IN EQUITY.

The fact that the defendant, in a suit in equity, for the infringement of a patent, did not have proper expert testimony, on the final hearing, is no ground for granting a rehearing, where no application was made in the premises before the final hearing, and no excuse is shown.

The fact that, since the first hearing, the defendant has discovered that a patent earlier than the plaintiffs, and which was in evidence on such hearing, has been twice reissued, the last time since such hearing, is no ground for granting a rehearing.

If there is nothing, in a prior original patent, to affect the validity of the patent sued on, no reissue of such prior patent made subsequently to the date of the patent sued on, can affect such validity.

On an application, after a hearing in a patent suit, to put in alleged newly discovered evidence, it must be shown that the party could not, with reasonable diligence, have obtained such evidence prior to such hearing.

Observations on prior unsuccessful experiments set up to defeat a patent.

(Before BLATCHFORD, J., Southern District of New York, May 3d, 1872.)

Hitchcock v. Tremaine.

THIS was a petition by the defendants to stay the entry of a final decree, in the suit reported in 8 *Blatchf. C. C. R.*, 440, and for leave to file an amended answer, and to take proof in support thereof, and for a rehearing of the cause.

Frederic H. Betts, for the plaintiffs.

B. E. Valentine, for the defendants.

BLATCHFORD, J. The grounds set forth in the petition, for the relief asked, are: (1.) That the defendants did not have proper expert testimony on the first hearing; (2.) That they have discovered, since the first hearing, that a patent issued to one Louis, prior to the plaintiffs', and set up in their answer as anticipating it, has been twice reissued, one of such reissues having been granted since the first hearing; (3.) That, since the first hearing, they have learned that said Louis was the inventor of the identical device covered by the plaintiffs' patent, and made and sold many of such devices at least five years before the date of the plaintiffs' patent.

(1.) The want of proper expert testimony is no ground for granting a rehearing. Application should have been made to the Court prior to the first hearing, for opportunity to procure and put in such testimony. No sufficient excuse is shown for not doing so.

(2.) As to the reissues of the Louis patent, all of them are subsequent in date to the plaintiffs' patent, and cannot affect its novelty or validity, if there is nothing in the specification or drawings of the original patent to Louis which affects such novelty or validity, as was decided by the Court on the former hearing.

(3.) As to the alleged newly discovered evidence as to a prior invention by Louis of the plaintiffs' device, the defendants fail to bring themselves within the principle on which amendments of answers after hearing are allowed, (*India Rubber Comb Co. v. Phelps*, 8 *Blatchf. C. C. R.*, 85,) by showing that they could not, with reasonable diligence, have ob-

Hitchcock v. Tremaine.

tained the testimony which they now wish to adduce, prior to the former hearing. On the contrary, the evidence shows that they could.

(4.) A careful review of the testimony given by Mrs. Louis, Bioren, and Frail, in regard to the alleged prior invention by Louis, leads to the undoubting conclusion, that, whatever he made resembling the plaintiffs' fan, in form, location, and operation, was an unsuccessful experiment, so far as he preceded Carpenter in time. The collateral evidence leads to the same conclusion. The patent to Louis, of June 10th, 1862, shows that, at that time, he had no invention of a fan external to the air passages. The newspaper publications show no such invention. And the testimony on the part of the plaintiffs is conclusive to show, that, prior to Carpenter's invention, patented in June, 1865, and even down to 1867, Louis had nothing in the way of an external rotating fan, except what may have been merely experimental, and was not considered by himself to be of any importance compared with other devices he employed to produce a tremolo. This is one of those cases, so often met with in the history of patents, where an invention, once perfected, has shown itself to be so useful and so highly appreciated as to have gone at once into so extensive use, that it is inherently impossible it should have been known before, and not have gone into general use. Its success leads infringers and rival inventors to set up crude and unsuccessful experiments as anticipating it, and dim recollections are stimulated, and conscience is strained, to clothe with living flesh what was an inert and useless skeleton.

The prayer of the petition is denied, with costs.

Barnes v. Straus.

FRANCES L. BARNES, EXECUTRIX OF, &C., OF SAMUEL H.
BARNES, DECEASED

vs.

, FERDINAND STRAUS. IN EQUITY.

The invention described in reissued letters patent granted to Frances L. Barnes, executrix of, &c., of Samuel H. Barnes, deceased, August 31st, 1869, for an "improvement in corset-springs," the original patent having been granted to said Samuel H. Barnes, as inventor, July 17th, 1866, is, the arrangement in a pair, combined by clasps, on a corset, of two springs, each spring consisting of two metallic plates, placed one upon another, and fastened together at their centres, but so connected, at or near each end, that they can play or move upon each other in the direction of their length, and be prevented from sliding off each other laterally.

Such arrangement did not exist before the invention of Barnes.

The claims of such reissued patent are valid, and claim, under the expression, "a pair or set of corset springs," two corset-springs connected by clasps, each spring being constructed as above mentioned.

The invention held not to have been anticipated by a carriage spring which existed before, or by a single corset-spring, composed of two plates, with provision for play, but with no means for combining it with a second spring.

The combination, consisting of the two springs connected by the clasps, exists, *pro tanto*, so as to be an infringement, when the springs and clasps are made, ready to be inserted in a corset.

(Before BLATCHFORD, J., Southern District of New York, May 23d, 1872.)

BLATCHFORD, J. This suit is brought on reissued letters patent granted to the plaintiff August 31st, 1869, for an "improvement in corset-springs," the original patent having been granted to Samuel H. Barnes, as inventor, July 17th, 1866, and reissued to the plaintiff, May 12th, 1868, and again June 29th, 1869. In the specification it is stated that Barnes invented "a new and improved corset-spring." The specification says: "The present invention consists in forming the

Barnes v. Straus.

springs of corsets of two or more metallic plates, placed one upon another, and fastened together at their centre, but so connected, at or near each end, that they can play or move upon each other in the direction of their length, as the springs are bent, whereby their flexibility and elasticity are greatly increased, while at the same time much strength is obtained, and the springs rendered much more durable than the springs for corsets now in general use." There are two figures in the drawings, one giving a front view "of the two springs of the corset," that is, one spring of two plates on one side of the vertical opening in the corset, and another spring of two plates on the other side of such opening, "having the ordinary clasps for fastening the corset about the waist of the person who is to wear it." The specification states that the drawings represent two springs of a corset, properly bent in the direction of their length, to conform to the body or waist of a person, each spring composed of two metallic plates, placed one upon the other, the under one a little longer than the upper one, and secured at their centres, or midway between their two ends, this being done, in one of the springs, by the rivet which secures the ordinary corset clasp to the spring, and, in the other one, by a headed rivet on which such clasp is interlocked by its eye; that, at or near each end of each short plate, is a short slot, extending in the direction of its length, through which projects the rounded end or head of a pin fixed in the under plate; and that, by means of these slots, as the corset-springs are bent, the plates constituting the same can play or move, the one upon the other, the heads of the pins preventing the plates from springing apart from each other or sliding off laterally. The specification proceeds: "From the above description, it is plain to be seen, by forming the corset-springs of two plates, (one or more may be used, if desired, laid one upon the other, but so connected together, that the several plates constituting such springs can freely play upon each other in the direction of their length,) that the flexibility, pliability or elasticity of the springs is much increased, without in the least degree impairing their

strength, rendering them much more durable and serviceable than the ordinary corset springs now in general use—an advantage and result of the utmost importance and utility. Although the springs have been herein above explained as formed of two metallic plates, laid one upon the other, and secured together as described, three or more may be used, but two are sufficient for ordinary corsets, it being distinctly understood that this invention is not limited to any particular number of plates which may be employed to form the springs, whether one or more, it simply consisting in so securing the several plates constituting the springs, to each other, that they can freely move or play upon each other. It may be stated that the terms “corset-steel,” “corset-spring” and “corset-clasp,” are each and all employed by the trade to designate a pair of springs, steels or stiffeners, connected by suitable clasps, whereby they are not only adapted to stiffen the front of the corset, but to fasten the two edges of the same together.” The claims are these: “(1.) A pair or set of corset springs, each spring consisting of two or more metallic plates, placed one upon another, and fastened together at their centres, but so connected, at or near each end, that they can play or move upon each other in the direction of their length, and be prevented from sliding off each other laterally. (2.) A pair or set of corset springs, each spring composed of two or more metallic plates, placed one above another and fastened together at their centres, and so connected, at or near each end, that they can move or play upon each other in the direction of their length. (3.) A pair or set of corset-springs, each spring consisting of two or more metallic plates, placed one upon another, and fastened together at their centres, but so connected, at or near each end, that they can play or move upon each other in the direction of their length, and be prevented from sliding off each other laterally, the clasps by which the springs are combined, except the centre one, being attached to only one of the plates.”

The patent is attacked for want of novelty. The evidence shows that the arrangement in a pair, combined by clasps, on

a corset, of two springs, each spring consisting of two metallic plates, placed one upon another, and fastened together at their centres, but so connected, at or near each end, that they can play or move upon each other in the direction of their length, and be prevented from sliding off each other laterally, did not exist before the invention of such arrangement by Barnes. The arrangement is useful, and Barnes invented it. Was the invention a patentable one, in view of what existed before?

The "ordinary" springs for corsets, referred to in the specification as "in general use," consisted of two springs, one on each side of the vertical opening in the corset, each formed of a single metallic plate, and the two springs being combined by clasps, the same as are referred to in the specification as the "ordinary corset-clasp," consisting of a clasp with an eye on one spring and a head on the other spring. The whole arrangement and combination constituted, as the specification says, a "corset-spring," embracing the two springs, one on each side of the vertical opening in the corset, connected by the clasps. In this arrangement, Barnes substituted, for the single-plate springs, double-plate springs. By having two plates he secured greater strength. But, in order to maintain the flexibility of the spring, and prevent danger of fracture to the metal, in the bending of it, in use in the corset, he fastened the two plates together at their centres, and made lengthwise slots in the upper plate, near its end, through which headed pins, fastened to the lower plates, projected, which allowed the two plates to slide along each other lengthwise, when bent, while the headed pins prevented the plates from slipping by each other sidewise or springing apart from each other facewise. This provision was necessary in order to develop the advantage of a spring made of two plates; and, in order not to prevent such sliding action of the plates, it was further necessary that the clasping devices, other than those at the centre of the length of the spring, should not be fastened through both plates. All this Barnes did, and this, in fact was his real invention. He did not merely substitute two plates for one plate.

Barnes v. Straus.

It being thus seen what Barnes did, the claims of the patent must be construed, if that can properly be done, so as to cover his real invention. Although the specification, in one place, speaks of the invention as consisting in making a spring of two plates which can play upon each other in the direction of their length, as the spring is bent, and, in another place, speaks of it as consisting in so securing the plates constituting the springs, to each other, that they can freely play upon each other, yet, in view of the whole specification, and of the fact that it says that the term "corset-spring" is employed, by the trade, to designate a pair of springs, connected by suitable clasps, and thus adapted not only to stiffen the front of the corset, but to fasten its two edges together, the expression, "a pair or set of corset-springs," where it occurs, in each one of the three claims, cannot be construed to mean anything else but two corset-springs connected by the clasps referred to, each spring being constructed in the manner described. In this view, the claims of the patent are all of them valid.

A spring existed before, used in a carriage, which consisted of several metallic plates, placed one upon another and fastened together at their centres, the shorter ones above the longer ones, but so connected at or near each end, by headed pins playing in and through slots, that they could move upon each other in the direction of their length, and be prevented from sliding off each other laterally. I think the evidence shows that there was something more than the mere new use of an old article, and more than the mere use of an old article for a new purpose, and more than the mere use of two springs, one of which had been used before, in making the combination which Barnes made. The carriage-spring differed from the corset-spring in not having that flexibility at the centre of its length which the corset-spring has and must have, and in not curving in one direction at one end and in the other direction at the other end, as the corset-spring is shown in the drawings of the patent to do. In other words, the carriage spring was not a corset-spring, and could not be used as such, without such a change as involved invention.

Barnes v. Straus.

The French corset-spring put in evidence was a single spring, not a combined pair of springs ; and, although it was composed of several metallic plates, placed one above another and fastened together at their centres, and free to move or play upon each other in the direction of their lengths, yet it had no such provision as the slots and fixed pins with heads, which Barnes introduced, nor any other provision for preventing the plates from becoming disengaged facewise or laterally. The French spring had no means of combining it with a second spring, when the two should be used one on each side of the vertical opening in a corset.

The pair of springs of the patent, that is, the two springs connected by the clasps, constitute, as a whole, a patentable combination. The two springs and the clasps connecting them are all required to make the article, as "a corset-spring," at all useful, in performing the functions which it performs when the springs are actually combined by the clasps when the corset is worn. The combination does not have its full effects developed until it is used in the corset, yet it exists *pro tanto*, so as to be an infringement, when the springs and clasps are made, ready to be inserted in a corset. The elements which make up the combination called "a corset-spring" co-operate mechanically to a common mechanical end, which end is developed in the use of the springs and clasps in the corset when worn. The fact that the clasps were used before with the single springs, does not destroy the novelty and patentability of the combination and arrangement made by Barnes.

There must be a decree for the plaintiff, for a perpetual injunction and an account, with costs, as the infringement is not denied.

George Gifford, for the plaintiff.

Charles F. Blake, for the defendant.

JOHN H. PLATT, AS ASSIGNEE IN BANKRUPTCY OF THE
STUYVESANT BANK

vs.

OLIVER H. P. ARCHER. IN EQUITY.

A banking corporation being insolvent, a receiver of its property was appointed by a State Court, on the 13th of October. On that day, its cashier gave up to the receiver the keys of the bank, and became his clerk, on a salary, and, from that time, ceased to act as cashier, but was never displaced from his official relation to the corporation as cashier. On a petition in involuntary bankruptcy, filed on the 23d of December, against the corporation, in the District Court, alleging the appointment of such receiver as an act of bankruptcy, an order to show cause was served on such cashier, on the 28th of December. On the 29th of December, a judgment was entered in a State Court, dissolving the corporation. On the 6th of January, the corporation was adjudged bankrupt: *Held*, that the service of the order to show cause was sufficient to give the District Court jurisdiction to make the adjudication. *Held*, also, that the District Court had jurisdiction to make the adjudication, notwithstanding the dissolution of the corporation.

A corporation, subject to the provisions of the bankruptcy Act, and which has committed an act of bankruptcy, and is in existence when the petition against it is filed, and when the proper papers are served on its proper officer, cannot oust the jurisdiction of the bankruptcy Court to proceed, on the return day, to an adjudication, because a decree dissolving the corporation has been made after such service and before such return day.

It appearing, by the order of adjudication, that no one appeared in opposition, and that the corporation was called in open Court, and came not, but made default to appear, and it not appearing that the receiver appeared and asked, as representing the corporation and its property, to be heard, by answering the petition, and was refused leave to do so, it cannot be said that the corporation, although dissolved, had no opportunity to be heard.

A proceeding in involuntary bankruptcy is, substantially, a proceeding *in rem*, especially in a case against a corporation.

An assignee in bankruptcy of the corporation having been appointed, he brought

Platt v. Archer.

a suit in equity, in this Court, against the State Court receiver, to set aside, as in fraud of the bankruptcy Act, the transfer of the property of the corporation to such State Court receiver, made by the operation of the order of the State Court appointing such receiver. On the filing of the bill, and on notice to such receiver, this Court granted an injunction restraining him from executing the trusts of his receivership, and appointing, pending the suit, a receiver of the property transferred to him, and of its proceeds.

At the first meeting of the creditors under the bankruptcy, the defendant was nominated a trustee, under the 43d section of the Act, and three persons were nominated a committee of the creditors, under that section. No assignee was chosen, and the meeting was finally closed, votes for an assignee having been given for another person than the defendant. The District Court refused to confirm the action in regard to a trustee and a committee, and appointed the plaintiff to be assignee in bankruptcy of the corporation. The defendant and two of the three persons nominated as a committee, brought a petition, in this Court, for a review and reversal of the order of adjudication, and of the order refusing to confirm the nomination of a trustee and a committee, and appointing the plaintiff assignee. The petition had not yet been brought to hearing. It being suggested, that the defendant's claim of title, as trustee, and the plaintiff's claim of title, as assignee, ought not to be decided until the action of this Court on such petition, it considered the points sufficiently to be able to say that it did not perceive in them any ground for refusing any relief it would otherwise grant.

The plaintiff was appointed receiver, on stipulating to charge no commissions on such assets of his receivership as should pass therefrom to the trust represented by the assignee of the bankrupt.

(Before WOODRUFF and BLATCHFORD, JJ., Southern District of New York, May 31st, 1872.)

BLATCHFORD, J. On the 13th of October, 1871, the Supreme Court of New York, in a suit brought by William R. Barr against the Stuyvesant Bank, and on a verified complaint and sundry affidavits therein, made an order restraining the bank from exercising any of its corporate franchises, and from collecting or transferring any of its moneys or property, until the further order of the Court, and appointing the defendant in this suit to be receiver of its property. Such suit was commenced on the 12th of October. The gravamen of the complaint was, that the bank was insolvent and unable to pay its debts. The bank appeared in the suit by attorney, on the 12th of October, and its counsel consented,

in open Court, to the making of the order of the 13th of October.

On the 13th of November, the Supreme Court, in a suit brought by the People of the State of New York against the bank, and on a summons, a complaint, affidavits, and due notice, counsel for the bank appearing and opposing, made an order enjoining the bank from exercising any of its corporate franchises, and from collecting or transferring any of its moneys or property, and appointing the defendant in this suit to be receiver of its property. The complaint set forth the insolvency of the bank.

On the 23d of November, no answer or demurrer having been put in, in the suit brought by Barr, a judgment was entered therein, awarding a perpetual injunction against the bank, and appointing the defendant in this suit to be its receiver, but not dissolving the corporation.

On the 23d of December, John Mack filed, in the District Court of the United States for this District, a petition in involuntary bankruptcy against the bank, setting forth, as one of the acts of bankruptcy, the procuring and suffering its property to be taken on legal process by the defendant in this suit, as receiver, with intent to defeat the operation of the bankruptcy Act. On the filing of the petition, an order to show cause, returnable on the 6th of January, 1872, was, on the 23d of December, issued. The order directed that a copy of the petition, and of the order, should be served on the president of the bank.

On the 27th of December, an answer of the bank, in the suit brought by the People, denying, on information and belief, its insolvency, was sworn to by John Van Orden, who, in the affidavit, says, that he "is cashier of the Stuyvesant Bank." This answer was subsequently put in in the suit.

On the 28th of December, on an affidavit of the absence of the president of the bank, and that Van Orden was cashier, an order was made by the District Court, that a copy of the petition, and of the order to show cause, be served

Platt v. Archer.

on the bank, by serving it on Van Orden, its cashier. Such service was made on Van Orden on the 28th of December.

On the 29th of December, in the suit brought by the People, judgment on the answer as frivolous was given against the bank, and it was adjudged that the charter of the bank "is declared to be forfeited, and the said corporation, composing the said bank, is hereby dissolved," and that the defendant in this suit be continued as receiver, and be appointed receiver of all the property of the bank, and that the bank be enjoined from collecting any debts, and transferring any money or property, and from transacting any business whatever.

On the 6th of January, 1872, on proof of such service of a copy of the petition and order to show cause on the cashier of the bank, no one appearing in opposition, and the bank being called in open Court, and making default in appearing pursuant to the order to show cause, the usual order of adjudication was made by the District Court, setting forth, that, on consideration of the proofs, it was found that the facts set forth in the petition were true, and adjudging that the bank became bankrupt, within the true intent and meaning of the bankruptcy Act, before the filing of said petition, and declaring and adjudging it bankrupt accordingly, and referring it to a register to take the proceedings required by the Act.

At the first meeting of the creditors of the bankrupt, held, in pursuance of the warrant issued to the marshal, for the choice of assignee, it was resolved, by three-fourths in value of the creditors whose claims had been proved, that it was for the general interest of the creditors of the bankrupt that the estate of the bankrupt should be wound up and settled, and distribution made among the creditors, by trustees, under the inspection and direction of a committee of creditors, and that the defendant in this suit be nominated as trustee, to take, hold, and distribute said estate; and that Richard Kelly, the Reverend John Orcutt, and Richard H.

Bull, president of the New York Savings Bank, be the committee of creditors, under whose direction the said trustee should act. This resolution was duly certified to the District Court by the register. The register also certified, that the first meeting of creditors was convened on the 7th of February, and was finally closed on the 13th of February; that, at the meeting, votes were cast for assignee, the names of the voters, and the amounts of the debts on which they voted, and the name of the person for whom such votes were cast, being returned, and such person not being the defendant herein; that there was an opposing interest to the appointment of an assignee by the register, in the action of the creditors in nominating a trustee; that no choice of assignee was made by the creditors; and that the register had made no appointment of assignee, believing that such action of the creditors was such an opposing interest as would render his appointing one irregular and void.

On the 16th of March, the defendant in this suit, on notice and on affidavits, applied to the District Court for the confirmation of the action of the creditors, in respect to a trustee and a committee. This motion was opposed on affidavits, and, by an order made on the 22d of March, the Court denied the motion, and appointed the plaintiff in this suit to be assignee of the estate and effects of the bankrupt. From the decision rendered by the District Judge, it appears that he was of opinion, on the papers before him, that the interests of the creditors would not be promoted by the appointment of the defendant in this suit as trustee, and that, therefore, he declined to confirm such resolution. The principal ground stated for this conclusion was, that, as the appointment of the defendant in this suit as receiver by the State Court was one of the grounds on which the bank was adjudged bankrupt, and he still continued to be such receiver, and claimed to hold, as such receiver, what remained in his hands of the property of the bank which had passed to him, and had been dealing with the rest as such receiver, and, if he was to account for it at all to the District Court, must account for it

as of the day the petition in bankruptcy was filed, and to a trustee or assignee to be appointed by the District Court, and, as it appeared that he did not intend to voluntarily surrender to any trustee or assignee to be appointed by the District Court, the property still in his possession, and did not intend, if confirmed as trustee by the District Court, to cease acting as receiver, but announced his intention to act both as receiver and as trustee, and to have his acts authorized by the State Court, and by the District Court, it was not proper that he should, as trustee, be plaintiff, and, as receiver, be defendant, in respect to the matters involved, and he could not be allowed to occupy the incompatible position of being a trustee under the bankruptcy Act, and looking to the State Court as partly the source of his authority, or of holding the property as receiver, under the State laws, and administering it under the authority or direction of the District Court. It further appears, from the decision of the District Judge, that he regarded it as an objection to confirming the proceedings, that the bank of which Mr. Bull, one of the three persons named as the committee of creditors, was president, claimed, by its proof of debt, to be entitled to a preference under the statutes of New York, and to be paid, in full, in priority to others, in a distribution of the assets under the bankruptcy Act, and that such claim of preference was contested by creditors who were unsecured, and who claimed no preference. The view of the Judge was, that the creditors had undertaken to select a committee consisting of three persons, and had thus expressed their desire that the committee should consist of three persons; that their action under the statute was a unit, and their resolution must be confirmed as a whole, or not at all; and that it was improper that Mr. Bull should be one of the committee, under whose direction the estate of the bankrupt was to be wound up and settled. The Judge regarded the case as having arisen where, under section 13 of the Act, it became the duty of the Court to appoint an assignee, the resolution nominating a trustee not being confirmed, and no choice of an assignee having been made by the creditors.

An assignment, in due form, under the Act, was executed by the District Judge to the plaintiff in this suit on the 22d of March, of all the estate which the bankrupt had on the 23d of December, 1871.

On the 23d of March, the defendant in this suit and Bull and Orcutt filed in this Court a petition praying for a review and reversal of the order of adjudication made by the District Court, and of the order refusing to confirm the nomination of a trustee and a committee, and appointing the plaintiff in this suit to be assignee. The petition of review sets forth, as objections to the orders, (1.) That the District Court had no jurisdiction over the bankrupt, it having been dissolved by a judgment of a competent Court before the adjudication; (2.) That it had no jurisdiction over the assets of the bankrupt, they having become vested in a receiver duly appointed by the State Court. If it should be held that the District Court had such jurisdiction, then it is objected, by the petition, to the order of the 22d of March, that it refused, (1.) To confirm the resolution nominating the defendant in this suit as trustee; (2.) To confirm the resolution nominating the three persons as a committee; (3.) To confirm at least two of the committee. If it should be held that the District Court had such jurisdiction, and that it was proper for the District Judge to refuse to confirm as aforesaid, then it is objected, by the petition, to the order of the 22d of March, (1.) That it appoints the plaintiff in this suit assignee, when less than one-tenth of all the creditors who had proved their claims had voted for him, while more than nine-tenths had voted for the appointment of a trustee; (2.) That the appointment of such assignee was not authorized by law, it having been the duty of the Court to direct the bankruptcy to proceed as though no resolution had been passed, and to make all necessary orders for resuming the proceedings, and thereupon to direct that all further proceedings (if any proceedings whatever were, under the circumstances, valid) be remitted to said register, and that an election of a new trustee or an assignee thereupon take place. This petition of review has not yet been brought to hearing before this Court.

On the 25th of April the plaintiff in this suit obtained an order from the State Court, granting him leave to bring this suit.

The bill in this suit sets out that, on the 13th of October, 1871, the Stuyvesant Bank was a corporation created by the State of New York, and was insolvent; that it was adjudged a bankrupt by the proceedings before mentioned; that, within four months before the filing of the petition against it, it, being insolvent, made a transfer of its property to the defendant, who then had reasonable cause to believe it to be insolvent, within the 35th section of the bankruptcy Act, the transfer being made by means of the order made on that day in the suit brought by Barr; that the defendant had reasonable cause to believe the bank to be insolvent, and that the transfer was made in fraud of the provisions of said Act, and with a view to prevent the property of the bank from coming into the possession of its assignee in bankruptcy, and to prevent it from being distributed under said Act, and to defeat the object of, and impair, hinder, impede and delay, the operation and effect of, and evade the provisions of, said Act; that the transfer was not made in the usual and ordinary course of business of the bank; that, on the said 13th of October, the bank, being insolvent, did, with intent, by such disposition of its property, to defeat and delay the operation of said Act, and with intent to delay, defraud and hinder its creditors, transfer its property to the defendant in this suit, and procure and suffer its property to be taken by him on legal process; that such legal process consisted in the orders and judgments of the State Court, before referred to; that the trust created by said legal processes, and transfer, and appointment of the defendant as receiver, was a trust created in fraud of the creditors of the bankrupt, and the property affected thereby was conveyed by the bankrupt to the defendant in fraud of its creditors, within the meaning of the 14th section of the bankruptcy Act, and the transfer was void within the meaning of the 35th section, and the legal process was void within the meaning of the 39th section, and the defendant had reasona-

Platt v. Archer.

ble cause to believe that a fraud on the Act was intended, and that the said debtor was insolvent; that the defendant has, on demand, refused to give to the plaintiff (whose title is set out) an account and the possession of such property, and claims a title and interest adverse to the plaintiff touching said property; that such property consisted of real, personal and mixed property; that a large proportion of it consisted of claims and choses in action against persons who were indebted to the bankrupt at the time such orders were made by the State Court; and that, to reduce the same to the possession of the plaintiff by actions at law, or to compel the defendant to respond for the value of the property in actions at law, would require a large number of suits, and a discovery and an accounting by the defendant. The bill prays that said transfer may be decreed to be void as against the plaintiff, and that the said legal processes may be adjudged to be, as against the plaintiff, void, and that the property affected thereby may be adjudged to be vested in the plaintiff, and that the defendant may account for the same, and for the disposition made by him of the same, and of the proceeds thereof, and deliver to the plaintiff so much of such property as remains in his hands, and the proceeds of such of it as he shall have disposed of, and that he be enjoined from disposing of or interfering with said property, and from setting up and asserting, as against the plaintiff, any title to, or right of action for, any of said property, and that, pending this action, and by final decree, he may be enjoined from doing any act to carry out or effectuate the trusts purporting to be created by his appointment as receiver, or from distributing the property affected by such receivership, otherwise than by the permission and direction of this Court, and that, pending this action, and by final decree, a receiver of the property transferred to him, or in his possession, and of its proceeds, may be appointed, with the usual powers of a receiver in like cases. The plaintiff now moves, on notice, for an injunction restraining and enjoining the defendant, pending this action, pursuant to the prayer of the bill, and also for the appointment of a receiver, pending this action, pursuant to the prayer of the bill.

It is claimed that the District Court had no jurisdiction to adjudge the bank a bankrupt, because the petition and the order to show cause were not served on any one who did or could represent the bank, and that Van Orden was not, at the time of the service, the cashier of the bank. This allegation is made on the ground that, on the 13th of October, Van Orden gave up to the defendant the keys of the bank, and became his clerk, on a salary, and ceased to act as cashier, and did not act as cashier from that time prior to the judgment of dissolution. But there was nothing in this which displaced Van Orden from his official relation to the corporation as cashier, as is also apparent from his own oath on the 27th of December, that he was then cashier. The corporation was in being on the 28th of December, when the papers were served on Van Orden, and he was still its cashier for the purpose of being served, as its proper representative, with such papers. If, at any time prior to the judgment of dissolution, the State Court had discharged the receivership, and directed the property of the corporation to be restored to its officers, Van Orden would have been a proper officer, as its cashier, to receive the property, without any new appointment of him as such.

It is also objected, that the bank had no existence when the adjudication was made. But we cannot admit it to be a tenable proposition, that a corporation, subject to the provisions of the bankruptcy Act, and which has committed an act of bankruptcy, and is in existence when the petition against it is filed, and when the proper papers are served on its proper officer, can oust the jurisdiction of the bankruptcy Court to proceed, on the return day, to an adjudication of bankruptcy, because a decree dissolving the corporation has been made after such service and before such return day. The papers having been properly served on an officer of the bank, while the bank was in being, and the bank being called and making default to appear, the order of adjudication is substantially a proceeding *in rem*, and not one *in personam*, the order being, that, the facts in the petition being found to be true, it is adjudged that the bank became bankrupt before

the filing of the petition, and is accordingly adjudged bankrupt. The judgment is, that the bank became bankrupt before the filing of the petition, by having committed the acts of bankruptcy set forth in the petition, and which it committed while it was in being, and that it is adjudged bankrupt in respect of the administration of its property subject to the Act, by reason of so having committed such acts of bankruptcy.

Independently of this view, no doctrine can be admitted which would place it in the power of a State, or of the Courts of a State, to render nugatory the operation of the Act in respect to such corporations as are subject to it. To concede that what was done in the present case operated to deprive this Court of the jurisdiction which attached by the filing of the petition and the service of the order to show cause, would be to concede that the Legislature of the State might lawfully provide, by a statute to be carried into effect by proceedings in its Courts, that the institution of proceedings in bankruptcy against an insolvent corporation, and the service of an order to show cause on its officers, should operate to dissolve the corporation, to be followed, as a consequence, by a defeat of the jurisdiction of the bankruptcy Court. The authority of Congress to pass the bankruptcy Act is paramount and exclusive, and so is the jurisdiction of the District Court thereunder. The 39th section of the Act provides, that the debtor who commits any of the acts specified in that section shall be deemed to have committed an act of bankruptcy, and, subject to the conditions thereafter prescribed, shall be adjudged a bankrupt. It is not one of those conditions that a corporation debtor, if in being when the petition is filed and the order to show cause is served, shall continue undissolved until after the adjudication. As respects a corporation proceeded against involuntarily, the proceeding is eminently one *in rem* against its property, as it cannot be discharged from its debts, nor can its members be discharged from their liability as such for its debts, and the proceeding is one solely for the distribution of its assets among its creditors. The prayer of the petition in this case, according to the form prescribed, was, that the cor-

poration might be declared a bankrupt, and that a warrant might be issued to take possession of its estate, and that the same might be distributed according to law. Although the assignment to the assignee relates back to the commencement of the proceedings in bankruptcy, as declared by the 14th section, yet, by the 14th, the 35th and the 39th sections, the assignee is vested with the title to recover, as assets of the bankrupt, property conveyed or transferred by or out of the bankrupt, in fraud of his creditors, or in fraud of the Act, before the filing of the petition in bankruptcy. We are entirely satisfied that the dissolution of the corporation in the present case had no effect to deprive the District Court of its jurisdiction.

The suggestion that judgment was pronounced against the corporation without giving it an opportunity of being heard, is answered by the considerations already adverted to. The corporation had all the opportunity of being heard which the District Court could or was bound to afford to it. Regarding the proceeding as one *in rem*, there is nothing in the record of the proceedings in the District Court to show that the receiver, as claimant of the property, desired to be heard as presenting the corporation and such property, and was refused a hearing. In the case of *In re Independent Insurance Co.*, (6 *National Bankruptcy Register*, 169 and 260,) receivers of a dissolved State corporation were admitted to file a plea to the jurisdiction of the bankruptcy Court, and such plea was heard on the merits and overruled. In the present case, the order of adjudication recites that no one appeared in opposition, and that the bank was called in open Court, and came not, but made default to appear. If the receiver had appeared and asked, as representing the bank and its property, to be heard by answering the petition, and been refused leave to do so, a different question would be presented.

Nor do we perceive any force in the position, as applied to this proceeding in bankruptcy, that it abated by the dissolution of the corporation, so as to be incapable of being proceeded with thereafter. The views we have already an-

Platt v. Archer.

nounced involve the kindred conclusion, that the proceeding did not abate.

On the undisputed facts in this case, the plaintiff is entitled to the relief he seeks on this motion. In regard to the points raised by the petition of review respecting the action of the District Court in not confirming the resolution of the creditors nominating a trustee and a committee, and in appointing the plaintiff to be assignee, the petition has not been heard before this Court, but, in view of the suggestion by the defendant, that his claim of title, as trustee, and the claim of title by the plaintiff, as assignee, ought not to be decided until the action of this Court on the petition, we have considered those points sufficiently to be able to say, that we do not perceive in them anything which ought to constrain us to refrain from granting to the plaintiff any relief which we should otherwise deem it proper to grant.

It is proper that the injunction asked for should issue, and that the plaintiff should be appointed receiver, he stipulating to charge no commissions on such assets of his receivership as shall pass therefrom to the trust represented by the assignee of the bankrupt.

Judge WOODRUFF concurs.

Francis N. Bangs, for the plaintiff.

David Dudley Field and Dudley Field, for the defendant.



APPENDIX.

I.

Rule of the Circuit Court of the United States for the Southern District of New York, adopted since the publication of the eighth volume of these Reports.

OCTOBER 2d, 1872.

Rule 55 of the Rules of the Circuit Court of the United States for the Southern District of New York is amended so as to read as follows :

When a cause is noticed for trial or argument for the first day of the term, a notice thereof, with a note of the issue and of the pleadings, and of the attorneys' names, shall be delivered to the clerk at least eight days next preceding the term; and the clerk shall, as early as the following Thursday, have the calendar of causes to be tried made up, arranging them according to the dates of their issues. And no cause shall be put upon the calendar without the special order of the Court, unless the note of issue shall be furnished as is hereby required.

Rule of the Circuit Court of the United States for the Eastern District of New York, adopted since the publication of the eighth volume of these Reports.

OCTOBER 15th, 1872.

On the hearing of appeals in Admiralty, the appellant shall furnish to the Court a printed copy of the Apostles, certified by the clerk of this Court, unless, by special order of the Court, obtained before the hearing, such printing, or some part thereof, shall be dispensed with. Such portion of the Apostles as may have been printed for the use of the District Judge may be furnished without reprinting. A printed copy of whatever is printed and furnished under this Rule shall be served on the proctor for the appellee, at least eight days before the hearing.



INDEX.

A

ACTION.

1. By the 15th section of the Act of June 30th, 1864, (13 *U. S. Stat. at Large*, 215,) the decision of a collector of customs, as to fees, charges and exactions claimed by him in the performance of his official duty, is declared to be final and conclusive, unless an appeal is taken to the Secretary of the Treasury, and it is provided that no suit shall be maintained to recover any such fees, &c., alleged to have been erroneously or illegally exacted, until the decision on such appeal is had. A vessel from a foreign port, with dutiable goods on board, arrived at New York, and was there sold, under a decree on a libel in admiralty, to the plaintiff. The duties on the goods not being paid or secured, the inspectors in charge, under the order of the collector, took the goods to the public stores, according to the provisions of § 56 of the Act of March 2d, 1799, (1 *U. S. Stat. at Large*, 669,) and of the Act of March 2d, 1861, (12 *Id.*, 209.) The collector exacted from the plaintiff the fees, charges and expenses connected with the removal of the goods, as a condition of granting to him a clearance for the vessel for an outward voyage. The plaintiff paid the amount, under protest, but did not appeal to the Secretary of the Treasury, and then brought this suit to recover back the amount paid: *Held*, that, although the exaction was, in fact, not warranted by law, the suit could not be maintained, because of the failure to appeal to the Secretary of the Treasury. *Shaw v. Grinnell*, 471.

ADMIRALTY.

See COLLISION.
DAMAGES, 1, 2.
JURISDICTION.
LIEN, 1 to 4.

AFFIDAVIT.

See PRACTICE, 3.

APPEAL.

1. Where a suit in equity is brought in the District Court, under the jurisdiction conferred on that Court by the 2d section of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 518,) by an assignee in bankruptcy, against a person claiming an adverse interest, touching property vested in the assignee, no appeal can, before a final decree in the suit, be taken to this Court, by the defendants therein, from an interlocutory decree made by the District Court. *Clark v. Iselin*, 196

See BANKRUPTCY, 6, 7, 13, 14, 19, 21, 25

ATTACHMENT.

See BANKRUPTCY, 8 to 10

B

BANKRUPTCY.

1. The Boston, Hartford and Erie Railroad Company was a corporation, chartered by the State of Connecti-

cut. It afterwards received a grant of corporate privileges, and was declared a corporation, by an Act of the Legislature of the State of Massachusetts, in which State it had an office, and carried on business. In October, 1870, a petition was filed by A., in the District Court for Massachusetts, in bankruptcy, upon which the corporation was, on the 2d of March, 1871, adjudged bankrupt. In December, 1870, J. filed a petition in the District Court for Connecticut, praying that the corporation be adjudged a bankrupt by that Court. Pending this latter petition, A. petitioned the District Court for Connecticut, and set forth, in his petition, and in a supplemental petition, his proceedings in Massachusetts, and the adjudication there made, averring, also, that the proceedings in Connecticut were collusive between the corporation and J., and would prejudice the creditors of the corporation, create expense and conflict, and embarrass the settlement of the estate, and praying that he, A., might be allowed to appear and defend against the petition of J. The District Court for Connecticut dismissed such petition of A., and proceeded to an adjudication of bankruptcy against the corporation, and issued a warrant:

Held, (1.) That, A. being, in fact, a creditor of the corporation, his petition to the District Court for Connecticut should have been entertained, and that the facts set forth therein warranted his intervention;

(2.) That, whether the bankrupt was to be regarded as a single corporation, or as two corporations, united in interest, having one and the same corporators, and common property, rights, and franchises, and owing the same creditors, the District Court for Massachusetts should be permitted to exercise the jurisdiction it had acquired over the bankrupt and the estate, and carry the proceedings in bankruptcy to their final conclusion, without the interference of the District Court for Connecticut, and that all proceedings in that Court should be stayed. *In re Boston, Hartford & Erie R. R. Co.*, 101

2. In a proceeding in involuntary bankruptcy, the alleged debtor may deny

that the petitioner for an adjudication is a creditor, and may, if he maintains such denial by proof, have the petition dismissed. *In re Cornwall*, 114

3. Where a person, whose property exceeds in value all that he owes, with a view to the payment of his debts, and to secure to himself a maintenance in the future, conveys that property to another, on an agreement that the grantee shall pay all that he owes, and support him during the residue of his life, such a conveyance is not, *per se*, fraudulent and void, as against creditors. *id*

4. Where the statutes of limitation of the State in which the petitioning creditor in a proceeding in involuntary bankruptcy and his alleged debtor reside, have created a bar to the recovery of the alleged debt by action, such debt cannot form a basis for an adjudication of bankruptcy on the petition; and the holder of a claim so barred is not entitled to prosecute such a petition. *id*

5. Where a debt is barred by the statute of limitations, a promise by the debtor to pay it when he is able, is conditional, and does not create an obligation, as a revival of the debt, until ability to pay appears; but, where there is a present debt, a promise to pay it when able does not destroy or postpone the right of the creditor to sue, or prevent the running of the statute. *id*

6. A claim proved in the District Court against the estate of a bankrupt was contested by the assignee and a creditor, and was allowed by that Court. The objecting creditor then petitioned this Court, under the 2d section of the bankruptcy Act of March 2d, 1867, (14 U. S. Stat. at Large, 518,) to review the decision of the District Court allowing the claim, and to disallow the claim: *Held*, that the petition must be dismissed; that the 2d section of the Act confers jurisdiction on this Court to review, in the manner prescribed by such section, the decisions of the District Court, only in cases where special provision is not otherwise made by the Act for the review of such decisions; that the

- 8th section of the Act makes provision for a review of the decision of the District Court allowing the claim of a creditor, by authorizing an appeal to this Court, by the assignee, from such decision; and that, although the 22d section gives to a creditor the right to institute an investigation into the validity of the claim of another creditor, yet, when an investigation has been had, and a decision as to the validity of the claim has been made by the District Court, the right of the objecting creditor to contest the claim ceases, and any further proceeding to review the decision must be taken by the assignee, by appeal, under the 8th section. *In re Troy Woolen Co.*, 191
7. Even if this Court can, in a suit in equity, brought in the District Court by an assignee in bankruptcy, to set aside an alleged preference averred to have been obtained in violation of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 517,) review, before a final decree is made in the cause by the District Court, an interlocutory order made by that Court therein, such review can be had only by means of an appeal, under the 8th section of the Act, and cannot be had by means of a petition of review under the 2d section of the Act. *Warren v. Tenth National Bank*, 198
8. A sheriff who, after proceedings in bankruptcy are commenced, wherein an assignee is appointed, levies an execution upon, and sells, property which was of the bankrupt, is liable to the assignee for the proceeds of such property, although he pays such proceeds to the execution creditor, before receiving actual notice of the bankruptcy. *Miller v. O'Brien*, 270
9. It makes no difference that, before the proceedings in bankruptcy were instituted, the sheriff seized, under an attachment in the suit in which the execution was afterwards issued, the property in question, and held it to be levied on in case execution should issue, or sold it by order of Court, and held its proceeds for the same purpose. *id.*
10. The operation of the bankruptcy Act dissolved the attachment, and the title of the assignee vested as of the time of the commencement of the proceedings in bankruptcy. *id.*
11. After the filing of a petition on which I. was adjudged a bankrupt, and after the appointment of an assignee, and the conveyance to him of all the estate of the bankrupt, S. commenced a suit, in a State Court, to foreclose a mortgage on real estate of I. The District Court, after restraining the prosecution of the suit, made an order dissolving the injunction, and permitting the suit to proceed. The mortgaged premises were worth less than one-half of the amount of the mortgage, the mortgage was given long before the bankruptcy of I., and there was no proof of the invalidity of the mortgage. On a petition of review, by I.: *Held*, that the order of the District Court was proper. *In re Iron Mountain Co.*, 320
12. The District Court has power to restrain the holder of a mortgage, or other lien, on the property of a bankrupt, from enforcing such lien by suit; and, where the value of the property exceeds the amount secured by the lien, or the amount or validity of the lien is in doubt, it is, in general, proper to do so. *id.*
13. The District Court, by an order entered June 25th, rejected and disallowed the claim of a creditor against the estate of a bankrupt, and awarded to the assignee costs against the claimant, to be taxed, and collected by execution. They were taxed April 8th, following. The District Court refused to enter, on the application of the claimant, a further or more formal judgment against the claimant for the amount of the taxed costs, the assignee not asking to have such judgment entered. On April 18th, the claimant gave notice of an appeal to this Court from the order of June 25th. The assignee moved to dismiss the appeal, on the ground that it was not brought within ten days after June 25th: *Held*, that the appeal must be dismissed, as not having been taken within the ten days limited by section 8 of the

- bankruptcy Act of March 2d, 1867. (14 *U. S. Stat. at Large*, 520). *In re Place*, 369
14. The order of June 25th was final, in such sense that an appeal would lie therefrom. *id.*
15. The District Court has, under the 1st section of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 517,) power to prohibit any proceeding in a State Court by a creditor, to liquidate and enforce a lien on the property of a debtor who is adjudged a bankrupt by such Court. *In re Clark*, 372
16. Such power is to be exercised summarily, and does not require a formal suit. *id.*
17. When the property affected by a lien is confessedly the property of the bankrupt, and has passed to the assignee, and it only remains to ascertain and liquidate the alleged lien, the summary jurisdiction of the District Court is entirely adequate. *id.*
18. The power of the bankruptcy Court to give further relief, in protection of the estate of the bankrupt, on a renewed application, on new or further evidence, after it has made one order in the premises, considered and sustained. *id.*
19. *Semble*, that the mode of review of an order made in the exercise of such summary jurisdiction, is not by an appeal under the 8th section of the bankruptcy Act. *id.*
20. An order of the District Court, restraining an alleged creditor of the bankrupt's from further prosecuting an action in a State Court, in which he had attached property of the bankrupt's, affirmed. *id.*
21. The jurisdiction of the Circuit Court, to review summary proceedings in bankruptcy, is not limited by any measure of the value of the property involved. *In re Clark*, 379
22. A petition of review, in bankruptcy, merely reciting the proceedings in the District Court, and its decree, and alleging that the petitioner is aggrieved thereby, and praying a review and a reversal, without pointing out any errors, or supposed errors, in law or in fact, or specifying any ground or reason for such reversal, except that the petitioner is aggrieved, commented on, as loose practice, not to be sanctioned. *id.*
23. Where property comes to the possession of an assignee in bankruptcy, as part of the estate of the bankrupt, and is taken from his possession under a writ of replevin, issued from a State Court, in a proceeding to which the assignee is not a party, and in which the title of the assignee is not in question, the District Court is bound to see that such possession by the assignee is not forcibly displaced. *id.*
24. A finding of fact, by the District Court, on the examination of witnesses in the presence of the Court, should not be reversed by the Circuit Court, without a very clear and decided conviction that it is erroneous. *id.*
25. The review given to the Circuit Court, by the 2d section of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 518,) is given to it as a Court of equity; and it is not bound to reverse upon strictly legal grounds, if satisfied that the facts are correctly found, and that no injustice has been done. *id.*
26. Declarations of the bankrupt, held to have been properly admitted in evidence, on the trial of a suit between the assignee and a third person, as to the title to certain property, as declarations made by him while in conspiracy with such third person to cover and conceal such property, and as part of the *res gestæ*. *id.*
27. Where an assignee in bankruptcy proceeded, in the District Court, by petition, to recover certain property, as assets of the bankrupt, and the respondent answered the petition, and did not object to the form or substance of the proceedings, or to the jurisdiction of the Court, but submitted to its jurisdiction, and set up, by his answer, his own title to the property, and prayed that the Court would ad-

- judge as to the title, between him and the assignee, and it did so adjudge, the Circuit Court, on review, will not consider the question as to whether a more formal suit would or would not have been proper. *id.*
28. A proceeding in involuntary bankruptcy, under section 59 of the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 536,) may be prosecuted in the District in which the debtor has carried on business for the requisite time specified in section 11 of that Act, although he resides and may be found in another District. *In re The Alabama & Chattanooga R. R. Co.*, 390
29. A railroad company, incorporated by the laws of a State, for constructing and operating a railroad, cannot be proceeded against, in bankruptcy, in a District Court without the State or States where its railroad is, or is to be, built, maintained and operated, on the petition of a creditor, charging an act of bankruptcy. *id.*
30. Allegation and proof that such company kept an office in such District for six months next preceding the filing of the petition, where its officers acted and its board of directors met, and where it contracted debts and made loans, purchases and payments, do not give such Court jurisdiction. *id.*
31. The business of a railroad company, within the meaning of the 11th section of the said Act, can only be carried on where the railroad is, or is to be, constructed, maintained and operated. *id.*
32. Hence, the District Court for the Southern District of New York has no jurisdiction to adjudge an Alabama railroad corporation a bankrupt, on the petition of a creditor. *id.*
33. The principle decided in *In re The Boston, Hartford and Erie Railroad Co.*, (*ante*, p. 101,) affirmed. *In re Boston, Hartford & Erie R. R. Co.*, 409
34. Under the bankruptcy Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 517,) where petitions for adjudication are filed in two or more District Courts, each having jurisdiction, the Court in which the petition is first filed ought to be accorded exclusive jurisdiction over the case. *id.*
35. An adjudication in bankruptcy was signed by the District Judge in New York, on March 1st, but was not made known, or promulgated, or filed, until March 3d. On March 2d, the District Court for Massachusetts made a decree adjudging the same debtor a bankrupt: *Held*, that the adjudication in Massachusetts was the prior adjudication. *id.*
36. A banking corporation being insolvent, a receiver of its property was appointed by a State Court, on the 13th of October. On that day, its cashier gave up to the receiver the keys of the bank, and became his clerk, on a salary, and, from that time, ceased to act as cashier, but was never displaced from his official relation to the corporation as cashier. On a petition in involuntary bankruptcy, filed on the 23d of December, against the corporation, in the District Court, alleging the appointment of such receiver as an act of bankruptcy, an order to show cause was served on such cashier, on the 28th of December. On the 29th of December, a judgment was entered in a State Court, dissolving the corporation. On the 6th of January, the corporation was adjudged bankrupt: *Held*, that the service of the order to show cause was sufficient to give the District Court jurisdiction to make the adjudication. *Platt v. Archer*, 559
37. *Held*, also, that the District Court had jurisdiction to make the adjudication, notwithstanding the dissolution of the corporation. *id.*
38. A corporation, subject to the provisions of the bankruptcy Act, and which has committed an act of bankruptcy, and is in existence when the petition against it is filed, and when the proper papers are served on its proper officer, cannot oust the jurisdiction of the bankruptcy Court to proceed, on the return day, to an ad-

judication, because a decree dissolving the corporation has been made after such service and before such return day. *id.*

39. It appearing, by the order of adjudication, that no one appeared in opposition, and that the corporation was called in open Court, and came not, but made default to appear, and it not appearing that the receiver appeared and asked, as representing the corporation and its property, to be heard, by answering the petition, and was refused leave to do so, it cannot be said that the corporation, although dissolved, had no opportunity to be heard. *id.*

40. A proceeding in involuntary bankruptcy is, substantially, a proceeding *in rem*, especially in a case against a corporation. *id.*

41. An assignee in bankruptcy of the corporation having been appointed, he brought a suit in equity, in this Court, against the State Court receiver, to set aside, as in fraud of the bankruptcy Act, the transfer of the property of the corporation to such State Court receiver, made by the operation of the order of the State Court appointing such receiver. On the filing of the bill, and on notice to such receiver, this Court granted an injunction restraining him from executing the trusts of his receivership, and appointing, pending the suit, a receiver of the property transferred to him, and of its proceeds. *id.*

42. At the first meeting of the creditors under the bankruptcy, the defendant was nominated a trustee, under the 43d section of the Act, and three persons were nominated a committee of the creditors, under that section. No assignee was chosen, and the meeting was finally closed, votes for an assignee having been given for another person than the defendant. The District Court refused to confirm the action in regard to a trustee and a committee, and appointed the plaintiff to be assignee in bankruptcy of the corporation. The defendant and two of the three persons nominated as a committee, brought a petition, in this Court, for a review and reversal of

the order of adjudication, and of the order refusing to confirm the nomination of a trustee and a committee, and appointing the plaintiff assignee. The petition had not yet been brought to hearing. It being suggested, that the defendant's claim of title, as trustee, and the plaintiff's claim of title, as assignee, ought not to be decided until the action of this Court on such petition, it considered the points sufficiently to be able to say that it did not perceive in them any ground for refusing any relief it would otherwise grant. *id.*

43. The plaintiff was appointed receiver, on stipulating to charge no commissions on such assets of his receivership as should pass therefrom to the trust represented by the assignee of the bankrupt. *id.*

See APPEAL.
EQUITY, 1.
MECHANICS' LIEN.

C

CASES COMMENTED ON.

1. *Tilghman v. Mitchell*, (2 *Fisher's Patent Cases*, 1.) *Tilghman v. Mitchell*, 18

CHARTER PARTY.

1. W., by a charter party under seal, hired from G. a vessel, for a specified term, to be run, as a freight and passenger vessel, between New York and San Domingo, for so much per month, W. to supply, man and navigate the vessel, and G., in case of damage to her by the perils of the seas, to repair her, and no claim for charter money to be made during the time she should be unfitted for use on such route by such damage. The charter party contained no covenant that, at the time of the charter, the vessel was seaworthy. W. sued G., in covenant, averring such a covenant, and alleging a breach of it, in that the vessel was not seaworthy, so that the voyages stated in the charter party could not be commenced. G. demurred to the declaration: *Held*,

that there was an implied covenant by G. that the vessel was seaworthy, or fit for the service for which she was hired, and that W. could aver such a warranty and declare on it, in covenant. *Wilson v. Griswold*, 267

CIRCUIT COURT.

See BANKRUPTCY, 6, 7, 13, 14, 19, 21, 22, 24, 25, 27.

COLLECTOR.

See ACTION.

COLLISION.

1. In a collision between two steamers, in the night, the S. and the C., the S. was held in fault for not having any lookout assigned or stationed for the performance of that duty; and for starboarding, instead of porting, when the two steamers were meeting nearly end on; and for starboarding when she saw the red light of the C., a short distance off, a very little on her starboard bow; and for not stopping and reversing. *The Comet*, 323
2. It being shown that the S. was negligent, she is to be held to clear proof of contributing negligence or fault in the C. *id.*
3. On the evidence, the C. was held not to have been in fault. *id.*
4. A steamship and a barque collided, in the Atlantic Ocean, within a day's sail of New York, in the track of her inward and outward commerce, where the presence of other vessels was to be expected, in a fog so dense that a vessel could not be seen at a distance greater than the length of the barque. The steamer was going, at the time, at a speed of not less than seven miles an hour: *Held*, that the steamer was in fault in going at such a rate of speed, and that such fault was a cause of the collision. *The Pennsylvania*, 451
5. *Held*, also, that her navigators were in fault, in giving conflicting and

vacillating orders, after discovering the barque. *id.*

6. The barque, although under way, was ringing a bell, and was not blowing a fog-horn. That was a fault on her part, but, on the evidence, it was not a fault which contributed to the collision. *id.*
7. The jurisdiction of the District Court for the Eastern District of New York, in this case, sustained, although the vessel proceeded against was found and attached in the waters of the county of New York. *id.*
8. The report of the Commissioner as to the value of the libellant's vessel, founded on conflicting or varying estimates, sustained. *id.*

See DAMAGES.

CONSTITUTION OF THE UNITED STATES.

Article 4, section 1, 275

CONSUL.

See JURISDICTION.

CORPORATION.

See BANKRUPTCY, 1, 36 to 39.
EQUITY, 2.
LIFE INSURANCE, 4 to 18.

COSTS.

See PATENT, 13.

D

DAMAGES.

1. In a case of collision, the District Court allowed, as an item of damage, \$500, for depreciation in the value of the libellant's vessel, besides allowing \$600 for future repairs. It appeared that the \$600 would put the vessel in a seaworthy condition, and in as good and serviceable a condition as she

was in before the collision; but the ship-builder testified, that, with such repairs, the vessel would not be as valuable, by \$500, as before the collision, and that there is a general damage, which vessels sustain when they come together, that they show when they grow old: *Held*, that the allowance of the \$500 was improper. *Petty v. Merrill*, 447

2. When a vessel is made as serviceable as she was before, any conjecture that she is not as valuable, or that, when she is old, some damage will appear, as the result of the collision, not now discoverable, is too vague and uncertain to warrant the finding of the conjectural amount of damage. *id.*

See COLLISION, 8.
PATENT, 21.

DISTILLER.

See INTERNAL REVENUE, 1 to 7.

DISTRICT COURT.

See BANKRUPTCY, 1, 2, 11, 12, 15,
18, 20, 23, 24, 28 to 32,
34, 86 to 88.
JURISDICTION.
COLLISION, 7.

E

EQUITY.

1. A bill in equity was filed by an assignee in bankruptcy against the bankrupt and another, to set aside a conveyance of property made by the bankrupt to the other defendant, and to compel an account of the same, and payment to the plaintiff, and for a discovery. The bankrupt demurred to the bill for want of equity:

Held, (1.) The jurisdiction to entertain such a bill is clear. Independent of the question, whether the assignee may not always, if he sees fit, seek the aid of a Court of Chancery, to set aside a fraudulent con-

veyance or illegal transfer, instead of proceeding by various actions at law, the right to call for an account is not questionable.

(2.) Although the charge, in the bill, of fraud and illegality, is in the alternative, either ground is sufficient.

(3.) The assignee has the right, as ancillary to the principal relief, to have a discovery from the defendants; and the need of such discovery also excuses the want, in the bill, of a more precise specification of the particular fraud alleged.

(4.) The bankrupt is a proper party to the bill. *Verselius v. Verselius*, 189

2. This Court having in its hands certificates for 60,056 shares of the capital stock of a corporation, one of the plaintiffs, and having made an order for the delivery of those certificates to the defendants, one G. petitioned to have so many of such certificates as would represent 12,735 of such shares delivered to him, as the owner thereof. Certificates of shares, far exceeding in number 60,056 shares, had been put into the hands of the defendants, by various persons, with power to the defendants to transfer them, on the books of the corporation, from the names of such persons to their own names. The defendants gave to such persons receipts stating the number of certificates and the number of shares, and that the certificates were to be registered in the names of the defendants. G. became the owner of 124 of such receipts, representing 12,735 shares. The 60,056 shares, and no more, had been transferred to the names of the defendants, and the certificates therefor, in the hands of the Court, were in their names. G. could not identify any of the receipts he held as having been given for any particular certificates represented by any of the certificates in the hands of the Court: *Held*, that any person who could identify any certificate he deposited with the defendants, could call upon them to respond in respect thereof; and that, as G. did not show that any person under whom he claimed title to the receipts, deposited any of the certificates representing the 60,056 shares

in the hands of the Court, or that such certificates were not all of them deposited by persons to whom the receipts which he claimed to own were not issued, the prayer of this petition must be denied. *Erie Railway Co. v. Heath*, 226

3. The bill in the first cause was an original bill. The bill in the second cause was a bill for discovery and relief and denominated itself a cross bill. The relief prayed in it was, that certain releases and proceedings might be declared to be a bar to any further proceedings in the first cause, and that the bill in that cause might be dismissed, and that an injunction might issue restraining the prosecution of any suit involving the questions covered by such releases and proceedings. The discovery prayed was as to whether such proceedings did not take place, and as to whether the agent of the defendants in the second cause was not present when such proceedings took place. The releases were given, and the proceedings took place, after issue was joined in the first cause. The defendants in the second cause being aliens, and out of the jurisdiction of the Court, and being the plaintiffs in the first cause, the plaintiffs in the second cause, who were the defendants in the first cause, moved, that the subpoena to appear and answer in the second cause be served on the solicitors for the plaintiffs in the first cause, and that the proceedings in the first cause be stayed until the cross bill should be answered. In reply to the motion, such solicitors tendered a stipulation, withdrawing their replications to the answers in the first cause, and permitting such answers to be amended by setting up therein the matters of the cross bill not contained in such answers, or supplemental answers to be filed, setting up such matters: *Held*, that such stipulation made the cross bill unnecessary, as to its prayer for relief, except so far as it prayed for an injunction; that, in that respect, it was an original bill; and that the substituted service asked for could not be made in an original suit. *Heath v. Erie Railway Co.* 316
4. *Held*, also, that there was no allegation in the cross bill that it was material the plaintiffs should have the discovery asked; and that, if there were, the discovery was unnecessary, in view of the Act of July 6th, 1862, § 1, (12 *U. S. Stat. at Large*, 588,) and the Act of July 2d, 1864, § 3, (13 *Id.*, 351,) permitting parties to be witnesses. *id.*
5. The theory and basis of a bill of discovery in equity, in aid of a defence of another suit, is, that the Court in which such other suit is pending has no means of compelling a discovery from the plaintiff therein, of facts material to the defence. *id.*
6. The motion was denied, but the benefit of the stipulation tendered was given to the defendants in the first cause. *id.*
7. If the defendants in that cause choose to examine the plaintiffs therein by commission, the Court can require that the plaintiffs answer fully all interrogatories put to them, or else debar them from the benefit of their suit. *id.*
8. The fact that the defendant, in a suit in equity, for the infringement of a patent, did not have proper expert testimony on the final hearing, is no ground for granting a rehearing, where no application was made in the premises before the final hearing, and no excuse is shown. *Hitchcock v. Tremaine*. 550
9. The fact that, since the first hearing, the defendant has discovered that a patent earlier than the plaintiffs', and which was in evidence on such hearing, has been twice reissued, the last time since such hearing, is no ground for granting a rehearing. *id.*

See APPEAL.

BANKRUPTCY, 7.

INJUNCTION.

LIFE INSURANCE, 4 to 18.

PATENT, 21 to 23, 33.

PARTY.

PRACTICE, 2, 3.

EVIDENCE.

1. In an action at law on a time policy of marine insurance on a vessel, tried before the Court, without a jury, after the plaintiff had rested his case at the trial, the defendants offered in evidence a paper purporting to be an application presented to the defendants, requesting them to effect the insurance covered by the policy. The Court excluded the paper, on the ground that the application was merged in the policy, and that there was no plea in the case that the policy was obtained by any fraud or by any misrepresentation, and that the offer of the paper was not preceded, or accompanied, or followed, by any offer to put in evidence, or by any putting in evidence of, any such misrepresentation: *Held*, that the exclusion was proper. *Folsom v. Mercantile Mutual Ins. Co.*, 201

2. *Held*, also, that the absence from the application of any statement as to where the vessel was when the application was made, or as to the port from which she had sailed, or as to the voyage on which she was bound, or as to who was her master, had no tendency to show that the plaintiff did not, when he made the application, communicate to the defendants the facts referred to, or answer truly all questions put to him in regard thereto. *id.*

See BANKRUPTCY, 26.
LIEN, 3, 4.
LIFE INSURANCE, 3.
PLEADING, 5, 6.
PRACTICE, 2 to 4.

F

FRAUD.

See BANKRUPTCY, 3.
EQUITY, 1.

G

GUARDIAN.

1. In the absence of a restraining statute, a guardian of the person and

estate of an infant, appointed by a Court of Probate, has, as incidental to his office and duties, the power to sell personal property of his ward. *Wallace v. Holmes*, 65

2. The statute of Massachusetts, (*General Statutes of Massachusetts*, chap. 109, § 22,) providing that the Courts therein named may authorize or require a guardian to sell personal property held by him as guardian, and invest the proceeds in real estate, or otherwise, does not take away the power of the guardian to sell such personal property without an order of the Court, and to confer title thereto on the purchaser. *id.*

I

INJUNCTION.

1. An irregularity in the service on a defendant of the subpoena in a suit in equity, affords no reason for withholding an injunction against him, if he has had notice of the motion for the injunction, and appears to oppose it. *Thayer v. Wales*, 170

See BANKRUPTCY, 11, 12.
PATENT, 24 to 30, 65, 66.
REMOVAL OF CAUSES, 5.

INSURANCE.

See EVIDENCE, 1, 2.
LIFE INSURANCE.

INTERNAL REVENUE.

1. Under section 22 of the Internal Revenue Act of July 20th, 1868, (15 *U. S. Stat. at Large*, 134,) a regular suspension of work by a distiller relieves him from assessment for taxation during the interval between the time he so regularly suspends work, and the time he actually resumes work, whether the resumption is regular, according to that section, or not. *Daniels v. Tarbox*, 176
2. If he resumes work without previously complying with the provisions of that section in regard to resump-

- tion, he is liable to the forfeitures and punishment provided by that section; but the regularity of the suspension does not depend upon the regularity of the resumption. *id.*
3. Having mash or wort on the premises during the period of suspension, does not make the distiller liable to assessment for tax during such period. *id.*
 4. A notice in writing of an intention to suspend work, under that section, was addressed to the assessor, instead of the assistant assessor, but was written in the office of the assistant assessor, and came to his hands, and contained the information required by the statute, and was acted upon by the assistant assessor: *Held*, that it was no objection to the regularity of the notice that it was addressed to the assessor. *id.*
 5. A non-compliance with the statute in regard to one interval of suspension, cannot affect the question of the regularity of another suspension. *id.*
 6. Where it was impossible to lock the door of the furnace of the still, and impossible to make a fire in the furnace, and the assistant assessor attended during the interval of suspension, and saw that no work of distilling was done: *Held*, that the right of the distiller to be treated as having duly suspended work, was not affected by the omission of the assistant assessor to comply with the statute by locking the door of the furnace. *id.*
 7. *Held*, also, that such right was not affected by the omission of the assessor to comply with the statute by reporting the suspension, and the action of the assistant assessor thereon, to the Commissioner of Internal Revenue. *id.*
 8. Under § 122 of the Act of June 30th, 1864, (13 *U. S. Stat. at Large*, 284,) moneys used by a railroad company to replace an old and worn out bridge, by another of like materials and dimensions, are not "profits used for construction," and, as such, liable to a tax of five per cent. *Hartford & New Haven R. R. Co. v. Grant*, 542
 9. But, where a wooden bridge is replaced by a much more costly stone bridge, the earnings adequate to pay for the latter, beyond the expense of building anew a like wooden bridge, are to be deemed "profits used for construction." *id.*
 10. Where, however, the cost of such stone bridge is charged to the expense account of the company, and the whole amount of such account for the year, including such cost, is not more than a proper percentage of the gross receipts of the company to cover all proper, ordinary, current expenses, and the depreciation of its entire property, such cost is not to be deemed "profits used for construction." *id.*
- J
- ### JURISDICTION.
1. Article 10 of the treaty between the United States and the King of Prussia, of May 1st, 1828, (8 *U. S. Stat. at Large*, 378, 382,) provides, that the consuls, vice-consuls and commercial agents of each party "shall have the right, as such, to sit as judges and arbitrators, in such differences as may arise between the captains and crews of the vessels belonging to the nation whose interests are committed to their charge, without the interference of the local authorities," subject to the right of the contending parties "to resort, on their return, to the judicial authority of their country," and to the right of the consuls, vice-consuls or commercial agents to require the assistance of the local authorities, "to cause their decisions to be carried into effect or supported." The crew of a Prussian vessel sued her *in rem*, in Admiralty, in the District Court, to recover wages alleged to be due to them. The master of the vessel answered, denying the debt, invoking the protection of said treaty, denying the jurisdiction of the Court, and averring that the claim for wages had already been adjudicated by the Prussian consul at New York. The consul also protested formally to the Court

against the exercise of its jurisdiction. The case was tried in the District Court, and it appeared that the consul had adjudicated on the claim for wages. The District Court decreed in favor of the libellants: *Held*, That the District Court had no jurisdiction of the case. *The Elwina Kreplin*. 438

See BANKRUPTCY, 1, 21, 28 to 37.
COLLISION, 7.
EQUITY, 1.
PLEADING, 1.

L

LIEN.

1. Under § 8 of the Act of July 18th, 1866, (14 *U. S. Stat. at Large*, 180,) which declares that a vessel shall be holden for the payment of the penalty imposed upon her master by § 24 of the Act of March 2d, 1799, (1 *Id.*, 646,) where goods are brought into the United States by her, which are not included or described in the manifest of her cargo, the vessel may be proceeded against *in rem*, in the Admiralty, to enforce such lien against her. *United States v. The Missouri*, 433
2. The manifest of the cargo of such vessel, filed in the custom house, is competent evidence on the question as to whether such goods were entered on the manifest of her cargo. *id.*
3. It is not necessary to the liability of the master to such penalty, that it should appear he had knowledge that the goods were on board of the vessel. *id.*
4. If the absence of such knowledge is to be of avail, it must be proved as a defence. *id.*

See BANKRUPTCY, 11, 12.

LIFE INSURANCE.

1. A policy of insurance on the life of a person contained the condition, that,

if he should die by suicide, the policy should be null and void, and the insurers should not be liable for the loss. The subject insured died by an act of self-killing, by himself firing a pistol at his head: *Held*, that, if the subject insured, at the time he fired the pistol, was conscious of the act he was committing, intended to take his own life, and was capable of understanding the nature and consequences of the act, the insurers were not liable; that, if the act was thus committed, it was immaterial whether he was capable of understanding its moral aspects, or of distinguishing between right and wrong; and that, if he was not thus conscious, or had no such capacity, but acted under an insane delusion, overpowering his understanding and will, or was impelled by an uncontrollable impulse, which neither his understanding or will could resist, the insurers were liable. *Gay v. Union Mutual Life Ins. Co.*, 142

2. *Held*, also, that, the fact of self-killing being conceded, it was for the party claiming to recover on the policy, to establish that the subject insured was in the condition, when he committed the act, which left the insurers liable. *id.*
3. The value of the testimony of expert witnesses, considered. *id.*
4. In March, 1858, a mutual life insurance company of New York issued to G. a written policy on his life. G. was, at the time, a citizen of, and a resident in, Alabama, and continued to be such until his death in June, 1866. The policy was for life, subject to the payment of an annual premium on or before a specified day, and contained a provision, that, in case G. should not punctually pay such premium, the policy should cease and determine, and all previous payments made thereon should be forfeited to the company. In due season, in March, 1859, 1860 and 1861, G. paid to M., an agent of the company at Mobile, Alabama, the accruing premiums, and they were received by the company at New York. Afterwards, and in March, 1861, the company withdrew all their agencies

- from Alabama, and had no agent in that State until 1869. G., after 1861, paid no further premiums on the policy. He was always ready to pay, but did not pay because of the revocation of the agencies, and because the insurrection against the Government of the United States prevented lawful intercourse between Mobile and New York. The restrictions against intercourse continued until May, 1865. Afterwards, and before March, 1866, G. applied to the company at New York, to receive the premiums in arrear, with interest. It refused to do so or to recognize the policy as subsisting. The plaintiff, as executor of G., renewed the application, but it was refused, on the ground that the policy was forfeited. He then filed this bill, praying for a decree declaring the policy to be subsisting and not forfeited, and directing the payment of the amount insured by it, less the unpaid premiums and interest thereon: *Held*, That the plaintiff was entitled to such decree. *Hamilton v. Mutual Life Ins. Co.*, 234
5. An executory contract of continuing performance, made before the breakout of a war, with an alien enemy, if it cannot be performed except in the way of commercial intercourse with the enemy, is *ipso facto* dissolved by the declaration of war, which operates, for that purpose, with a force equivalent to that of an Act of Congress. *id.*
 6. Where a contract is of such a character that its continued existence is not dependent upon any further intercourse between the parties, the only effect of the war is to suspend its operation, and, on the return of peace, the rights of the parties under it may be enforced. *id.*
 7. The policy of life insurance, in this case, was suspended, but not dissolved, during the continuance of the war between the United States and the insurrectionary States, of which latter Alabama was one, and New York was not one, in so far as G. could not pay the accruing annual premiums without commercial intercourse between Alabama and New York. *id.*
 8. The contract was not one of continuing performance, in the sense of the rule before stated, so as to be dissolved by the war. *id.*
 9. The policy was not unlawful, as continuing to insure the life of G., although he was an alien enemy, it appearing that he was a neutral, passive, non-combatant enemy, who remained such in fact. *id.*
 10. On the facts of this case, it was a part of the contract of the company, that G. should have the right to pay the annual premiums to an agent of the company in Alabama, and the company was bound to provide in Alabama, during the continuance of the risk on the policy, an agent to receive such premiums, appointed and qualified in compliance with the statute law of Alabama on the subject, and G. was not bound to pay such premiums elsewhere than to such agent. *id.*
 11. As the absence of such agent was all that prevented the payment of the premiums by G., the company cannot set up, as a defence, the non-payment of the premiums at the stipulated times. *id.*
 12. The agency of M., having been created before the war, would not have been revoked by the war, at least so far as the right to receive payment of annual premiums was concerned. *id.*
 13. Payment of the premiums by G. to the agent, would not have violated any law of war, or any duty of G.'s. *id.*
 14. The refusal of the company, when applied to by G., to recognize the policy or receive the premiums, made it unnecessary for him to pay the premium due in March, 1866, *id.*
 15. It is of the essence of every contract, that, if one party to it prevents its performance by the other party, the former cannot be allowed to reap any benefit from the fact of such non-performance. *id.*
 16. The inability of the company to receive the premiums, because of the

unlawfulness of commercial intercourse, was equivalent to a tender of the premiums and a refusal to receive them, or to a waiver of their punctual payment. *id.*

17. There is a sound distinction between cases in which the impediment to the performance of a precedent condition, on which, by contract, money is to be paid, exists solely on the part of him who is to be the actor in performance, and cases in which the impediment exists either solely on the part of him who is to be the recipient of performance, or is an impediment affecting both parties jointly, and equally in extent. *id.*

18. Although the company was a mutual company, the policy was not dissolved by the war, as a contract of partnership between enemies. *id.*

LIMITATION.

1. The 7th section of the Act of March 3d, 1863, (12 *U. S. Stat. at Large*, 757,) providing a two years' limitation for the bringing of a suit for an arrest or imprisonment made, or trespass or wrong done or committed, or act omitted to be done, during the late rebellion, under authority of the President, or of an Act of Congress, does not apply to an action of assumpsit. *Britton v. Butler*, 457

See BANKRUPTCY, 4, 5.

M

MASTER.

See LIEN.

MECHANICS' LIEN.

1. Under the mechanics' lien law of the State of New Jersey, (*Nixon's Digest*, 4th ed., p. 571.) A. performed labor and furnished materials in erecting a building on real estate of B. in New Jersey. Afterwards, B. executed a mortgage to C., on such real estate.

After that B. was adjudged a bankrupt, on his own petition, in the District Court for the Southern District of New York, and an assignee of his estate was appointed. Thereafter, and within one year after the performance of such labor, A. filed his claim, under said law, in the office of the clerk of the county, in New Jersey, in which such building was situated: *Held*, that the lien of A. attached as of the time the labor was performed, and was superior to the lien of C. under his mortgage, and that the real estate, in the hands of the assignee in bankruptcy, was subject to such lien of A. *In re Dey*, 285

MORTGAGE.

See BANKRUPTCY, 11, 12.

N

NAVIGATION.

See COLLISION.

P

PARTY.

1. Where, in a suit in equity, the want of parties is not set up or suggested in the answer, it cannot avail on final hearing, unless the case is one in which the Court cannot proceed to a decree between the parties before it, without prejudice to the rights of those who are proper to be made parties, but who are not brought into Court. *Wallace v. Holmes*, 65

See EQUITY, 1.

PATENT.

1. Invention, (1.)
2. Specification, (2.)
3. Assignment.

4. License.
5. Reissue, (8 to 5.)
6. Extension, (6, 7.)
7. Abandonment, (8 to 13.)
8. Novelty, (14.)
9. Infringement, (15.)
10. Damages, (16, 17.)
11. Account of Profits, (18 to 23.)
12. Injunction, (24 to 30.)
13. Particular Patents.
 - (1.) Tilghman—Purifying fatty bodies, (31 to 35.)
 - (2.) Collins—Lamp, (36, 37.)
 - (3.) Waterbury Brass Co.—Brass-kettle, (38 to 41.)
 - (4.) Woolcocks—Speaking-tube whistle, (42 to 46.)
 - (5.) Stainthorp—Candle-machine, (47, 48.)
 - (6.) Shaw—Smut-mill, (49 to 52.)
 - (7.) Kittle—Spring-mattress, (53 to 55.)
 - (8.) Osborn and Vincent—Skirt-hoop, (56 to 58.)
 - (9.) De Forest and Gilbert—Hoop-skirt, (59 to 66.)
 - (10.) Jurgensen—Stem-setting watch, (67 to 71.)
 - (11.) Dudley and Clark—Hand-mirror, (72 to 77.)
 - (12.) Merriam and Chamberlin—Whip-socket, (78 to 80.)
 - (13.) Platt—Button, (81 to 83.)
 - (14.) Day—Electro-magnetic telegraph, (84 to 88.)
 - (15.) Heaton—Armor for ships, (89 to 93.)
 - (16.) Sawyer—Putting-up powders, (94 to 96.)
 - (17.) Warth—Stop-valve for petroleum packages, (97 to 99.)
 - (18.) Smith—Corded elastic fabric, (100 to 102.)
 - (19.) Tilghman—Cutting and engraving stone, &c., (103 to 108.)
 - (20.) Buerk—Watchman's time-detector, (109 to 113.)
 - (21.) Blair—Rubber-head for lead pencils, (114, 116.)
 - (22.) The Modena Hat Co.—Fabric for hats, (116.)
 - (23.) Kendall and Trested—Coating for hats, (117.)
 - (24.) Blake—Bonnet, (118 to 124.)
 - (25.) Jenkins—Elastic packing, (125 to 126.)
 - (26.) Jenkins—Steam globe-valve, (127 to 129.)

(27.) Sarven—Carriage-wheel, (130 to 136.)

(28.) Barnes—Corset-spring, (137 to 141.)

1. *Invention.*

1. A mere aggregation of parts, whereof the patentee has not the exclusive right to either, and in which the parts have no new operation, and produce no result which is due to the combination itself, is not patentable. *Sarven v. Hall*, 524

See 52, 61, 68, 75, 88, 90 to 96, 102, 114, 115, 121.

2. *Specification.*

2. Where the specification of a patent for a product fully describes the machine and the process by which the product is produced, such patent may be good, even though the same specification, annexed to a patent for the machine, may not fully secure the patentee against the use of his actual invention, because of a defect in the claim of the latter patent. *Waterbury Brass Co. v. Miller*, 77

3. *Assignment.*

See 54, 76.

4. *License.*

See 26, 30.

5. *Reissue.*

3. A reissued patent cannot be sustained by extrinsic proof that the patentee was the inventor of all that is claimed in it, if what is so claimed was not shown or suggested in the original specification, drawings, or model. *Sarven v. Hall*, 524
4. Defects or insufficiencies in the description of anything which is found in any form in the original specification, drawings, or model, may be supplied in the reissue. *Id.*
5. If there is nothing, in a prior orig-

inal patent, to affect the validity of the patent sued on, no reissue of such prior patent made subsequently to the date of the patent sued on, can affect such validity. *Hitchcock v. Tremaine*, 550

See 110.

6. Extension.

6. If the extension of a patent is regular on its face, no question of irregularity or fraud in granting it can be raised by an infringer, in a suit against him for infringement. *Tilghman v. Mitchell*, 18

7. Although an inventor obtained a patent in the United States for his invention, after he obtained a patent in England for it, and the English patent expired previously to the granting of an extension of the patent for the United States, the fact that such English patent expired before the patent for the United States was extended, forms no objection to the validity of such extension. *id.*

See 24.

7. Abandonment.

8. In January, 1852, B. applied for a patent. His application was rejected in April, 1852. He did not appeal, or apply for a re-examination. In May, 1852, he took from the Patent Office his application, and all the papers connected with it, except one drawing, but made no formal withdrawal. The papers so withdrawn were never returned. From May, 1852, until April, 1862, he had no communication with the Patent Office, and took no steps towards obtaining a patent. During that interval, his invention went into extensive use, with his knowledge, and without his objection. In April, 1862, he filed a new application for a patent for the invention, and paid a new fee. The new application made no reference to the application of 1852. The fee paid to the Patent Office in 1852 was not withdrawn: *Held*, that the application of 1852 had been abandoned, and that a patent granted in 1869,

on the application of 1862, was void, because of the public use of the invention, for nearly ten years before 1862, with the permission of the inventor. *Bevin v. East Hampton Bell Co.*, 50

9. The fact that an invention was in public use and on sale, with the consent and allowance of the inventor, more than two years before his application for a patent, renders the patent invalid, however great the hindrances to the application, and whether caused by the want of pecuniary means, or other misfortune. *Sisson v. Gilbert*, 185

10. The public use, in this case, held not to have been experimental, the inventor having himself manufactured and sold machines containing the invention, through several years, and having allowed such machines to be used thence onward, for six more years, before applying for his patent. *id.*

11. A merely experimental use, made in good faith, and not in such wise as to amount to a fraud upon the public, misleading them into a use, in the belief that it is free, does not destroy the exclusive right of an inventor. *id.*

12. What constitutes an "allowance," by an inventor, of a public use of his invention, although there are no words of consent, his consent and allowance being inferred from acquiescence. *id.*

13. A defence, that the patent was invalid, because of such consent and allowance, being sustained, the bill was dismissed, but, under the circumstances, without costs. *id.*

See 54, 77.

8. Novelty.

14. Observations on prior unsuccessful experiments set up to defeat a patent. *Hitchcock v. Tremaine*, 550

See 74, 83, 84, 86, 88, 90 to 96, 101, 108, 111, 114, 115, 121, 129, 185, 140.

9. *Infringement.*

15. Where a structure consisting of several parts is patented as a combination, one who manufactures and sells some of the parts, they being useless without the residue, with the understanding and intent that such residue shall be supplied by another, and the whole go into use in its complete form, is liable as an infringer of the patent. *Wallace v. Holmes*, 65

See 1, 5, 6, 16, 17, 27, 31, 32, 36, 37, 40 to 42, 44, 46, 47, 49, 54, 58, 62 to 65, 67, 69 to 71, 73, 80, 86, 99, 113, 116, 117, 122 to 124, 141.

10. *Damages.*

16. In an action at law for the infringement of letters patent, the jury found a verdict for the plaintiff for \$700 damages. On a motion by the defendant for a new trial, the Court was of opinion that the evidence, tending to prove actual damages sustained by the plaintiff, did not warrant a verdict for a greater amount than \$562 50:

Held, (1.) The plaintiff might be allowed to remit the excess, instead of being required to submit to a new trial.

(2.) It appearing that the infringement was deliberate and intentional, and the plaintiff asking, under the statute, for an increase of the actual damages found, the Court awarded judgment for \$1,200 and costs.

(3.) The defendant was allowed to require the plaintiff to first remit the amount of the excess of the verdict, or submit to a new trial, the order of the Court thereupon to award the plaintiff judgment as aforesaid: *Russell v. Place*, 173

17. In this case, which was an action at law, for the infringement of letters patent, the plaintiff having had, at the trial, a verdict for \$5,000, the Court, regarding the conduct of the defendant as peculiarly aggravated, increased the damages to \$7,500, as being a sum sufficient to cover the expenses of the trial, and something more, for the time and trouble of the plaintiff. *Peck v. Frame*, 194

11. *Account of Profits.*

18. In a suit in equity for the infringement of a patent for a tremolo attachment to an organ, on taking an account of the profits derived by the defendant from dealing in such attachment, it appeared that the defendant dealt in musical instruments not having such attachment, as well as in those having it: *Held*, that a proper part of the general expenses of conducting the defendant's entire business, such as clerk hire, rent of store, and the like, ought to be assigned to the dealing in such attachments, such part to bear the same proportion to the whole of such general expenses, that the sales of such attachments bore to the sales in the entire business. *Hitchcock v. Tremaine*, 385

19. Such general expenses ought not to be apportioned according to the amount of profits on sales. *id.*

20. The patented attachment being a revolving fan, not including the apparatus for moving the fan, the profits on such apparatus ought not to be allowed. *id.*

21. In a suit in equity, for the infringement of letters patent, brought before the passage of the Act of July 8th, 1870, (16 U. S. Stat. at Large, 206, 216, §§ 55, 111,) both profits and damages cannot be recovered. *Williams v. Leonard*, 476

22. An interlocutory decree in such a suit, entered after the passage of such Act, inadvertently provided for the recovery of both profits and damages. The report of the Commissioner reported both profits and damages, and was excepted to by the defendant, on the ground that the damages could not be recovered in the suit: *Held*, that the point could not be raised by an exception to such report, but that, nevertheless, the Court would not award any damages, and would re-settle the interlocutory decree, so as to exclude them. *id.*

23. In an accounting for profits, the defendant cannot be credited with a sum of money as a salary earned by

and paid to himself, while engaged in the business which earned the profits. *id.*

See 33.

12. Injunction.

24. On a motion for a preliminary injunction to restrain the infringement of a patent which had been extended, although its extension had been opposed by the defendant, on testimony introduced by him, such injunction was granted, it appearing that the novelty of the invention and the validity of the patent had been sustained, on final hearing, in several suits in equity. *Tilghman v. Mitchell*, 18
25. The defendant not allowed to give a bond as security, in place of having a preliminary injunction issued against him. *id.*
26. The defendant expressing a willingness to take a license from the plaintiff, under the extended patent, at the usual rate of license established by the plaintiff, an order was made, that, unless the defendant should accept and execute a license, duly executed by the plaintiff, in the usual form, within ten days, under the extended patent, an injunction should issue, as prayed for in the bill. *id.*
27. A preliminary injunction granted against a clear infringement, there having been repeated adjudications sustaining the patent. *Thayer v. Wales*, 170
28. In opposition to a motion for an injunction, a general allegation, by affidavit, on information and belief, that the thing patented existed before, without disclosing the particulars of the information leading to the belief, is insufficient. *Young v. Lippman*, 277
29. A separate affidavit, by the plaintiff, of his belief that the patentees were the original and first inventors of the thing patented, dispensed with, the bill having in it such an averment, and having been sworn to

eleven days before it was filed and notice of application, on it, for the injunction, was given. *id.*

30. The question of withholding an injunction, if the defendant will take a license, considered. *Baldwin v. Schultz*, 494

See INJUNCTION.

13. Particular Patents.

(1.) *Tilghman—Purifying fatty bodies.*

31. By the use, for decomposing fatty bodies into fat acids and glycerine, of the apparatus described in letters patent of the United States, granted to Robert Alfred Wright and Louis Jules Fouché, January 25th, 1859, for "improvements in process for decomposing fats," such fatty bodies are so decomposed by the action of water at a high temperature and pressure, and the process is used which is described and claimed in letters patent of the United States granted to Richard A. Tilghman, October 3d, 1854, for 14 years from January 9th, 1854, for an "improvement in processes for purifying fatty bodies." *Tilghman v. Mitchell*, 1
32. The fact, that, in using the Wright and Fouché apparatus, a lower temperature is employed than that designated in the Tilghman patent, and the fact that more time is employed for the operation, and the fact that a continued agitation or circulation of the fat, water, and steam is kept up, make no difference in the conclusion. *id.*
33. The defendant having employed, before he adopted the Tilghman process, a process in which he used lime and sulphuric acid, and it being shown that, as a result of the use of the Tilghman process, he dispensed with the use of lime and sulphuric acid, and saved a quantity of fat which was lost by the use of the prior process, and obtained an increased profit from the glycerine produced: *Held*, that the plaintiff was entitled to recover, as profits, on an accounting, under a decree, in a

suit in equity, such saving of lime, sulphuric acid and fat, and such increased profit in respect of glycerine. *id.*

34. The construction put, in the case of *Tilghman v. Mitchell*, (2 *Fisher's Patent Cases*, 518,) on the specification of the patent granted to Richard A. Tilghman, October 8d, 1854, for fourteen years from January 9th, 1854, for an "improvement in processes for purifying fatty bodies," approved. *Tilghman v. Mitchell*, 18

35. The novelty of the invention covered by the said patent to Tilghman, and the validity of the said patent, sustained. *id.*

(2.) *Collins—Lamp.*

36. Letters patent were granted to Michael H. Collins, September 19th, 1865, for an "improvement in lamps." The claim was to "the improved lamp, as not only constructed with its cone or deflector, (F,) and its chimney rest, (D,) and chimney, arranged with respect to each other as described, but as having the said deflector provided with peripheral springs, or the same, or the slits, (h, h), and the rest, (D,) made concavo-convex, and provided with an annular groove or lip at the bottom, for supporting the chimney, the whole being substantially as described or represented." The specification described the main purpose of the invention to be not only to keep the lower part of the glass chimney of the lamp cool, so that it might readily be removed by the hand, but also to support the chimney without the use of a spring catch or other devices such as are ordinarily used. The distinguishing feature of the invention claimed was the burner, with its chimney-rest, a deflector having peripheral springs, to sustain the chimney without the aid of a catch or screw, and with air passages operating, when in use, to keep the lower part of the chimney cool, and tending, by that means, and by the greater elevation of the flame, to prevent the lower portion of the burner and top of the reservoir from becoming unduly heated.

Vol. ix—38

The burner alone, or the burner attached to the reservoir, was useless without a chimney, and a chimney was useless without a burner. The defendants made and sold burners substantially like the patented invention, but, although they used such burners with chimneys placed therein, to exhibit the burners to customers, they did not make or sell the chimneys: *Held*, that the claim of the patent was a claim to the burner in combination with the chimney. *Wallace v. Holmes*, 65

37. *Held*, also, that the defendants must be regarded as active parties in the whole infringement, by making and selling the burner to be used with the chimney. *id.*

(3.) *Waterbury Brass Co.—Brass-kettle.*

38. The two re-issued letters patent granted to the Waterbury Brass Company, May 24th, 1870, as assignees of Hiram W. Hayden, the inventor, one for an "improvement in machine for making kettles," and the other for an "improvement in brass-kettles," are valid. *Waterbury Brass Co. v. Miller*, 77

39. The first named patent is for a machine, and the other patent is for the product of the process wrought by such machine, the machine and the process being described in the same terms in each. *id.*

40. The plaintiff's machine consisted of an engine lathe, a form, a clamp, and other devices, and an adjustable tool-carriage, sustaining and guiding a burnishing or spinning tool in a definite, prescribed path, pressing the tool against the disk of metal operated upon, the tool-carriage being moved by a screw connected by a gear wheel with the power moving the lathe. The defendant's machine was, in substance, in all respects, like the plaintiff's, except that the tool carriage was moved by a rod connected with a cam acted on by a gear-wheel actuated through a crank by the hand of a workman: *Held*, that this was not an essential difference. *id.*

41. The words, "substantially as described and shown," in the claim of the patent, held to relate only to material features of the combination specified, to be ascertained by considering the purpose of the machine, and what are the elements of the combination which constitute its distinctive character, and are effective in producing the peculiar result for which the contrivance is made. *id.*
- (4.) *Woolcocks—Speaking-tube whistle.*
42. The first claim of the letters patent granted, May 24th, 1870, to Thomas J. Woolcocks, for an "improvement in speaking - tube whistles," namely, "In combination with the cylindrically formed barrel A, the stem F, having the reacting spring G attached to it, and operating on the outside of the barrel, as hereinbefore described, and for the purposes set forth," is infringed by a combination consisting of the barrel, stem, and spring, the spring being attached to the stem, and operating on the outside of the barrel, and the barrel being octagonal instead of cylindrical, the combination being, in all other respects, the same, and the octagonal form possessing all the advantages of, and being the equivalent of, the cylindrical form, as contradistinguished from the previous square form. *Woolcocks v. Many*, 139
43. The first claim of the reissued letters patent granted to Luke Taylor, October 19th, 1869, for an "improved mop-head," the original letters patent having been granted to him February 15th, 1869, and reissued November 10th, 1868, and again reissued November 24th, 1868, namely, "In a mop-head, in which the cross-head or stationary jaw is attached permanently and immovably to the handle, operating the movable jaw or binder by means of a tubular screw or socket fitted in the handle, and having its screw-thread on its exterior, in combination with a nut encompassing the screw and connected with the movable jaw, so as to operate substantially as shown and described," is, in substance, a claim for the described devices, arrangement, and organization for operating the movable jaw of a mop-head, in which the cross-head or stationary jaw is attached permanently and immovably to the handle by means of the screw formed on the exterior of the collar described in the specification, so fitted to and fixed upon the handle as to revolve therein without longitudinal motion, in combination with a nut encompassing the screw and connected with the movable jaw, so as to operate substantially as shown and described in the specification. *Taylor v. Garretson*, 156
44. The mere substitution of a mechanical equivalent or equivalents for one or more of the elements constituting the combinations and organizations thus claimed, or any merely formal or fraudulently evasive change in the parts or arrangement embraced in the claim, will not relieve a party from liability as an infringer. *id.*
45. The second claim of the said reissued patent, namely, "In a mop-head, in which the movable jaw or binder is operated through the medium of a screw-nut or collar, by means of thumb-ears attached to or formed with the said screw-nut or collar, placing the said ears outside the yoke or bow of the movable jaw or binder aforesaid, as herein described, for the purpose set forth," is, in substance, a claim to the invention of the described location and use of the thumb-ears attached to the tubular screw or collar, with a screw on its exterior, constructed and operated substantially as described, in a mop-head in which its movable jaw is operated through the medium of such tubular screw or collar, with screw-threads on its exterior, in connection with a proper nut encompassing and acting with such screw. *id.*
46. A mop-head constructed in accordance with the description contained in letters patent granted to Oliver S. Garretson, August 13th, 1867, for an "improved mop-head," is not an infringement of the said reissued patent to Taylor, as it does not contain Tay-

lor's revolving collar, with a screw-threaded exterior, or any mechanical equivalent thereof. *id.*

(5.) *Stainthorp—Candle-machine.*

47. The first claim of the letters patent granted to John Stainthorp, March 6th, 1855, for an "improvement in machines for making candles," namely, "The employment of the pistons, D, D, formed at their upper ends into moulds for the tips of the candles, in combination with stationary candle-moulds, to throw out the candles in a vertical direction, substantially as herein set forth," is infringed by a machine in which the piston has a flat end, and moulds a candle with a flat end, instead of a convex tip, provided the piston is used in combination with the stationary mould, to throw out the candle in a vertical direction, as described in the specification. *Thayer v. Wales*, 170

48. The said letters patent are valid. *id.*

(6.) *Shaw—Smut-mill.*

49. The third claim of the reissued letters patent, No. 3,794, granted to Daniel Shaw, January 11th, 1870, for an improved smut-mill and separator (the original patent having been granted to him April 6th, 1852, and reissued November 3d, 1863, and extended April 6th, 1866), namely, "In combination with a smutter or scourer, and a suction fan, both arranged on and driven by the same shaft, and an air-trunk for directing the course of the blast, a regulator, for changing the force or volume of the current of air, without changing the speed or motion of the smutting or scouring cylinder, substantially as described," is limited to a combination in which a tight smutter or scourer is employed, and does not cover a combination in which an open scourer is employed. *Knox v. Murtha*, 205

50. The general words of the claim are to be construed as limited by any particular description found in the specification. *id.*

51. Reasons stated why such third claim is, probably, invalid. *id.*

52. The fifth claim of the patent, namely, "The arranging of the smutter or scourer and the suction separating fan within or between the legs of the blast or air-trunk, in which the entire separation is made, and which passes over or around them, for the purpose of economizing space, and cheapening the construction of the machine, substantially as described," is void, as covering no patentable invention. *id.*

(7.) *Kittle—Spring-mattress.*

53. The first claim of the re-issued letters patent granted to Samuel P. Kittle, October 17th, 1865, for a "spring-mattress," (the original patent having been granted to him November 8th, 1864), namely, "The combination of the two parts, A and A', and an intervening portion of the sides of the box of a box-spring mattress, having the cases containing the stuffing attached to the said sides, the said parts A, A', and the intervening portion, being connected to each other by hinges, the joints of which are located twice the distance apart of the thickness of the stuffing, substantially as herein above set forth," is infringed by a mattress in which the sides of the box are divided into five parts, in such manner that the mattress contains the combination covered by said third claim, introduced twice, once at each end of the mattress. *Kittle v. Frost*, 214

54. The said patent is valid. *id.*

55. K., the inventor, in April, 1863, after making the invention, agreed in writing with F., to assign to F. an undivided one-half interest under the patent when it should be issued, in and to certain specified territory, on condition that F. should perform all of the covenants on his part in the agreement, which were numerous, and concerned principally the making and selling of mattresses. Among them were, however, covenants, that F. should pay "all necessary expenses of procuring a patent" for the invention, advancing the same as it should be required, \$30 of it to be advanced before May 30th, 1863, and that F. should "be at the

risk of all the expenses arising in the prosecution of the case for a patent" on the invention. In June, 1864, when the application for the patent was ready to be filed, F., at the request of K., paid to K. \$15, as the fee to be paid at the Patent Office on filing the application. It was filed. Subsequently, K. notified F. of his (F.'s) failure to perform many of his covenants, and demanded a compliance with all of them. Two days after the patent was granted, K. notified F. that all his rights under the agreement were forfeited, and that he must not make any mattresses under the patent. The parties then met, and K. renewed the notice, and F., with a view to a settlement of his pecuniary transactions with K., under the agreement, presented to K. a bill, which contained, as a debit against K., the said item of \$15, as "advanced on patent." *Held*, that this was an abandonment by F. to K., with the acquiescence of K., of all rights of F., under the agreement, to an interest in the patent. *id.*

(8.) *Osborn and Vincent—Skirt-hoop.*

56. The letters patent granted to L. A. Osborn and I. J. Vincent, as assignees of Robert J. Mann, the inventor, June 22d, 1858, for an "improvement in skirt-hoops," are valid, so far as the second claim is concerned, namely, "Securing the hoop, *d*, to the perpendicular straps, by means of small clamps, constructed as herein described." *Doughty v. Day*, 262

57. Although the specification states that the nature of the improvement which is the subject matter of the second claim consists in the peculiar manner of fastening the hoops "to the perpendicular straps by means of a small clamp, the said clamp being made with teeth, or otherwise," yet, taking the drawings and the description together, no one would, from them, use clamps without teeth, to fasten the hoops to the perpendicular straps. *id.*

58. Increasing the number of teeth, and adding another feature to the clamp, while it still has teeth which, after passing through the strap, are clinch-

ed, and embrace the hoop, is, nevertheless, an infringement of the said second claim. *id.*

(9.) *De Forest and Gilbert—Hoop-skirt.*

59. The claim of the letters patent granted to Thomas B. De Forest and Thomas S. Gilbert, February 18th, 1868, for an "improvement in springs for hoop-skirts," namely, "A skirt-hoop, formed by enclosing one or more wires within a covering, which not only envelopes and protects the wire, but forms an edge, A, or connection B, substantially as and for the purposes specified," is a claim to such a skirt-hoop as is described, as an article of manufacture—a skirt-hoop capable of use in making what is known as a hoop-skirt. *Young v. Lippman*, 277

60. The invention in the patent is limited to a skirt-wire made by folding the fabric over one or more wires, and securing it by sizing or glue and pressure, so as to thus enclose the wire or wires in a covering, and leave an edge of the fabric on the one wire, or a connection, formed by the fabric, between the two wires, so as to admit of attaching the skirt-wire to vertical tapes, in making a hoop-skirt. *id.*

61. The securing the fabric by gluing it, or using other equivalent adhesive substance, in contradistinction to securing the fabric, to form the enclosure, by weaving around the wires, or weaving pockets, in which to insert the wires, being cheaper, and an improvement in the trade, and useful, is, if new, patentable, the resulting fabric being a different article from one formed by weaving. *id.*

62. An article of dress, called a bustle, containing wire hoops, each of which is a skirt-hoop, formed by enclosing, by means of glue or sizing and pressure, two wires within a covering, which not only envelopes and protects the wires, but forms a connection between them, so that, while the wires are confined to their proper places within the covering, the wire hoop or spring has the appearance of being made from a much broader wire than it in reality is, and may be

- secured to the vertical tape by means of a metallic fastening passing through the vertical tape and the material covering the spring, is, substantially, a hoop-skirt, of a diminished size, and the making and selling of such bustles is an infringement of said patent. *id.*
63. The ownership of a right to manufacture covered wire for springs for skirts, under a patent granted to John T. Loft, March 18th, 1860, for an "improved machine for covering the springs of skeleton skirts," confers no right, as against the De Forest and Gilbert patent, to make, under the Loft patent, the covered wire contained in such bustle. *id.*
64. Although such covered wire may be made by means of the machinery described in the Loft patent, no such wire or skirt-hoop is described or shown in the Loft patent, nor is the apparatus of that patent one which necessarily produces nothing else but such wire or skirt-hoop. *id.*
65. The fact that the plaintiff is infringing the Loft patent, by using the Loft apparatus to make skirt-hoops, is no ground for refusing an injunction against the defendant, restraining him from infringing the plaintiff's patent. *id.*
66. A provisional injunction was dissolved, on evidence showing the prior existence, in the United States, of the skirt-wire of the patent, specimens of the thing known before being produced. *id.*
- (10.) *Jurgensen—Stem-setting watch.*
67. The claims of the re-issued letters patent granted to Jules Jurgensen, April 11th, 1871, for an "improvement in stem-setting watches," the original letters patent having been granted to him January 15th, 1867, namely: "1. A stem-setting watch, so constructed that the setting mechanism is thrown into gear by turning down the pendent ring or bow, when the front cap or case is open, substantially as shown and described; 2. The combination of the cap or guard, E, with the pendent bow, C, and hand-setting mechanism, whereby the said cap, while closed, is made to prevent the bow from throwing the hand-setting mechanism in gear, substantially as shown and described," are infringed by watches containing mechanism constructed in accordance with the description contained in letters patent granted to V. J. Magnin, Guédin & Co., as assignees of James Nardin, August 17th, 1869, for an "improvement in stem-winding watches." *Jurgensen v. Magnin*, . 294
68. Before the plaintiff's invention, no projection on the bow or pendent ring of a watch had been used, through the turning down of such bow, to actuate a slide, to throw into gear the hand-turning wheels, and the slide had never been placed within reach of any such projection; and the plaintiff was the first to dispense at once with the projection of the slide outside of the case, and with the necessity for locking it by a pin, by putting it within the closed cover, and making it impossible for the projection on the bow to move it with the cover closed. *id.*
69. The defendant's arrangement infringes, because the slide does not project outside of the case, and is within the cover, when the cover is closed, so as to be thereby protected from accidental contact with anything; and because the slide is so placed, relatively to one of the collars on the bow, that, when the cover is open, and the bow is turned over, the collar will press on the slide, to effect the gearing with the hand-turning wheels. *id.*
70. In both, if the bow is turned down, when the cover is open, a projection on the bow presses against a slide, which bears against a spring, through the compression of which the gearing is effected with the hand-turning wheels, by the sliding motion imparted to a toothed wheel on the winding-stem; and, in both, when the cover is shut, such gearing cannot be effected, even accidentally. *id.*
71. It makes no difference, that there is, in the plaintiff's arrangement, a larger quantity of mechanism, and that the

plaintiff places the slide, and the projection to move it, within the stem, while the defendant places them outside of the stem, and that the defendant can still move his slide by hand, when the cover is open, and the plaintiff cannot so move his. *id.*

(11.) *Dudley and Clark—Hand-mirror.*

72. The letters patent granted to W. U. Dudley and Lawrence W. Clark, as assignees of W. U. Dudley, the inventor, July 27th, 1869, for an "improved hand-mirror," are valid. *Clark v. Scott,* 301

73. The claim of said patent, namely, "A hand or portable toilet mirror, constructed, substantially as described, of a base-piece, P, with its handle-extension piece or stiffener, C, glass, A, and outer back and handle, D, made of any suitable composition or cement, substantially as specified," covers a hand-mirror made of a cement applied in a plastic state and afterwards hardened, and which has in it two flat wires or strengtheners, made of metal, imbedded in the cement and concealed from view, and running from the body of the mirror part, through the neck and into the handle, and serving to stiffen and strengthen the article, particularly at the junction of the handle with the body. *id.*

74. The brush described in letters patent granted to J. S. Parsons and George A. Scott, as assignees of Alanson C. Esterbrook, June 19th, 1866, for an "improved brush," namely, a brush in which the bristles, inserted through a perforated plate, are imbedded and held firmly in a suitable cement, which cement, at the same time, in combination with the plate, and an extension of the plate into the handle, forms the back and handle of the brush, is not, as a structure, substantially the same thing as the hand-mirror covered by the patent to Dudley and Clark. *id.*

75. Such hand-mirror, as an article of manufacture, was patentable, as distinguished from a brush, even though the backs and handles of the two were made in the same way, there

having been a point of utility and adaptability, in applying the non-warping property of the back and handle to rendering the glass of the mirror free from liability to fracture, which constituted sufficient invention to support a patent for a mirror, even though a brush with a like back and handle had existed before. *id.*

76. Dudley, at the time he applied, in August, 1866, for a patent for the hand-mirror, also applied, as inventor, for a patent for an "improvement in brushes," with this claim, namely, "A brush, in which the bristles are inserted through a perforated plate or holder, imbedded in a composition or cement of any suitable substance, as described, which cement shall, in combination with a base-piece and stiffener of metal, or other material, form the back and handle of the brush, substantially as specified." Both of the applications were rejected. In December, 1866, he assigned to a corporation, who were the real defendants in this suit, all his inventions "in the manufacture of composition brush backs and handles, with suitable strengtheners," and all applications for a patent "thereof," and certain apparatus used by him "in said manufacture," with all his useful information "for making and selling said composition brush backs and handles," "meaning hereby to transfer" all his rights "to the manufacture and sale of said composition brush backs and handles." The applications for both of the patents were pending at that time: *Held*, that the assignment was one only of the invention of the brush, and of the application for the brush patent, and did not carry a right to the invention of the hand-mirror. *id.*

77. Dudley, from August, 1866, until May, 1869, did nothing further towards obtaining a patent for the hand-mirror. The said corporation put into the market, in the fall of 1867, hand-mirrors made in accordance with Dudley's invention. Dudley did not know that fact. His co-patentee, Clark, obtained no interest in the invention until April, 1869: *Held*, that these facts consti-

tuted no objection to the validity of the patent. *id.*

(12.) *Merriam and Chamberlin—Whip-socket.*

78. The claim of the reissued letters patent granted to John O. Merriam and Edwin Chamberlin, as assignees of Charles B. Morehouse, the inventor, July 12th, 1870, for an "improvement in whip-sockets," the original patent having been granted to said Morehouse February 6th, 1866, namely, "The whip-socket, B, having permanently attached thereto the stationary jaw or clamp, E, in combination with the detachable jaw or clamp, G, whereby the said whip socket may be fastened to, and connected with, the dash-board rod of a carriage or other vehicle, substantially in the same manner and by the means herein described and set forth," is a claim to a whip-socket having, at the top and bottom thereof, metal rings or flanges, for the purpose of giving support and strength, with a stationary jaw of a clamp permanently attached thereto, and a detachable jaw, to be applied to clasp the rod of the dash-board, the detachable jaw forming, in connection with its fellow, a mouth or double jaw, which can be slid off and upon the object to which it is to be fastened, and made tight thereon by the single screw which holds its outer end to its fellow. *Merriam v. Drake*, 336

79. Such form of clamp allows the whip-socket to be made fast to the dash-board rod without perforating the leather thereof. *id.*

80. Such claim is not infringed by a whip-socket which has no rings or flanges, and has a substantially different clamp, requiring the perforation of the leather of the dash-board to admit of its application thereto. *id.*

(13.) *Platt—Button.*

81. The letters patent granted to Clark M. Platt, July 10th, 1866, for an "improvement in buttons," are valid. *Platt v. U. S. Button Co.*, 342

82. The claim of the patent, "The button, formed of a single piece of metal, with the edge turned over, and with one central hole, as a new article of manufacture, as specified," covers a button formed of a single thickness of metal, with the edge folded over upon the body of the metal, and with one central hole, capable of being used for a single rivet or eyelet, to fasten the button to the garment. *id.*

83. Such button is not anticipated by a button having a single piece of metal and the folded edge, but no central hole; or by a button in which the edge was not folded over upon the body of the single piece of metal; or by a button not made of metal; or by a button not made of a single piece of metal; or by a button made of a single piece of metal, with its edge folded over on the body of the metal, and with two, three or four holes, so as to be attached to a garment by sewing; or by a button made of more than one piece of metal, in which the edge of one of the pieces of metal is folded over upon the other parts which make up the thickness of the button, and not upon itself. *id.*

(14.) *Day—Electro-magnetic telegraph.*

84. The second claim of the reissued letters patent granted to Samuel F. Day, March 23d, 1869, for an "improvement in electro-magnetic telegraph," the original letters patent having been granted to him May 24th, 1864, namely, "The arrangement of the sounding box, C, the lever, D, and the sounding post, G, of a magnetic telegraph, in combination with each other, in the manner hereinbefore described, and to the effect stated," is void, for want of novelty. *Day v. Bankers' and Brokers' Telegraph Co.*, 345

85. The combination covered by such second claim is one which is capable of being used either in a local current or in a main line current, and is not claimed merely when used where a local battery is dispensed with. *id.*

86. The use of such combination in a local current would be an infringement of the claim; and the prior use

of the arrangement in a local current is an answer to the claim. *id.*

87. The combination claimed is the arrangement of the sounding box, lever, and sounding post, relatively to each other, so that the blow of the armature will be struck directly towards the box, so as to produce a vibration of the box, and consequent sound, by direct action, and so that the sound produced by the blow will be more audible than if the blow were not struck at all in connection with a box or hollow base, but were struck in connection with a solid base, or were struck in connection with a box or hollow base, but not directly towards it. *id.*

88. Such an arrangement existed previously, though in a small instrument used only in a local current, the box and the magnet being small, and the sound feeble; but, the absolute parts, and their relative arrangement, and their action, and their effect, remaining the same, it required no invention to make the box larger, to produce more sound, so as to use it in a longer circuit, with a larger and heavier magnet. *id.*

(15.) *Heaton—Armor for ships.*

89. The letters patent granted to Charles W. S. Heaton, April 14th, 1863, for an "improved defensive armor for ships and other batteries," are void for want of novelty. *Webb v. Quintard*, 352

90. In 1861, a description and drawings were published in a printed publication, in England. From those, the United States, in 1863, caused to be constructed and placed on a vessel, armor like that claimed in the patent of Heaton, one of such drawings being practically the same thing as the armor placed on such vessel. Heaton conceived the idea of his armor in 1856. In 1858, he experimented, by firing a pistol at small pieces of wood and iron. He made no experiments from the fore part of 1859 till the latter part of 1861, when he began to make a model of a war vessel, which he completed early in

1862. The first trial he made with real armor was in 1863: *Held*, that Heaton did not make his invention before the date of the English publication. *id.*

91. A printed publication is, by the 6th, 7th, and 15th sections of the Act of July 4th, 1836, (5 *U. S. Stat. at Large*, 119, 123,) put on the same footing with a patent taken out at the time of the publication; and, regarding the English publication as a patent, it was not unjustly obtained for that which had before been invented by Heaton, who was using reasonable diligence in adapting and perfecting it. *id.*

92. Heaton did not make his invention until he made his model, and he did not begin to make that until after the English publication had been made. *id.*

93. A previous conception of the possibility of accomplishing what the English publication makes known, was not enough. There must have been a reduction of the idea to practice, and an embodiment of it in some distinct form. *id.*

(16.) *Sawyer—Putting up powders.*

94. The reissued letters patent granted to Henry Sawyer, October 1st, 1867, for an "improvement in putting up powders, &c.," which claim, as a new article of manufacture, "a package or case, which, when made with distributing holes, and filled, is cemented by the wax or wafer, as set forth," do not claim any patentable invention. *Sawyer v. Birby*, 361

95. The invention claimed is a small cylindrical box, perforated at the end with holes, and having the perforations closed by wax, or wafer, or paper pasted on, to retain the contents, while the box is being transported, the wax or wafer being removed, or the paper punctured, when it is desired to permit the contents to pass through the holes. *id.*

96. Everything in such invention, both in means and in result, was old. *id.*

- (17.) *Warth—Stop-valve for petroleum packages.*
97. The letters patent granted to Albin Warth, April 19th, 1870, for an improvement in stop-valves for petroleum packages, make, in each one of their two claims, a cup-shaped disk, a material part of the invention, such disk being a valve-seat for a valve, and having the effect, by reason of being cup-shaped, to sink the valve within the package, so that there shall be no part projecting outside. *Meissner v. Devos Mfg. Co.*, 383
98. The cup-shaped form of the disk is made, by the specification and claims, an essential part of the invention. *id.*
99. Such patent is not infringed by a stop-valve of convex-form, not suspended below the surface of the package, though in other respects constructed like the patented arrangement. *id.*
- (18.) *Smith—Corded elastic fabric.*
100. The reissued letters patent granted to William Smith, June 30th, 1868, division B, for an "improvement in corded elastic fabrics," the original letters patent having been granted to him April 5th, 1853, and subsequently extended, are void for want of novelty. *Smith v. Elliott*, 400
101. The claim of such reissued patent, namely, "The corded fabric, substantially as hereinbefore described, in which the cords are elastic, and are held between the upper and under weft threads, and separated from each other by the interweaving of the upper and under weft threads with the warp threads, in the spaces between the cords, and only there, substantially as above shown," is anticipated by a like fabric which existed before, although not woven of a width, or fineness, or elasticity, suitable to be used for the gores of boots, and not so used, and although the fabric introduced by the patentee possessed the qualities which fitted it to be used for the gores of boots, and it was so used, and displaced other elastic fabrics before used for that purpose. *id.*
102. The fabric not being new, its application to a new use was not invention. *id.*
- (19.) *Tilghman—Cutting and engraving stone, &c.*
103. The letters patent granted to Benjamin C. Tilghman, October 18th, 1870, for an "improvement in cutting and engraving stone, metal, glass, &c.," are valid. *Tilghman v. Morse*, 421
104. The use, for ornamenting the surfaces of glass and metal, of the process described in letters patent granted to George F. Morse, November 21st, 1871, for an "improvement in the ornamentation and dressing of the surfaces of glass and other substances," is an infringement of the first claim of the said patent to Tilghman, which is, "The cutting, boring, grinding, dressing, engraving, and pulverizing of stone, metal, glass, pottery, wood, and other hard or solid substances, by sand used as a projectile, when the requisite velocity has been artificially given to it by any suitable means." *id.*
105. The word "artificially," in such claim, and throughout the specification of the Tilghman patent, covers the falling of sand through a vertical tube, high enough to enable the sand to acquire sufficient velocity to do its work. *id.*
106. Such claim is a claim for a process or art. *id.*
107. The invention of Tilghman consists in the discovery, that a stream of sand, driven with sufficient velocity to cause the grains of sand, through their own velocity and momentum, to act as projectiles against the article to be cut or dressed, will do the work effectually, without any vehicle to carry the sand into contact with the article, and without any contact between anything and the article, except the sand. *id.*
108. Such invention was not anticipated by a process in which sand or emery was rubbed against the surface of glass by the wires of a rotating wire-

brush; or by the use, on a locomotive engine, of a stream of sand, combined with a jet of steam, to drive cows from the track of a railroad. *id.*

(20.) *Buerk—Watchman's time-detector.*

109. The reissued letters patent granted to Jacob E. Buerk, as assignee of John Burk, the inventor, March 8th, 1880, for 14 years from October 29th, 1856, for an "improvement in watchman's time-detectors," the original patent having been granted to Buerk, January 1st, 1861, for 14 years from that day, and reissued to him, August 22d, 1865, for the residue of such last-named term, are valid. *Buerk v. Valentine*, 479

110. Burk having obtained in France, October 29th, 1856, a patent for his invention, it was proper to correct, by a reissue, the error in granting the patent in the United States otherwise than for 14 years from that date. *id.*

111. Making a prior device, which will serve the like useful purpose, is not necessarily anticipating an invention. Where the mechanical means employed are different, and the mechanical result is different, one does not anticipate the other. *id.*

112. Whether the letters patent granted to Jacob E. Buerk, as inventor, June 6th, 1865, for an improvement on the time-detector described in the said patent of 1856, are valid, *quere. id.*

113. The defendant's apparatus held to be an infringement of the plaintiff's patent, where its mechanical construction was the same in all that constituted the principle or mode of operation of the plaintiff's apparatus, and gave it efficiency in securing the object of the invention. *id.*

(21.) *Blair—Rubber-head for lead-pencils.*

114. The letters patent granted to J. B. Blair, July 23d, 1867, for a rubber-head for lead-pencils, the claim of which is, "An elastic, erasive pencil-head, made substantially in manner as described," are void. *Rubber Tip Pencil Co. v. Howard*, 490

115. The claim is one to a piece of india-rubber with a hole in it, and is invalid, for want of invention. *id.*

(22.) *The Modena Hat Co.—Fabric for hats.*

116. The reissued letters patent granted to the Modena Hat Company, as assignees of Henry Loewenberg, the inventor, April 30th, 1867, for an "improved fabric for hats, bonnets, &c.," on the surrender of original letters patent granted to said Loewenberg, February 28th, 1865, the claim of such reissue being, "The new compound fabric, hereinbefore described, having substantially a foundation of interlaced threads, and a surface composed of fibrous material, stiffened by gelatinous matter, and consolidated by pressure," are not infringed by the use, as a fabric, of muslin, having interlaced threads, but no surface of fibrous material, either as part of the fabric or artificially applied. *Baldwin v. Schultz*, 494

(23.) *Kendall and Trested—Coating for hats.*

117. The letters patent granted to John L. Kendall and R. H. Trested, February 9th, 1869, for an "improved compound for coating textile fabrics for manufacture of hats and bonnets," the claim of such patent being for a compound composed of white French zinc, or its equivalent, or lead, ground in a colorless and inodorous oil, such as castor oil, and collodion, made by dissolving in ether gun-cotton saturated with alcohol, are not infringed by the use of a compound not containing oil or collodion, but containing zinc white, starch, glue, glycerine, and damar. *Baldwin v. Schultz*, 494

(24.) *Blake—Bonnet.*

118. In the claim of the letters patent granted to S. A. Blake, December 24th, 1861, for an "improvement in bonnets," namely, "A bonnet, cap, or other head covering, the body of which is made of two or more thicknesses of muslin, or other suitable fabric, shaped or formed with a series of raised or embossed stripes, in imita-

- tion of straw, or other braid, by means of suitable dies, in the manner herein set forth," the word "body" means a part of the bonnet which does not include the tip or crown-piece of the bonnet, and means that part of the bonnet to which the tip is united, in the finished bonnet. *Baldwin v. Schultz*, 494
119. According to the description in the specification of the Blake patent, the product of the action of the dies is the completed body of a bonnet, embossed in imitation of straw, and fit for use as the body of a bonnet, in the shape given to it by the dies, and without further ornamenting or covering its surface, and is not merely a frame, or carcass, or skeleton, requiring to be afterwards covered or ornamented, to make its exterior surface so comely and presentable as to be salable as a bonnet, and is not merely a fabric having the completed exterior surface necessary in the bonnet salable as such, but not shaped into its ultimate shape by dies, and requiring further manipulation to put it into such ultimate shape. *id.*
120. The proper construction of the claim of that patent is, that it claims a bonnet the body of which is embossed in imitation of straw or other braid, by dies, which, at the same time, give to it its ultimate shape, such body being made of two or more thicknesses of muslin or other suitable fabric, united by starch or other suitable adhesive and stiffening substance. *id.*
121. The article produced according to the Blake invention is new and useful, an improvement in the trade, and patentable. *id.*
122. It is an infringement of the Blake patent to make a bonnet of three thicknesses of muslin, united by starch, and shaped by dies, which, at the same time, emboss it in imitation of straw braid, although a coating is put on the muslin-frame before it is subjected to the final action of the dies. *id.*
123. A hat may infringe the Blake patent, and yet be seamless throughout. *id.*
124. The essence of the invention of Blake patent being, that the product of the action of the dies to which the thing is last subjected, is the completed body of the bonnet, embossed in imitation of straw, and shaped and ready for practical use, as the body of a bonnet, without further covering or ornamentation, the patent is infringed if the last embossing die gives the ultimate shape to the bonnet, although such dies may be of the same shape as a die to whose shaping action the bonnet has been previously subjected. *id.*
- (25.) *Jenkins—Elastic packing.*
125. The reissued letters patent granted to Nathaniel Jenkins, August 3d, 1869, for an "improvement in the manufacture of elastic packing," the original patent having been granted to him, as inventor, May 8th, 1866, are valid. *Jenkins v. Johnson*, 516
126. The first claim of that patent, namely, "An elastic packing, composed of at least four-tenths of finely pulverized, refractory, earthy or stony material, intimately mingled with, and held together by, rubber prepared for vulcanizing, and then vulcanized, as and for the purpose described," claims a packing, into the composition of which there enters at least four-tenths of refractory, earthy, stony, or mineral matter, which must go in in a pulverized state, in order to be intimately incorporated with the india-rubber, which serves as a vehicle to hold the powder, the compound being then vulcanized, by subjecting it to heat, in the presence of sulphur, and the result being a packing which is elastic, while it is indestructible by heat. *id.*
- (26.) *Jenkins—Steam globe-valve.*
127. The letters patent granted to Nathaniel Jenkins, October 6th, 1868, for an improvement in steam globe-valves," are valid. *Jenkins v. Johnson*, 516
128. The claim of that patent, namely, "The arrangement of the bearing surface, *l*, of the valve-head and the elastic packing held in an annular recess in the valve-head, as described,

with the valve-seat, *f'*, and the raised seat, *f*, in the manner as shown and specified," claims the arrangement of an annular chamber or cup, containing an elastic packing, with a raised seat, in connection with the two bearing surfaces outside of the cup and the raised seat, the whole operating in the manner described. *id.*

129. Such invention is not anticipated by a valve consisting of a raised seat, and a metallic receptacle fitting over it; nor by a valve with a raised seat, and a cup, and a packing of lead or tin fused into the cup. *id.*

(27.) *Sarven—Carriage-wheel.*

130. The specification of the original letters patent granted to J. D. Sarven, June 9th, 1857, for an improved carriage-wheel, discloses two devices—one consisting of spokes, whereof a part are tenoned into a wooden hub, and a part are in wedge form, not thus tenoned; the other consisting of flanged collars applied to the hub and the spokes therein, whether the spokes are constructed in the manner last named, or in any other manner, the specification pointing out the application of flanged collars to a wheel containing the ordinary number of spokes, in which it is probable, at least, that the extra or increased number of spokes not tenoned into the hub are omitted. *Sarven v. Hall*, 524

131. The reissued letters patent granted to said Sarven, September 6th, 1870, on the surrender of said original patent of 1857, in declaring that the invention embraces the combination of the flanged collars with a wooden hub into which the spokes are tenoned, without including the wedge-form spokes, or the solid bearing of the spokes upon each other exterior to the hub, do not embrace a device not found in the record of the original patent. *id.*

132. The first claim of said reissued patent, namely, "A carriage-wheel constructed with the spokes combined with a wooden hub, by tenons entering mortises in said hub, and with each other, in such manner that

a solid belt is formed around the said hub, substantially as before set forth," is limited to a solid belt formed by alternating tenoned spokes with wedge-formed spokes not tenoned, and is not infringed by a wheel in which all the spokes are tenoned into the hub. *id.*

133. The second claim of said reissued patent, namely, "A carriage-wheel constructed with a mortised wooden hub, with tenoned spokes, and with flanges which embrace the faces of the spokes in the immediate vicinity of the hub, and are connected together so as to form a metallic band, through which the spokes extend into the mortises in the wooden hub, substantially as before set forth," is valid. *id.*

134. Such claim is not a claim for a mere aggregation of devices. *id.*

135. Such claim is infringed by a wheel having tenoned spokes, and a wooden hub, and a mortised collar, cast in one piece, with divisions between the mortises for the several spokes, and with tapering sides formed to receive the spokes driven tightly therein, and give them endwise bearings. *id.*

136. As the mortised collar performs, both mechanically and practically, in the combination, the same office that is performed by the flanges of the plaintiff's wheel, it is none the less an equivalent therefor, in the combination, because it performs an additional office, not performed by such flanges. *id.*

(28.) *Barnes—Corset-spring.*

137. The invention described in reissued letters patent granted to Frances L. Barnes, executrix of, &c., of Samuel H. Barnes, deceased, August 31st, 1869, for an "improvement in corset-springs," the original patent having been granted to said Samuel H. Barnes, as inventor, July 17th, 1866, is the arrangement in a pair, combined by clasps, on a corset, of two springs, each spring consisting of two metallic plates placed one upon another, and fastened together

- at their centres, but so connected, at or near each end, that they can play or move upon each other in the direction of their length, and be prevented from sliding off each other laterally. *Barnes v. Straus*, 553
138. Such arrangement did not exist before the invention of Barnes. *id.*
139. The claims of such reissued patent are valid, and claim, under the expression, "a pair or set of corset springs," two corset-springs connected by clasps, each spring being constructed as above mentioned. *id.*
140. The invention held not to have been anticipated by a carriage spring which existed before, or by a single corset-spring composed of two plates, with provision for play, but with no means for combining it with a second spring. *id.*
141. The combination, consisting of the two springs connected by the clasps, exists, *pro tanto*, so as to be an infringement, when the springs and clasps are made, ready to be inserted in a corset. *id.*
- of this Court, if not accompanied by the certificate required by that Rule. *id.*
5. Matter pleadable in bar in such an action, if intended to show that the plaintiff had no subsisting cause of action when the suit was commenced, can be given in evidence under the general issue. *id.*
6. In such an action, evidence of acts of misfeasance immediately connected with the cause of action, or evidence showing an equitable defence arising out of the cause of action, if admissible at all, can be given in evidence, in mitigation of damages, under a plea of the general issue. *id.*
7. In such an action, matter in a plea, which attributes to the plaintiff habits, disposition, temper, and acts, in such wise as would warrant an action for libel against whoever should publicly make such charges by printing or writing, is irrelevant, impertinent, and scandalous, and will be stricken out, on motion. *id.*

See REMOVAL OF CAUSES, 3.

PLEADING.

1. In an action on a judgment of the Superior Court of Chicago, Illinois, the declaration averred that that Court was a Court of general jurisdiction, duly created by the laws of Illinois, but did not aver that that Court had jurisdiction of the person of the defendant, either by service of process, appearance, or otherwise: Held, on demurrer, that the declaration was sufficient. *Tenney v. Townsend*, 274
2. A plea, without a conclusion, is no plea. *Wilkinson v. Pomeroy*, 513
3. A plea of the general issue, in an action for breach of promise of marriage, may be treated as a nullity, under Rule 26 of this Court, if not accompanied by the affidavit and the certificate required by that Rule. *id.*
4. A special plea in such an action may be treated as a nullity, under Rule 27

PRACTICE.

1. Where this Court, after the waiver of a trial by jury, tries a case without a jury, it is not required to make a special finding upon the facts. *Folsom v. Mercantile Mutual Ins. Co.*, 201
2. The testimony in a suit in equity may be taken orally, in open Court. *In re Clark*, 872
3. In a suit in equity, it is irregular to swear a person to an affidavit entitled in the suit, before the bill has been filed. *Baldwin v. Schultz*, 494
4. On an application, after a hearing in a patent suit, to put in alleged newly discovered evidence, it must be shown that the party could not, with reasonable diligence, have obtained such evidence prior to such hearing. *Hitchcock v. Tremaine*, 550

See BANKRUPTCY, 22, 27.
EQUITY, 3 to 9.

See INJUNCTION.

LIEN, 3, 4.

PARTY.

PATENT, 16, 22, 24 to 30.

PLEADING, 2 to 7.

REMOVAL OF CAUSES, 2 to 6.

R

RECEIVER.

See BANKRUPTCY, 43.

REMOVAL OF CAUSES.

1. A judgment was rendered, in a State Court, on the report of a referee, in favor of the plaintiff, against two defendants. The judgment was reversed, and a new trial was granted. After that, one of the defendants, before another trial, applied to the State Court, under the Act of July 27th, 1866, (14 *U. S. Stat. at Large*, 306,) for the removal of the suit, as against him, into this Court. The State Court ordered the removal, holding that the case stood for trial as if no former trial had occurred. The plaintiff then moved, in this Court, that the cause be remanded to the State Court: *Held*, that, as the Act gave the right of removal "at any time before the trial or final hearing of the cause," the cause was properly removed. *Dart v. McKinney*, 359
2. Form of the order of this Court, on the filing of the papers from the State Court. *id.*
3. In the case of a removal, by one of two defendants, under the said Act of 1866, after the cause is at issue, in the State Court, on pleadings, there is no need of any new pleadings in this Court, provided they are in a proper shape for a trial, as between the plaintiff and such defendant. *id.*
4. An action was removed into this Court, from a State Court, as against two of the defendants, under the Act of July 27th, 1866, (14 *U. S. Stat. at Large*, 306). After the record of removal was filed in this Court, the plaintiff pleaded anew, setting up, in his bill, the removal of the cause. After issue, the plaintiff moved to remand the cause to the State Court, on the ground that it was not within

the Act: *Held*, that it was too late for the plaintiff to ask that the cause be remanded, on motion. *Carrington v. Florida R. R. Co.*, 467

5. Before the removal of a cause into this Court, from a State Court, as against two of the defendants, under the Act of July 27th, 1866, (14 *U. S. Stat. at Large*, 306,) an injunction was granted in it, by the State Court, on a full hearing, on notice, against such defendants. After the removal, they moved, in this Court, to dissolve the injunction, on the same papers on which it was granted: *Held*, that leave to make such motion must be applied for and obtained, before it could be made. *Carrington v. Florida R. R. Co.*, 468
6. A case was removed into this Court, under the 12th section of the Act of September 24th, 1789, (1 *U. S. Stat. at Large*, 79,) on the allegation that the plaintiff was a citizen of New York, and the defendant a citizen of Massachusetts. The plaintiff moved to remand the cause, on the ground that he was an alien. That fact was not denied: *Held*, that the motion must be granted. *Galvin v. Boutwell*, 470

REVENUE.

See ACTION.

LIEN.

S

SHERIFF.

See BANKRUPTCY, 8 to 10.

SHIPPING.

See COLLISION.

DAMAGES.

JURISDICTION.

LIEN.

STATUTE OF LIMITATION.

See BANKRUPTCY 4, 5.

LIMITATION.

STATUTES CITED.

UNITED STATES.

1789, September 24th, Judiciary, 128,
199, 395, 470
1789, September 29th, Practice, 198

1792, May 8th, Practice,	198
1799, March 2d, Revenue, 483, 471, 472	
1803, March 3d, Appeals,	199
1829, March 2d, Seamen,	446
1836, July 4th, Patents, 186, 353, 356	
1839, March 3d, Patents,	186
1861, March 2d, Revenue, 471, 472	
1861, July 18th, Commercial Inter- course, 457, 460	
1861, August 6th, Confiscation, 457, 462	
1862, July 6th, Evidence, 316, 319	
1862, July 17th, Confiscation, 457, 463	
1863, March 3d, Limitation of Suits, 458, 466	
1863, March 12th, Confiscation, 457, 463	
1864, June 30th, Internal Revenue, 177, 542, 543, 545	
1864, June 30th, Revenue, 471	
1864, July 2d, Evidence, 316, 319	
1865, February 25th, Eastern District of New York, 455	
1865, March 3d, Judiciary, 204	
1866, July 13th, Internal Revenue, 177	
1866, July 18th, Revenue, 433	
1866, July 27th, Removal of Causes, 359, 360, 467, 468, 469	
1867, March 2d, Bankruptcy, 191, 193, 196, 197, 369, 372, 374, 380, 390, 393, 409	
1867, March 2d, The Onondaga, 355	
1867, March 2d, The Rebellion, 457, 463	
1868, July 20th, Internal Revenue, 176, 177	
1870, July 8th, Patents, 357, 476, 548, 549	

MASSACHUSETTS.

General Statutes, chap. 109, sec. 22, 65, 70

NEW JERSEY.

Nixon's Digest, 4th ed., p. 571, Me-
chanics' Lien, 285, 286

NEW YORK.

1864, April 25th, (chap. 385,) Boston,
Hartford and Erie R. R. Co., 415
1 R. S., 65, Boundaries of New York, 47
3 R. S., 2, Counties in New York, 49

SUIT.

See ACTION.

T

TRADE-MARK.

1. Under section 77, &c., of the Act of
July 8th, 1870, (16 U. S. Stat. at

Large, 210, &c.) the words, "The
Star Shirt," and those words with
the device of a six-pointed star used
in connection therewith, and the de-
vice and words, "The * Shirt," used
as a trade-mark in connection with
the manufacture and sale of men's
and boys' shirts, and taken by deal-
ers as designating the shirts made
by a particular manufacturer, are a
lawful trade-mark. *Morrison v. Case*,
548

TREATY.

See JURISDICTION.

TRIAL.

See PRACTICE.

V

VESSEL.

See CHARTER PARTY.
COLLISION.
DAMAGES.
JURISDICTION.
LIEN.

W

WAR.

1. To an action of assumpsit the de-
fendant pleaded, (1.) That he was
military commander under the United
States, at New Orleans, and martial
law obtained there, from May 1st,
1862, till December 16th, 1862;
that, on September 1st, 1862, the
armed forces under his command
captured a person endeavoring to
make his way from the enemy's lines,
in Mississippi, to New Orleans; that
there were found concealed on his
person certain drafts drawn by per-
sons in Natchez, Mississippi, then in
the occupation of the enemy, on per-
sons in New Orleans, then in the
occupation of the forces of the United
States; that the defendant, in his
military capacity, and under the
authority of the President and the
Acts of Congress, captured said
drafts, and caused the proceeds
thereof, when collected, to be turned
over to the Treasury of the United
States, and they had been credited
to him, by order of the President;

- and that the causes of action sued on arose out of said acts and doings; (2.) That the pretended acts which, if true, would give to the plaintiff the supposed causes of action sued on, were performed by the defendant, if performed, as a military officer of the United States, and in pursuance of the laws of the United States, and of the orders of the President, and during the late rebellion, and that said supposed causes of action did not accrue within two years next before the commencement of the suit, nor within two years after March 8d, 1863: *Held*, on demurrer to the pleas, that the pleas were bad. *Britton v. Butler*, 457
2. Commercial intercourse between the State of Mississippi and the city of New Orleans being unlawful, under § 5 of the Act of July 13th, 1861, (12 *U. S. Stat. at Large*, 257,) and the Proclamation of the President, of August 16th, 1861, (*Id.*, 1262,) the drafts mentioned in the first plea were illegal and void instruments. *id.*
 3. The seizure of the drafts passed no title to the United States to the moneys in the hands of the drawees in New Orleans, which were collected on the drafts, the bills not having been accepted before seizure. *id.*
 4. The moneys in the hands of the drawees of the bills were not, on the facts set out in the first plea, subject to seizure. *id.*
 5. A mere declaration of war does not confiscate enemy property, or debts due to an enemy, nor does it so vest the property or the debts in the Government, as to support judicial proceedings for confiscation of the property or debts, without the expression of the will of the Government, through its proper department, to that effect. *id.*
 6. Under the Constitution of the United States, the power of confiscating enemy property and debts due to an enemy, is in Congress alone. *id.*
 7. The confiscation Acts of August 6th, 1861, (12 *U. S. Stat. at Large*, 319,) July 17th, 1862, (*Id.*, 589,) and March 12th, 1863, (*Id.*, 820,) all of them provide for a seizure only with a view to judicial proceedings. *id.*
 8. None of the confiscation Acts authorize the confiscation of moneys situated as the moneys in this case are alleged by the said first plea to have been situated. *id.*
 9. The possession of the unaccepted drafts, considered as captured documents constituting the evidence of debts due to an enemy, gave no right to the captors to take physical possession of the moneys of the drawees. *id.*
 10. The Act of March 2d, 1867, (14 *U. S. Stat. at Large*, 432,) approving, legalizing and making valid certain acts and orders of the President, or acts done by his authority or approval, and certain proceedings, acts, arrests and imprisonments, does not embrace the transactions set up in said first plea. *id.*
 11. The fact, that martial law obtained in New Orleans, on September 1st, 1862, does not, on the allegations in said first plea, make an order of the President authorizing or approving the seizure of said moneys, an act or order of his respecting martial law, or make the act of the defendant in seizing the moneys an act of his respecting martial law, within the meaning of said Acts. *id.*
 12. There is nothing in the mere existence of martial law, which, on the facts alleged in said first plea, justifies the seizure of said moneys. *id.*
 13. If said moneys were voluntarily paid to the defendant, the fact that he received them as a military commander, and in obedience to the orders of the President, and paid them into the Treasury, and that such payment has been approved by the President, cannot vary his liability for them to the plaintiff, if he would otherwise be liable for them. *id.*
- See LIFE INSURANCE, 4 to 18.
LIMITATION.
- WITNESS.
- See LIFE INSURANCE, 3.

Stanford Law Library



3 6105 06 034 602 5

